

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

Applicant: EB Golf Media LLC

Examining Attorney: Mildred Black

Mark: **GOLF**

Law Office: 121

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Serial No.: 88/350,867

**OFFICE ACTION RESPONSE**

EB Golf Media LLC (“EB Golf” or “Applicant”) is in receipt of an Office Action dated June 7, 2019 (“Office Action”), in connection with U.S. Appl. Serial No. 88/350,867 (the “Application”) for **GOLF** (the “Mark”) for “*Digital media, namely, electronic publications in the nature of magazines featuring news, lifestyles, sports, leisure, travel, and topics of general interest recorded on computer media and mobile applications for viewing and interacting with digital magazines featuring news, lifestyles, sports, leisure, travel, and topics of general interest; downloadable software in the nature of a mobile application for viewing and interacting with digital magazines; downloadable electronic publications in the nature of magazines in the field of news, lifestyles, sports, leisure, travel, and topics of general interest and digital applications for viewing and interacting with digital magazines via the internet and wireless devices in the field of news, lifestyles, sports, leisure, travel, and topics of general interest*” in Class 9, “*Magazine published monthly featuring golf information*” in Class 16, and “*Providing information in the field of golf by way of the Internet*” in Class 41 (collectively, the “Goods and Services”). The Examining Attorney has refused registration of Applicant’s Mark as merely describing a feature of the Goods and Services. Applicant respectfully submits that the

refusal should be withdrawn because Applicant's Mark has acquired distinctiveness by virtue of Applicant's prior registrations, including U.S. Reg. No. 2752640 for the typed word mark GOLF and U.S. Reg. No. 2349798 for the mark GOLF (Stylized).

Trademark Rule 2.41(b), 37 C.F.R. §2.41(b), provides that an Examining Attorney may accept ownership by the applicant of one or more prior registrations of the same mark on the Principal Register as *prima facie* evidence of acquired distinctiveness. See TMEP 1212.04. A proposed mark is the "same mark" as a previously registered mark if it "creates the same, continuing commercial impression such that the consumer would consider them both the same mark." TMEP 1212.04(b). In addition, the applied-for goods or services must be "sufficiently similar" to the prior-registered goods or services. TMEP 1212.04(c).

Applicant owns U.S. Registration No. 2752640 for the typed word mark GOLF on the Principal Register for "*General interest magazines*" in Class 16, and U.S. Reg. No. 2349798 for the mark **GOLF** for "*Magazine published monthly featuring golf information*" in Class 16 (collectively, the "Golf Registrations"). A printout of the details of the two Golf Registrations from the TSDR database is attached as **Exhibit A**. U.S. Registration No. 2752640 issued on August 19, 2003 and claims use dating back to April 1959, and U.S. Registration No. 2349798 issued on May 16, 2000 and claims use dating back to May 31, 1996. Applicant respectfully submits that the Golf Registrations constitute *prima facie* evidence that the Mark has acquired distinctiveness.

In particular, Applicant submits that the subject Mark ( **GOLF** ) is the "same mark" as the marks registered by the Golf Registrations for purposes of acquired distinctiveness. The commercial impression created by the subject Mark is identical to Applicant's prior registered marks, and any minor differences between the marks would be non-material for

purposes of acquired distinctiveness. Indeed, the Examining Attorney has conceded that Applicant's Mark is "essentially the same mark" as those registered by Applicant's prior registrations, including the two Golf Registrations. *See* June 7 Office Action.

