


Attorney Docket No.: 052999-100606
Mark: TALES OF ARISE
Application Serial No.: 88/473,322


ARGUMENTS

This is a Response to the Office Action issued September 13, 2019. Applicant, Kabushiki Kaisha BANDAI NAMCO Entertainment Inc. (“Applicant”), thanks the Examining Attorney for the thorough review of the application. In the Office Action, the Examining Attorney has raised a prior-filed application advisory. For the reasons set forth below, Applicant respectfully disagrees that the prior-filed applications pose any risk to the registration of the subject mark. The Examining Attorney also requires further specification of the services in Class 41. The Applicant herein amends the services in Class 41 to address this requirement.

I. Prior-Filed Application Advisory

The Examining Attorney has provisionally refused registration of the subject mark TALES OF ARISE (“Applicant’s Mark”) on the basis of the following pending applications:

Application No./Mark	Goods/Services	Applicant
U.S. Application No. 88262354 	<i>Downloadable game programs for mobile phones; computer programs which are downloadable via communication networks; videogame programs for business use; videogame programs for domestic use; computer game programs; downloadable game programs; computer software; computers; computer peripherals; mobile phones; smart phones; straps, cases and covers for mobile phones; straps, cases and covers for smart phones; sounds and music which are downloadable via communications networks; music files which can be received and saved via the Internet; still images and motion pictures which are downloadable via communications networks; image files which can be received and saved via the Internet; electronic publications in Class 9</i> <i>Providing games via mobile phones, the Internet and other communications, and information services in relation thereto; providing online games;</i>	Cygames, Inc.

	<p><i>providing electronic publications; providing electronic books and magazines online; providing videos, music or sounds online; providing images or images with sounds online; planning, operating or holding contests in the field of online game creation; planning, operating or holding contests in the field of online games in Class 41</i></p>	
<p>U.S. Application No. 88457468</p> 	<p><i>Cases for mobile phones; Cinematographic films featuring computer games; Computer game cartridges; Computer game discs; Computer peripheral devices; Digital music downloadable from the Internet; Downloadable computer application software for mobile phones, namely, software for computer games; Downloadable computer game instruction manuals; Downloadable computer game software; Downloadable computer software to enhance the audio-visual capabilities of multimedia applications, namely, for the integration of text, audio, graphics, still images, and moving pictures; Downloadable electronic game programs; Downloadable electronic game software; Downloadable electronic game software for use on mobile and cellular phones and handheld computers; Downloadable interactive game programs; Downloadable interactive multimedia computer game programs; Downloadable multimedia file containing artwork, text, audio, video, games, and Internet Web links relating to interactive, video, electronic and mobile games; Downloadable music files; Downloadable video game programs; Downloadable video game software; Electronic personal organizer; Fitted plastic films known as skins for covering and protecting electronic apparatus, namely, mobile</i></p>	<p>Marchewka Trademark Holder</p>

phones; Graphics cards; Headsets for use with computers; Mobile phone straps; Mouse pads; Recorded computer application software for mobile phones, namely, software for computer games; Recorded computer game software; Recorded video game software; Recorded video game programs in Class 9

Entertainment services, namely, providing on-line computer games; Entertainment services, namely, providing online electronic games; Entertainment services, namely, providing online video games; Entertainment services, namely, providing temporary use of non-downloadable computer games; Entertainment services, namely, providing temporary use of non-downloadable electronic games; Entertainment services, namely, providing temporary use of non-downloadable interactive games; Entertainment services, namely, providing temporary use of non-downloadable video games; Entertainment in the nature of computer games tournaments; Providing information on-line relating to computer games and computer enhancements for games; Providing an Internet website portal featuring entertainment news and information specifically in the field of interactive, computer, video, electronic games, gaming and social networking in Class

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Applicant respectfully disagrees and submits that there is no likelihood of confusion between Applicant's Mark and the cited marks.



U.S. Application No. 88262354 for

At the outset, Applicant advises the Examining Attorney that U.S. Application No. 88262354 for



was abandoned on October 2, 2019 due to the applicant's failure to file a response to an Office Action issued in the application. A true and correct copy of the status record before the USPTO for the application is attached hereto as Exhibit A. Accordingly, Applicant respectfully requests that refusal in view of this reference be withdrawn.



U.S. Application No. 88457468 for

Applicant respectfully disagrees with the Examining Attorney's position that the mark set forth in U.S. Application No. 88457568 for ARISE --A SIMPLE STORY-- (stylized) (the "Cited Mark") is confusingly similar to the Applicant's Mark for TALES OF ARISE.

