

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: CHALK)
)
Applicant: Chris Long Enterprises, LLC) Examining Attorney
)
Serial Number: 88354813) Elissa Garber Kon
)
Filing Date: 03/25/2019) Law Office: 106
)
International Class: 9, 25, 35, 41)

Hon. Assistant Commission for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Attn: Box RESPONSES
NO FEE

RESPONSE TO OFFICE ACTION

The Applicant Chris Long Enterprises, LLC (“Applicant”), by and through its undersigned counsel, hereby submits this response to the Office Action dated May 17, 2019, in which the Examining Attorney refused Applicant’s application for the registration of “Chalk” (the “Mark”) under Section 2(d), based on the likelihood of confusion of the mark. In support of the Mark’s registration on the Principal Register, Applicant respectfully states as follows:

I. Section 2(d) Refusal - The Mark Does Not Create a Likelihood of Confusion

The Applicant respectfully submits that the Examining Attorney’s determination that the Mark will likely cause confusion is in error.

A. The Marks are Not Related

Applicant’s Mark will be used in connection with an interactive online community for the intelligent and humorous sports fan. Chalk will deliver a unique perspective—that avoids the canned talking points provided by competing networks. Specifically, the Applicant’s Mark

identifies an online portal featuring sports news and discourse, along with news and information in the field of sports and politics.

Applicant's Mark

1. The Founder and personality behind CHALK is Chris Long, a retired professional football player with approximately 1,000,000 social media followers across Twitter and Instagram. Chris Long played in the National Football League (“NFL”) for 12 years and won two (2) Super Bowls. Chris Long is well-known as a player, but even more well-known publicly for his political and social views. Chris Long has participated in a significant amount of media interviews over the last several years, covering topics in sports, entertainment and politics.
2. CHALK is digital media network that will be distributing video, audio, and written content across multiple digital platforms including the Applicant’s primary website, YouTube, Instagram, Twitter, Facebook, and all Podcast distribution platforms including Apple Podcasts and Spotify.
3. CHALK will cover several topics and stories and create content geared around sports, politics, and entertainment. Gambling and cannabis will be **content** drivers for the network. However, gambling services are not provided through the network.
4. CHALK will have current and retired professional athletes and entertainers as content contributors.
5. CHALK will be selling subscriptions on the primary website and subscriptions will provide exclusive content and LIVE chats for subscribers.
6. CHALK will have advertisers and sponsors on the primary website, mobile app and support social media channels.

The Registered Marks

The Examining Attorney's Office Action lists the following registered marks as confusingly similar to the Applicant's Mark:

1. U.S. Registration No. 5075783 CHALK in stylized font for:

Class 9 - Computer game software; downloadable mobile applications for online games.

Class 41 - Online entertainment services in the form of fantasy sports leagues; entertainment services consisting of a web-based system and an online portal so that customers can participate in online games, operation and coordination of fantasy sports leagues and game tournaments.

2. U.S. Registration No. 4542218 CHALK NYC (with NYC disclaimed) for:

Class 25 - Belts; Blazers; Blouses; Boots; Cardigans; Denims; Dresses; Gloves; Hats; Jackets; Jeans; Leggings; Lingerie; One-piece garments for children; Overalls; Pants; Scarfs; Shirts; Shoes; Skirts; Sleepwear; Slippers; Socks; Sport coats; Stockings; Sweaters; Sweatshirts; T-shirts; Tights; Tops; Undergarments

Class 35 - Online retail store services featuring clothing and clothing accessories.

3. U.S. Registration No. 4791557 CHALK DIGITAL for:

Class 35 - Advertising and advertisement services; advertising and marketing services, namely, promoting the goods and services of others; advertising and publicity services, namely, promoting the goods, services, brand identity and commercial information and news of third parties through digital and on-line medium.

U.S. Registration Nos. 4542218 and 4791557 for CHALK NYC and CHALK DIGITAL are not for the same or related goods and services as the Applicant's Mark. CHALK NYC is used in connection with a children's clothes retailer completely unrelated to sports or entertainment. In addition, the connotation of the term "Chalk" in connection with CHALK NYC is that of a chalk used on a chalkboard by schoolchildren. CHALK DIGITAL is used in connection with a mobile advertisement and marketing service completely unrelated to the Applicant's business. The different uses of the marks listed above in item 2 and 3 establishes that the marks are neither related nor competitive since the marks are not advertised in the same forum nor do the marks emanate from the same source.