Moreover, the applied-for Goods and Services are sufficiently similar and related to the registered magazine goods such that the acquired distinctiveness in Applicant's registered GOLF mark should transfer to the Goods and Services in the subject Application. *Cf. In re Best Products Co., Inc.*, 231 USPQ 988, 989 n.6 (TTAB 1986) ("[W]e infer in the instant case that the differences between the marks BEST & Des. and BEST JEWELRY & Des., and between the identifications of services in their respective registrations ['mail order and catalog showroom services' and 'retail jewelry store services'], were deemed to be immaterial differences."); *In re Owens-Illinois Glass Co.*, 143 USPQ 431, 432 (TTAB 1964) (applicant's ownership of prior registration of LIBBEY for cut-glass articles held acceptable as *prima facie* evidence of distinctiveness of identical mark for plastic tableware.); *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308, 309 (TTAB 1960) (applicant's ownership of prior registration of LYTLE for various services, including the planning, preparation and production of technical publications, held acceptable as *prima facie* evidence of distinctiveness of identical mark for brochures, catalogues and bulletins).


With respect to the applied-for Class 16 goods ("*Magazine published monthly featuring golf information*"), these goods are essentially identical to the prior-registered magazine goods and thus clearly satisfy the requisite "sufficiently similar" standard.

With respect to the applied-for Class 9 goods (which include, *inter alia*, "*electronic publications in the nature of magazines*") and Class 41 services ("*Providing information in the field of golf by way of the Internet*"), these Goods and Services are closely related to the

registered magazine goods. Indeed, these Goods and Services essentially cover the electronic format of Applicant's prior-registered magazine goods and the electronic provision of the information held therein. These Goods and Services regularly emanate from the same source as the prior-registered magazine goods, and consumers are accustomed to seeing these goods and services being offered by the same source, such that acquired distinctiveness will readily transfer from one to the other. See *In re Owens-Illinois Glass Co.*, 143 USPQ at 432. In addition to the subject Application and Applicant itself offering each of these Goods and Services from a single source, a brief search of the TESS database shows over 1,450 registrations that cover all of: electronic magazines in Class 9; physical magazines in Class 16; and the provision of online information in Class 41. See **Exhibit B** (TESS Database search for: live[LD] AND `RN > "0" AND ((IC WITH "016") SAME MAGAZINES)[GS] AND ((IC WITH "009") SAME MAGAZINES)[GS] AND ((IC WITH "041") SAME INFORMATION)[GS] ). A small sampling of ten of these registrations is included in the table below, and a printout of the full TSDR records for these ten registrations is attached as **Exhibit C**.

Mark	App. No.	Reg. No.	Relevant Goods & Services	Owner
FIFA  <b>FIFA</b>	77646723	3878469	IC 009. ...electronic publications, namely, books, magazines, brochures, pamphlets, fliers, press releases, newspapers and newsletters in the fields of sports, sports events, sports records, athletes, sports personalities and celebrities supplied by CD-ROM, by downloadable databases and downloadable on the Internet  IC 016. ...magazines featuring sports, sports events, sports records, athletes, sports personalities and celebrities; ...  IC 041. ...information in the fields of entertainment or education, provided on-line from a computer database or the Internet or accessible via a wireless electronic communication device; provision of non-	Fédération Internationale de Football Association (FIFA) association SWITZERLAND FIFA-Strasse 20 Zürich SWITZERLAND 8044