The Trademark Office must consider the relevant *Du Pont* factors in determining the issue of likelihood of confusion. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ 563 (C.C.P.A. 1973). Further, the significance of each factor is case specific. *Nina Ricci S.A.R.L. v. E.T.F. Enterprises, Inc.*, 12 USPQ2d 1901 (Fed.Cir. 1989), *rev'g*, 9 USPQ2d 1061 (TTAB 1988); *In re E. I. du Pont De Nemours & Co, supra*. In this instance, the most relevant *Du Pont* factors are:

- 1) The differences in look, sound, connotation, and commercial impression of each mark; and
- 2) The high degree of care exercised by consumers.

Dissimilarity of the Marks

Here, Applicant asserts that Applicant's Mark, TALES OF ARISE, and the Cited Mark, ARISE - -A SIMPLE STORY-- (Stylized), are sufficiently different in appearance, sound, connotation, and commercial impression such that there is no likelihood of confusion between the two marks. *See Du Pont*, 476 F.2d at 1361, 177 USPQ at 567 (noting that when conducting a likelihood of confusion analysis, marks must be compared for similarities in appearance, sound, meaning or connotation, and commercial impression). Importantly, "[s]imilarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related." *See* TMEP §1207.01(b)(i).

First, from a visual standpoint, Applicant's Mark provides a very different visual impression than the Cited Mark. The Cited Mark is highly stylized. Applicant's Mark, on the other hand, includes no stylization whatsoever. Even though both Applicant's Mark and the Cited Mark include the term ARISE, when viewing the marks side-by-side, there are no visual commonalities (beyond the term ARISE) that would suggest to consumers that the marks and any related goods or services are in any way connected. The Board has noted that prominent design features can, in fact, serve to distinguish a design mark from another mark. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (holding that VOLTA for vodka drinks and TERZA VOLTA with a stick-like design element for wines is not likely to cause confusion); *Colgate-Palmolive*, 432 F.2d at 1402, 167 USPQ at 530 (finding PEAK and PEAK PERIOD to be different in appearance); *In re Electrolyte Labs., Inc.*, 929 F.2d at 647-48, 16 USPQ2d at 1240 (finding the "substantial" differences in design of the marks to be significant in determining there was no likelihood of confusion between "K+ (and design)" and "K+EFF" for potassium supplements). Thus, Applicant's Mark is not likely to cause confusion with the Cited Mark due to such differences in appearance. *See* 4 McCarthy on Trademarks and Unfair Competition § 23:25 (5th ed.) ("If picture or symbol marks are distinctly different in overall visual appearance, confusion is not likely, even if the marks are used on competing products.").

Further, the fact that the marks contain the term ARISE does not necessarily support a finding of likelihood of confusion. It is well settled that there is no automatic determination of likelihood of confusion merely because two marks have one or two words in common. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 159, 229 USPQ 818, 819 (Fed. Cir. 1986) (no likelihood of confusion between BED & BREAKFAST REGISTRY for "making lodging reservations for others in private homes" and BED & BREAKFAST INTERNATIONAL for "room booking agency services"); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1408-09 (TTAB 1998) (HARD ROCK CAFE and Design and COUNTRY ROCK CAFE and Design dissimilar in appearance; no likelihood of confusion); *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1566 (TTAB 1996) (BROADWAY CHICKEN and BROADWAY PIZZA dissimilar in appearance; no likelihood of confusion).

Moreover, both Applicant's Mark and the Cited Mark comprise distinct added elements which serve to distinguish the marks, including Applicant's addition of the wording TALES OF and the Cited Mark's inclusion of the wording A SIMPLE STORY. Also, the Cited Mark includes added design elements. Additions 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 a distinguishing source because it is merely descriptive or diluted. TMEP 1207.01(b)(iii); *see, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that marks are distinct in look and sound); *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 barbecue mitts) is likely to cause confusion, because, inter alia, THE RITZ KIDS creates a different commercial impression); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*,

89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *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). In this instance, the marks perceive entirely different commercial impressions, given the distinctive added elements to each mark.

Furthermore, when pronounced, Applicant's Mark does not sound like the Cited Mark because the marks include different wording that do not sound alike. Applicant's Mark has the added wording TALES OF and the Cited Mark has the added wording --A SIMPLE STORY--. Notably too is that the common term ARISE comes at the beginning of the Cited Mark



; whereas, the term comes at the end of the Applicant's Mark TALES OF ARISE, which also further distinguishes the marks. In *Colgate-Palmolive*, the court noted there was no phonetic similarity between the marks "PEAK" and "PEAK PERIOD," stating that "[t]he difference in the appearance and sound of the marks in issue is too obvious to render detailed discussion necessary. In their entireties they neither look nor sound alike." *Colgate-Palmolive Co.*, 58 C.C.P.A. at 737. This reasoning is equally applicable in the instant case.

