

Applicant: Hong Kong NETEASE Interactive Entertainment Limited  
Trademark: SUPER MECHA CHAMPIONS  
Serial No. 88336552

## OFFICE ACTION RESPONSE

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

In the Office Action, the Examining Attorney initially refused registration of Applicant's mark based on alleged likelihood of confusion with U.S. Serial No. 88019888 for



**HARDCORE  
MECHA**

For the following reasons, Applicant respectfully traverses this requirement and requests reconsideration.

### **Marks Project Different Commercial Impression**

To properly evaluate the similarities between marks, the marks must be viewed in their entireties (see In re National Data Corp., 224 U.S.P.Q. 749 (Fed. Cir. 1985)), which is merely a recognition that its commercial impression is formed by the combination of all of the elements contained therein. In re Opryland USA Inc. v. The Great American Music Show, Inc., 23 U.S.P.Q.2d 1471 (Fed. Cir. 1982).


Further, according to TMEP Section 1207.01(b)(iii):

Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties

convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted (emphasis omitted).

This position has been well supported by the numerous Board's decisions, e.g., Shen Mfg. Co. v. Ritz Hotel Ltd., 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, inter alia, THE RITZ KIDS creates a different commercial impression); In re Farm Fresh Catfish Co., 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services).

Finally, see In re Hearst Corp., 982 F.2d 493, 494 (Fed. Cir. 1992), wherein Court of Appeals found that Board erred in its analytic approach by failing to afford substantial weight to "girl" in the mark VARGA GIRL as compared to VARGAS. Specifically, Court of Appeals found that the appearance, sound, sight, and commercial impression of VARGA GIRL derive significant contribution from the component "girl". By stressing the portion "varga" and diminishing the portion "girl", the Board inappropriately changed the mark.

Likewise, viewed in their entireties, Applicant's mark SUPER MECHA CHAMPIONS and the cited mark  are readily distinguishable in terms of meaning, sight, sound and commercial impression.

First, in addition to the common term "MECHA" Applicant's mark contains additional distinctive wording "SUPER" and "CHAMPIONS" none of which are not a part of the cited mark.

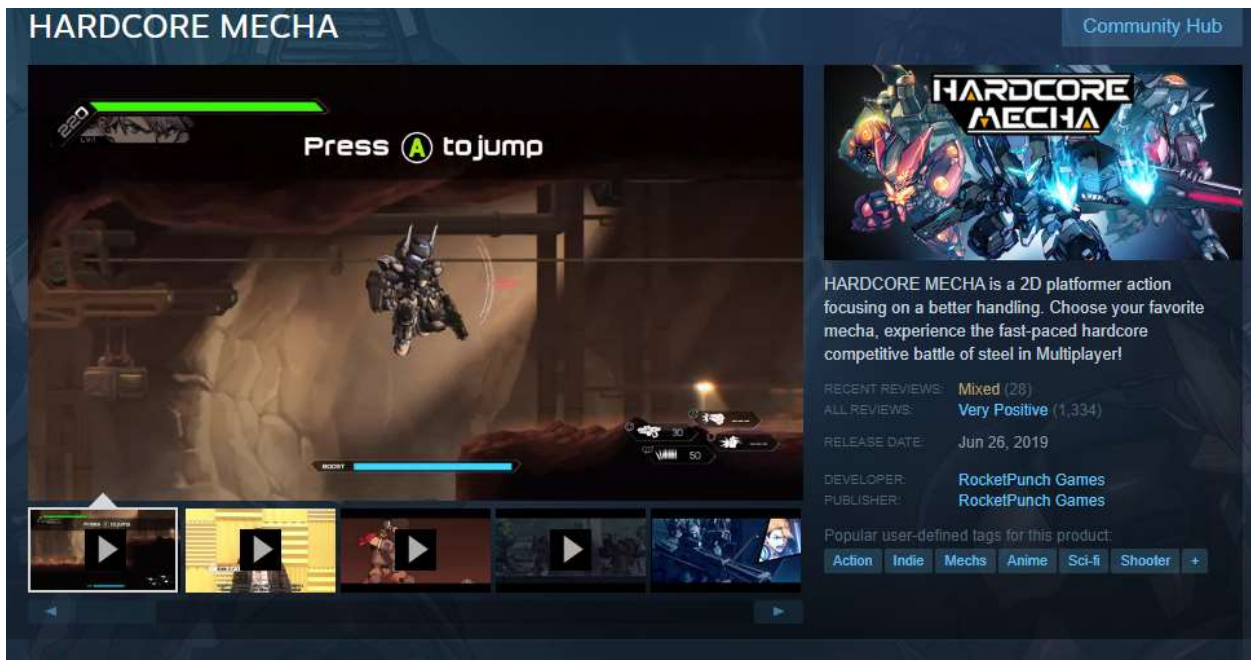
Second, it is well established in identifying the dominant feature of the mark, “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions.” Presto Prods., Inc. v. Nice-Pak Prods., Inc., 9 USPQ2d 1895, 1897 (TTAB 1988). See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 73 USPQ2d at 1692. See also Mattel Inc. v. Funline Merch. Co., 81 USPQ2d 1372, 1374-75 (TTAB 2006). Likewise, while all the parties share a common word “MECHA”, “SUPER” in Applicant’s mark and “HARDCORE” in the cited mark nevertheless remain a prominent and dominant feature as the first elements in the mark and the first words to appear on the label or advertisement materials.