Mark	App. No.	Reg. No.	Relevant Goods & Services	Owner
			downloadable, on-line electronic publications in the nature of magazines, books, and newsletters in the fields of sports, sports events, sports records, athletes, sports personalities and celebrities; provision of sports information related to statistical information; logging of sports record for sports statistics; ...	
THE GUARDIAN  THE GUARDIAN	75713488	4115099	<p>IC 009. Electronic publications, namely, books, newspapers, newspaper inserts, magazines, newsletters, and directories featuring news, music, comedy, video, film, politics, cultural events, arts, travel, environment, books, television, games, sports, science and scientific matters, industrial research, computers, information technology, computer programming, provision of food and drink, restaurants, eateries, hotels, healthcare, beauty care, gardening, veterinary matters, agricultural matters and fashion recorded on computer media; downloadable electronic publications, namely, books, newspapers, newspaper inserts, magazines, newsletters, directories and pamphlets featuring news, music, comedy, video, film, politics, cultural events, arts, travel, environment, books, television, games, sports, science and scientific matters, industrial research, computers, information technology, computer programming, provision of food and drink, restaurants, eateries, hotels, healthcare, beauty care, gardening, veterinary matters, agricultural matters and fashion; ...</p> <p>IC 016. Printed publications and periodicals, namely, newspapers, newspaper inserts, magazines, newsletters, books, directories and pamphlets featuring news, music, comedy, video, film, politics, cultural events, arts, travel, environment, books, television, games, sports, science and scientific matters, industrial research, computers, information technology, computer programming, provision of food and drink, restaurants, eateries, hotels, beauty care, gardening, veterinary matters, agricultural matters and fashion; ...</p> <p>IC 041. ...provision of interactive information in the fields of news, music, comedy, video, film, politics, cultural events, arts, travel,</p>	GUARDIAN NEWS & MEDIA LIMITED COMPANY UNITED KINGDOM 90 York Way Kings Place London N1 9GU UNITED KINGDOM


Mark	App. No.	Reg. No.	Relevant Goods & Services	Owner
			environment, books, television, games, sports, science and scientific matters, industrial research, computers, information technology, computer programming, provision of food and drink, restaurants, eateries, hotels, beauty care, gardening, veterinary matters, agricultural matters and fashion; ...	
<p>LIVE MAG</p> 	79114224	4615510	<p>IC 009. Electronic publications, namely, magazines featuring a wide range of cultural, educational, news, sports and entertainment topics recorded on computer media; computer software for mobile phones and mobile computers for displaying and processing images, graphics and text</p> <p>IC 016. Printed matter, namely, magazines featuring news, information and commentary in the fields of politics, finance, business management, current events, fashion, style, consumer goods design, travel, food and culture, photographs</p> <p>IC 041. ...providing an Internet website portal featuring entertainment news and information specifically in the field of current events; providing not-downloadable on-line publications in the nature of newspapers and periodicals in the fields of in the field of politics, finance, business management, current events, fashion, travel, food and culture</p>	<p>Deutsche Telekom AG Joint Stock Corporation under the laws of Germany FED REP GERMANY Friedrich-Ebert- Allee 140 53113 Bonn FED REP GERMANY</p>
ROLLING STONE	88397628	5896339	<p>IC 009. Downloadable software in the nature of a mobile application for obtaining news, information and commentary in the fields of entertainment, popular culture, current events, politics and music, all of the foregoing relating to the Rolling Stone publication(s); Downloadable magazines, newsletters, articles, and columns featuring news, information and commentary in the fields of entertainment, popular culture, current events, politics and music, all of the foregoing relating to the Rolling Stone publication(s)</p> <p>IC 016. Magazines in the fields of entertainment, popular culture, current events, politics and music, all of the foregoing relating to the Rolling Stone publication(s).</p>	<p>Rolling Stone, LLC LIMITED LIABILITY COMPANY DELAWARE 11175 Santa Monica Blvd. Los Angeles CALIFORNIA 90245</p>

