

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Marvel Characters, Inc.
Serial Number: 88215854
Filing Date: December 4, 2018
Mark: AVENGERS: ENDGAME
Examining Atty.: Yocheved D. Bechhofer, Esq.
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Commissioner for Trademarks
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RESPONSE TO OFFICE ACTION

Marvel Characters, Inc. ("Applicant") submits the following amendment and remarks in response to the Office Action dated March 7, 2019 (the "March 7, 2019 Office Action"), and the Supplemental Office Action dated May 30, 2019 (the "May 30 Office Action"), regarding Application Serial No. 88215834 (the "Application").

AMENDMENT

Please substitute the current identification of goods with the following (as amended, "Amended Goods"):

All-purpose carrying bags; all-purpose sport bags; baby backpacks; backpacks; beach bags; book bags; calling card cases; coin purses; diaper bags; duffel bags; fanny packs; gym bags; handbags; knapsacks; key cases; luggage; luggage tags; overnight bags; purses; satchels; leather shopping bags; mesh shopping bags; textile shopping bags; tote bags; umbrellas; waist packs; wallets; all of the foregoing related to a film featuring a group of fictional characters

Applicant submits that the Amended Goods resolve the Examining Attorney's concerns regarding the identification and multiple-class application requirements in the March 7, 2019 Office Action.

PRIOR PENDING ADVISORY

The Examining Attorney has identified prior pending Application Serial No. 79258320 for END GAME in the name of Arekkz Gaming Ltd. covering "Clock cases; key rings [split rings with trinkets or decorative fobs]; medals; watch bands; watch cases [part of watches]" in Class 14, "Handbags, bags, trunks [luggage], travelling bags, umbrellas, attaché cases, backpacks, briefcases, haversacks, music cases, net bags for shopping, pocket wallets, purses, school bags, vanity cases, wheeled shopping bags" in Class 18, and "Clothing, footwear, headgear; cap peaks; hat frames [skeletons]; pockets for clothing; ready-made linings [parts of clothing]; shirt fronts; shirt yokes" in Class 25 (the "Cited END GAME Mark").

As discussed below, Applicant submits that the differences in the marks makes confusion between Applicant's AVENGERS: ENDGAME Mark and the Cited END GAME Mark unlikely. In addition, with this response, Applicant has amended and narrowed its identification of goods to clarify that its goods are all related to Applicant's film featuring fictional characters. Accordingly, Applicant respectfully requests that the Examining Attorney withdraw the prior pending advisory.

A. Applicant's AVENGERS: ENDGAME Mark and the Cited END GAME Mark Are Sufficiently Dissimilar in Overall Appearance, Sound, Connotation, and Commercial Impression

The Examining Attorney argues that if the Cited END GAME Mark registers, "applicant's mark may be refused registration under Trademark Act Section 2(d)

because of a likelihood of confusion between the two marks.” (May 30 Office Action, p. 2).

The Examining Attorney’s analysis discounts the differences between Applicant’s AVENGERS: ENDGAME Mark and the Cited END GAME Mark in overall commercial impression, connotation, appearance, and sound that stem from the additional wording in Applicant’s mark. 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 one particular shared term 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 court held that the marks were *not* confusingly similar, and it strongly 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 common terms is not dispositive on the issue of likelihood of confusion when the additional wording creates an entirely different commercial impression. *See Plus Prods. 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, the Examining Attorney has improperly dissected Applicant’s AVENGERS: ENDGAME Mark by focusing only on the single, second terms it shares with the Cited END GAME Mark—that is, the words “END GAME.” When the marks are properly viewed as a whole, they are in fact dissimilar overall.

As an initial matter, the addition of the distinctive first wording “AVENGERS” in Applicant’s AVENGERS: ENDGAME Mark significantly distinguishes the appearance,

sound, and connotation of Applicant's AVENGERS: ENDGAME Mark from the Cited END GAME Mark such that confusion between the marks is unlikely. Indeed, consumers will first encounter Applicant's famous AVENGERS mark when viewing Applicant's AVENGERS: ENDGAME Mark. They will immediately understand that Applicant's AVENGERS: ENDGAME Mark and underlying goods are tied to Applicant and its famous AVENGERS comic books, films, and entertainment franchise. Further, the first term—AVENGERS—looks and sounds completely different from the Cited END GAME Mark. Thus, all of the key factors of sound, appearance, and connotation in Applicant's AVENGERS: ENDGAME Mark differ from the Cited END GAME Mark.

Moreover, both the Federal Circuit and the Board repeatedly have held that it is the first word consumers will see when encountering an applicant's mark, and it is more likely to have a greater impact on purchasers and be remembered by them. See *Presto Prods. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”); *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (VEUVE is the most prominent part of the mark VEUVE CLICQUOT because it is the first word in the mark and the first word to appear on the label). The Examining Attorney has improperly ignored the critical first term, “AVENGERS.” Contrary to the Examining Attorney's position, consumers will first focus on and later recall the word “AVENGERS” when encountering and remembering Applicant's AVENGERS: ENDGAME Mark.

In sum, when the marks are considered in their entireties, the differences between the marks in overall appearance, sound, connotation, and commercial impression are sufficient to avoid a likelihood of confusion.

B. Applicant's Amended Goods Are Sufficiently Unrelated to the Goods in the Cited END GAME Mark

Applicant's Amended Goods clearly relate to Applicant's famous AVENGERS comic books, films, and merchandise franchise, including Applicant's AVENGERS: ENDGAME film released in April 2019 (Attached as Exhibit A (from <https://www.marvel.com/movies/avengers-endgame>) are representative printouts regarding Applicant's AVENGERS: ENDGAME film).

Additionally, the AVENGERS: ENDGAME film is among the highest grossing films of all time (Exhibit B from <https://www.cnbc.com/2019/07/21/avengers-endgame-is-the-highest-grossing-film-of-all-time.html>). As noted above, upon encountering Applicant's Amended Goods offered under Applicant's AVENGERS: ENDGAME Mark, consumers will immediately understand that such goods are tied to Applicant and its famous AVENGERS franchise and newly released film of the same name. Here, consumers are unlikely to believe that Applicant's Amended Goods emanate from the owner of the Cited END GAME Mark. Accordingly, Applicant's Amended Goods are sufficiently unrelated to the goods offered under the Cited END GAME Mark.

Accordingly, based on the differences between the parties' respective goods and marks, Applicant submits that confusion between Applicant's AVENGERS: ENDGAME Mark and the Cited END GAME Mark is unlikely.

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the prior pending advisory be withdrawn, and that the Application be approved for publication.