U.S. Registration No. 5075783 CHALK is not used in connection with a good or service similar to that of the Applicant. The owner of the CHALK mark, Chalk Daily Fantasy Sports SL, uses its mark in connection with a **gambling and betting** service, unlike the Applicant. Further, although the Examining Attorney's Office Action provided no evidence of the registrant's use of its mark "CHALK" in commerce, a simple web search of the registrant's mark does not immediately reveal the registrant's service or how the registrant's mark "CHALK" is used in connection with its service. A web search of the registrant's mark "CHALK" also reveals that the mark "CHALK" is not being used in connection with an active service here in the U.S. since the mark was registered (a copy of an inactive Facebook page for the registrant is attached hereto as "Exhibit A"). Conversely, a search of the Applicant's Mark reveals YouTube channels and Twitter Accounts actively using the Mark. The purpose of a mark is to identify the source of products . . . to prospective consumers. *See, e.g.*, 15 U.S.C. §1127 (service mark is "any word, name, symbol, or device, or any combination thereof" used to identify and distinguish the services of one person from the services of another, and to indicate the source of those services); *see also Lane Capital Management, Inc. v. Lane Capital Management, Inc.*, 192 F.3d 337, 343 (2nd Cir. 1999). Notwithstanding U.S. Registration No. 5075783 for CHALK, there appears to be no U.S. presence for the services bearing the CHALK mark. For the reasons set forth above and further detail below, the refusal to register under Section 2(d) of the Trademark act should be reversed.

B. Du Pont Factors

A determination of likelihood of confusion under Section 2(d) is made on a case-by-case basis and the factors set forth in *In re E.I. du Pont de Nemours & Co.*, aid in this determination. 476 F. 2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

a. Similarity of the Marks

Applicant's Mark and the registered marks are not similar. The uses, pronunciation, relationship, and function of the marks are not similar. In *Genband*, the Board instructed that "under the first *du Pont* factor regarding the similarity or the dissimilarity of the marks, we consider whether applicant's mark and the registered mark, when viewed in their entireties, are similar in appearance, sound, connotation and commercial impression." *In re Genband Inc.*, 2011 WL 1495451, at 2 (Mar. 30, 2011). In *Genband*, the Board concluded that the manner in which the registrant and the applicant displayed their mark was different and that the marks were dissimilar. *See Id.* In this matter, Applicant's Mark is prominently displayed as a brand identifier and origin source. The mark appears on Applicant's website (chalkmedia.com) and YouTube channel. U.S. Registration No. 5075783 CHALK does not have a web presence here in the U.S. nor does its Facebook page actively display the mark CHALK. Applicant's Mark and registrant's mark, U.S. Registration No. 5075783, are dissimilar in that the depiction differs, similar to *Genband*. Similarly, CHALK NYC and CHALK DIGITAL depiction differs from the that of the Applicant while the goods and services are also not similar. As such, the refusal to register under Section 2(d) of the Trademark act should be reversed.

b. Similarity of the Goods and Services

Applicant's Mark identifies the services listed above. Although the Examining Attorney argues that the description of the Applicant's goods are broad enough to encompass those of the registrant of U.S. Registration No. 5075783, as noted above, neither registrant or U.S. Registration No. 5075783 appear to have a presence in the U.S. As such, the "circumstances surrounding their marketing [does not] give rise to the mistaken belief that [the goods and/or services] emanate from the same source." *See id.* Applicant is a prominent, well-known U.S. athlete who participated in a sport, which is only played in North America. It is unlikely that a consumer would be confused as to the source of the goods or service. *See In re Rexel Inc.*, 223

USPQ 830 (TTAB 1984). As noted above, U.S. Registration Nos. 4542218 and 4791557 for CHALK NYC and CHALK DIGITAL are for completely different goods and services. CHALK NYC is a children's apparel retailer and CHALK DIGITAL is a mobile marketing service completely unrelated to sports or entertainment. As such, the refusal to register under Section 2(d) of the Trademark act should be reversed.

c. Balancing of *Du Pont* Factors

Ultimately, each of the *du Pont* factors is balanced to make a determination of likelihood of confusion. *In re Genband Inc., at 5*. In *Genband*, the Board concluded that because “the marks are dissimilar and purchasers of both applicant's and registrant's goods are made with care, we [the board] find that there is no likelihood of confusion between registrant's mark for its goods and applicant's mark for its goods.” *Id.* In this matter, Applicant's Mark and the registrants' mark are not similar and elicit different commercial impressions. In addition, the consumers of each good or service make their purchases with the requisite care. Therefore, it is unlikely that a consumer will be confused. As such, the refusal to register under Section 2(d) of the Trademark act should be reversed.

II. Disclaimer

Applicant agrees to delete disclaimer.

III. Goods/Services

Applicant agrees with the language provided for Class 9: Downloadable computer application software for handheld devices, namely, software for playing sport games, obtaining and sharing sports information, and viewing sports instruction downloadable and playable on a handheld device.

IV. Conclusion

Applicant has presented sufficient arguments to establish that the Examining Attorney was incorrect in refusing to grant Applicant's registration. Applicant's Mark is not likely to

cause confusion with the registrants' marks, contrary to the Examining Attorney conclusion.

Accordingly, Applicant respectfully requests that this Office approve the above application for registration.

Dated: November 18, 2019

Respectfully submitted,

/s/ Jenny Johnson-Sardella

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EXHIBIT A



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