Mark	App. No.	Reg. No.	Relevant Goods & Services	Owner
			<p>IC 041. Non-downloadable magazines, newsletters, articles, and columns featuring news, information and commentary in the fields of entertainment, popular culture, current events, politics and music, all of the foregoing relating to the Rolling Stone publication(s); Providing a website featuring blogs and non-downloadable publications in the nature of articles in the fields of entertainment, popular culture, current events, politics and music, all of the foregoing relating to the Rolling Stone publication(s); Entertainment services in the nature of non-downloadable webcasts, podcasts, and videos in the fields of entertainment, popular culture, current events, politics and music, all of the foregoing relating to the Rolling Stone publication(s); Providing online newsletters delivered by e-mail in the fields of entertainment, popular culture, current events, politics and music, all of the foregoing relating to the Rolling Stone publication(s); ...</p>	
<p>DAILY MAIL</p> <p>DAILY MAIL</p>	75588985	2956380	<p>IC 009. electronic publications, namely, books, magazines, newspapers, manuals and supplements therefore featuring information and advice relating to news, politics, cultural affairs, careers, fashion, health, beauty, medical matters, sports, entertainment, education, food and drink, travel, hotel and accommodation reservation services, current affairs, financial matters, the web sites of others and the world wide web recorded on CD-ROM, electronic, electro-magnetic, optical and electro-optical data carriers; CD-ROMS featuring music</p> <p>IC 016. Printed matter and printed publications, namely, books, magazines, newspapers, periodicals, brochures, manuals, and supplements therefor featuring information relating to news, politics, fashion, health, beauty, medical matters, sports, entertainment, education, food and drink, travel, hotel and accommodation reservations, current affairs, financial matters, the web sites of others, and the world wide web</p> <p>IC 041. ...providing sports information by pre-recorded telephone messages or from a global</p>	<p>ASSOCIATED NEWSPAPERS LIMITED CORPORATION UNITED KINGDOM Northcliffe House Kensington, London ENGLAND W8 5TT</p>

Mark	App. No.	Reg. No.	Relevant Goods & Services	Owner
			<p>computer network; electronic publishing services, namely, publishing of the works of others in hard copy, on CD-rom and on a computer database or a global computer information network featuring news, politics, cultural affairs, careers, fashion, health, beauty, gardening, medical matters, sports, entertainment, music, television, theatre, education, food and drink, cookery, travel, holidays, science, current affairs, business and financial matters, hotels, hotel and accommodation reservation services, the websites of others and the worldwide web; providing information in the fields of sports, entertainment, music, television, theatre and education</p>	
<p>BILLBOARD</p>	<p>85977278</p>	<p>4211680</p>	<p>IC 009. Downloadable electronic publications in the nature of magazines, newsletters, and information flyers in the field of music and entertainment; ...</p> <p>IC 016. Printed publications in the nature of magazines, books, newsletters, and information flyers in the field of music and entertainment, printed matter, namely, newspapers, catalogs, photographs, magazines, books, printed periodicals, newsletters, and brochures all in the fields music and entertainment; posters, stationery, notebooks, book covers, stickers, decals</p> <p>IC 041. online websites featuring information in the field of music and entertainment; online magazines in the field of music and entertainment; entertainment services in the nature of providing live musical performances; night clubs</p>	<p>Prometheus Global Media, LLC LIMITED LIABILITY COMPANY DELAWARE 770 Broadway New York NEW YORK 100039595</p>
<p>SPORT RIDER MAGAZINE</p> 	<p>86849959</p>	<p>4956041</p>	<p>IC 009. Downloadable publications, namely, magazines in the field of motorcycles.</p> <p>IC 016. Publications, namely, magazines in the field of motorcycles.</p> <p>IC 041. Providing a website featuring online information and non-downloadable publications featuring topics of interest to motorcycle enthusiasts, namely, topics of motorcycle news,</p>	<p>Bonnier Active Media, Inc. CORPORATION NEW YORK 460 NORTH ORLANDO AVE., STE 200 Winter Park FLORIDA 32789</p>