Third, TMEP §1207.01(b)(viii) provides a clear guidance in regards to the instant situation:


If the common element of two marks is “weak” in that it is generic, descriptive, or **highly suggestive** of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality. (bold font and underlining added)

*See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 159 229 USPQ 818, 819 (Fed. Cir. 1986) (reversing TTAB’s holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (holding COBBLER’S OUTLET for shoes, and CALIFORNIA COBBLERS (in typed and stylized forms) for footwear and women’s shoes, not likely to cause confusion); *In re Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035 (TTAB 1985) (holding ASO QUANTUM (stylized, with "ASO" disclaimed) for diagnostic laboratory reagents, and QUANTUM I for laboratory instruments for analyzing body fluids, not likely to cause confusion).

In other words, current practice clearly suggests - the weaker the common element the more unlikely that consumers would be confused because such consumers are likely to assume that highly suggestive terms simply identify or describe the goods. In our case “MECHA” in the cited mark is highly suggestive because according to the attached evidence “MECHA” is a large armored robot, typically controlled by a person riding inside the robot itself and according to the attached evidence of use submitted by the Registrant the mark is used for computer games predominantly featuring mechas. See below:



Therefore, it is reasonable to assume that prospective customers would look to dominant elements in Registrant’s mark, such as HARDCORE, not a highly suggestive term “mecha”. By stressing the portion “MECHA” and diminishing all other distinctive and dominant elements in both parties’ marks, the Examining Attorney inappropriately changed the mark and followed the Board’s conclusion, which was reversed in In re Hearst Corp. When SUPER MECHA CHAMPIONS is given the fair weight, along with confusion with  mark becomes significantly less likely.

Therefore, considering weakness of the common element “mecha” in Registrant’s mark and addition of all distinctive elements in SUPER MECHA CHAMPIONS is sufficient to avoid a likelihood of confusion as SUPER MECHA CHAMPIONS in its entirety conveys significantly different commercial impression than  .

Applicant respectfully requests withdrawal of the refusal to register based on likelihood of confusion. Inasmuch as all outstanding issues have been resolved, Applicant submits that the mark is in condition for publication. Please direct any questions regarding this response to the undersigned attorney for Applicant.

Please direct any questions regarding this response to the undersigned attorneys for Applicant.

Alexander S. Lazouski  
Lazouski IP LLC  
Phone: (201) 645-5616