Thus, when properly considered in their entireties, the marks at issue, *i.e.*, TALES OF ARISE and ARISE --AS SIMPLE STORY-- (Stylized), create significantly different overall appearances, sounds, connotations, and commercial impressions. Because of these differences between the marks, Applicant submits that there is no likelihood of confusion between Applicant's Mark and the Cited Mark.

High Degree of Care in Making Purchasing Decision

Consumers selecting both Applicant's and the owner of the Cited Mark's goods and/or services exercise a high degree of care when making their decisions. This high degree of care decreases any possibility of confusion that could exist between the use of the marks on these services. If confusion is to exist, it must be in the mind of some relevant consumer who encounters both marks.

The care expected of purchasers against which likelihood of confusion is measured is determined by the marketing environment in which the goods or services are ordinarily bought or sold. Some factors to be considered are the manner in which the goods are

purchased. . . the manner in which the goods are marketed. . . and the class of prospective purchasers. . .

Restatement (Third) Unfair Competition § 20, comment g (1995).

In weighing the issue of likelihood of confusion, consideration should be given to the “general impression of the ordinary purchaser, buying under the normally prevalent conditions of the market and giving the attention such purchasers usually give in buying that class of goods.” *W.W.W. Pharmaceutical Co. Inc. v. The Gillette Co.*, 984 F.2d 567, 575, 25 USPQ2d 1593, 1600 (2d Cir. 1993). Some conditions of purchase are more conducive than others to the exercise of a high degree of reasonable care. *Industrial Nucleonics Corp. v. Hinde Engineering Co.*, 475 F.2d 1197, 177 USPQ 386, 387 (C.C.P.A. 1973). These conditions include (1) if the purchaser is an enthusiast and (2) the price of the goods or services. *See, e.g., Turtle Wax, Inc. v. First Brands Corporation*, 781 F.Supp. 1314, 22 USPQ2d 1013, 1024 and n. 18 (N.D. Ill. 1991) (car buffs who purchase car polish exercise a high degree of care in making a selection); *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1137, 202 USPQ 81, 92 (2nd Cir. 1979) (considering the high cost of goods).

Here, the respective consumers of Applicant’s goods and services and the goods and services associated with the Cited Mark, which generally relate to video games, are sophisticated and knowledgeable consumers who exercise a high degree of ordinary care when selecting such goods and services. Careful thought, consideration, and evaluation goes into the selection of a video game. Accordingly, a consumer seeking such goods or services would spend a noteworthy amount of time researching, examining and inspecting the goods or services where possible before making a decision.

Typically, when a consumer elects to purchase a video game, he or she is seeking a specific game, or at the very least a specific genre of a game. The genres and themes associated with the games offered under Applicant’s Mark and the Cited Mark are entirely distinct. In particular, Applicant’s TALES OF ARISE game takes place in a setting divided between the medieval world of “Dahna” and the advanced world of “Rena.” *See Exhibit B.* Rena’s superior technological and magical advancement cause it to hold power over Dahna, taking its resources and treating its people as slaves. *Id.* The protagonists are a man named Alphen, native to Dahna, and a woman named Shionne, from Rena, who end up travelling together. *Id.* Applicant’s TALES OF ARISE game is also part of the *Tales* series of games, which consumers will recognize and associate directly with Applicant. On the other hand, the game offered under the Cited Mark is described as a journey through the lives of two people where memories come alive and time bends to your will. *See Exhibit C.* The game starts out at a funeral pyre and treks through the characters’ lives, reliving various moments and memories. *Id.* Based on these brief descriptions alone, it is clear that Applicant’s and the owner of the Cited Mark’s video games are in no way similar or even of the same genre.

In view of the stark differences between the video games offered under the marks, consumers are not likely to be confused as to the source or sponsorship of the goods and services.

Because of the significant differences in appearance, sound, connotation and commercial impression of the marks and the high level of consumer sophistication in purchasing the related goods and services, Applicant submits that there is no likelihood of confusion between Applicant's Mark and the Cited Mark. Accordingly, Applicant respectfully requests that the advisory be withdrawn with respect to this cited application as well.

Applicant has now responded to all issues raised by the Examining Attorney, and therefore respectfully requests the Application be approved for publication. Should the Examining Attorney have any questions, she is invited to contact Applicant's counsel at (202) 585-8000.