Mark	App. No.	Reg. No.	Relevant Goods & Services	Owner
			motorcycles brands and custom motorcycles, motorcycle touring, motorcycle events, motorcycle tips and technical articles, motorcycle parts, motorcycle gear, motorcycle images and videos, and motorcycle reviews and classifieds.	
<p>CEO MAGAZINE INSPIRING THE BUSINESS WORLD</p> 	87406721	5384115	<p>IC 009. ...downloadable electronic publications in the nature of magazines in the fields of business and lifestyle information and news; downloadable electronic publications, namely, electronically readable versions of a printed publication in the nature of magazines in the fields of business and lifestyle information and news</p> <p>IC 016. Magazines in the fields of business and lifestyle information and news; printed periodical publications, namely, magazines in the fields of business and lifestyle information and news; printed matter, namely, magazines and newsletters in the fields of business and lifestyle information and news; printed publications, namely, magazines and newsletters in the fields of business and lifestyle information and news</p> <p>IC 041. ...publication of electronic magazines containing information on a wide range of topics accessible online and over a global computer network; entertainment services in the nature of hosting social entertainment events; entertainment information; magazine publishing; news reporters services; publication of electronic newspapers accessible via a global computer network; production of audio and video recordings, other than advertising; providing on-line non-downloadable electronic publications in the nature of magazines in the fields of business and lifestyle information and news; publication of magazines; multimedia publishing of electronic publications online; publishing of electronic publications; publishing of printed matter; weblog services, namely, online journals or diaries featuring business and lifestyle topics; news agencies, namely, gathering and dissemination of news</p>	<p>Bean Media Group Pty Ltd Proprietary Company, Limited By Shares AUSTRALIA L1 Grosvenor Pl Brookvale NSW 2100 AUSTRALIA</p>

Mark	App. No.	Reg. No.	Relevant Goods & Services	Owner
BRITISH HERITAGE TRAVEL	87061656	5788142	<p>IC 009. Downloadable publications, namely, magazines, in the field of British travel, culture and history.</p> <p>IC 016. Magazines featuring British travel, culture and history.</p> <p>IC 041. Providing online magazines and newsletters featuring news, information and commentary in the field of British travel, culture and history; entertainment services, namely, providing podcasts in the field of British travel, culture and history; online journals, namely, blogs in the field of British travel, culture and history.</p>	IRISH STUDIO, LLC LIMITED LIABILITY COMPANY DELAWARE 1204 BROADWAY, 4TH FLOOR NEW YORK NEW YORK 10001
GD GAME DEVELOPER MAGAZINE  	85670093	4352826	<p>IC 009. Digital media, namely, downloadable electronic publications in the nature of magazines in the field of online, wireless, video, DVD, computer, console and arcade gaming; downloadable software in the nature of a mobile application for viewing and interacting with digital magazines; downloadable electronic publications, via the internet and wireless devices, in the nature of magazines in the field of online, wireless, video, DVD, computer, console and arcade gaming.</p> <p>IC 016. Magazines in the field of online, wireless, video, DVD, computer, console and arcade gaming.</p> <p>IC 041. Providing non-downloadable on-line publications, namely, magazines in the field of online, wireless, video, DVD, computer, console and arcade gaming; providing a website featuring blogs and information about the gaming industry, namely, information about computer games.</p>	UBM IP Luxembourg SARL CORPORATION LUXEMBOURG 17 Boulevard Prince Henri L- 1723 LUXEMBOURG

Accordingly, the Golf Registrations are strong evidence of acquired distinctiveness in Applicant's Mark.

## **Identification of the Goods and Services**

Applicant agrees to amend the identification of the Goods and Services to read as follows, in accordance with the Examining Attorney's suggestion:

Class 9: *Digital media, namely, electronic publications in the nature of magazines featuring news, lifestyles, sports, leisure, travel, and topics of general **human** interest recorded on computer media and mobile applications for viewing and interacting with digital magazines featuring news, lifestyles, sports, leisure, travel, and topics of general interest; downloadable software in the nature of a mobile application for viewing and interacting with digital magazines; downloadable electronic publications in the nature of magazines in the field of news, lifestyles, sports, leisure, travel, and topics of general **human** interest and **downloadable** digital **software** applications for viewing and interacting with digital magazines via the internet and wireless devices in the field of news, lifestyles, sports, leisure, travel, and topics of general interest*

Class 16 (no change): *Magazine published monthly featuring golf information*

Class 41 (no change): *Providing information in the field of golf by way of the Internet*

## **Conclusion**

Based on the foregoing, Applicant respectfully requests that the subject Application be approved for publication.