

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Performance Designed Products LLC Serial No: 88/410,984 Filed: May 1, 2019 Class: 28 Mark: PRISMATIC	Examining Attorney: Q Queen Law Office: 111 OFFICE ACTION RESPONSE
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Applicant hereby responds to the Office Action mailed on July 17, 2019.

THIS APPLICATION SHOULD BE PUBLISHED FOR OPPOSITION

I. THERE IS NO LIKELIHOOD OF CONFUSION WITH THE CITED MARK

The Examining Attorney has refused to register Applicant's mark PRISMATIC for "Audio headsets for use in playing video games; gaming headsets adapted for use in playing video games; headsets for use with video game consoles; headsets for use with hand-held units for playing video games other than those adapted for use with an external display screen or monitor; player-operated electronic controllers for electronic video games; controllers for video game consoles" in Class 28 under Section 2(d) of the Trademark Act on the grounds of a likelihood of confusion with Reg. No. 4,949,514 for the mark PRISMATIC PENGUIN registered for "Computer game programmes downloadable via the Internet; Computer game software; Computer game software for use on mobile and cellular phones; Interactive game programs; Interactive game software; Interactive video game programs; Video game software; all the foregoing games and software excluding electronic, digital, audio, video, audiovisual and

multimedia books, and software used solely or primarily in print, electronic, digital, audio, video, audiovisual or multimedia book publishing or to create, read, view, listen to or interact with print, electronic, digital, audio, video, audiovisual or multimedia books” in Class 9 (the “Cited Mark”) owned by Alex V. Thayer DBA Prismatic Penguin (“Registrant”).

The Office bears the burden of showing that a mark falls within the statutory bars of Section 2(d). J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (Fifth Ed.) § 19:75 at 19-230. To refuse registration under Section 2(d), the Examining Attorney “must present sufficient evidence and argument that the mark is barred from registration.” *Id.* § 19:128 at 19-383. In this case, the Examining Attorney does not have reasonable grounds to refuse registration under Section 2(d).

In re E.I. DuPont de Nemours & Co., 476 F.2d 1357 (CCPA 1973), sets forth the factors relevant to a determination of a likelihood of confusion. In view of the weakness of the Cited Mark given the existence of third party uses and registrations of PRISMATIC marks for electronic, computer and software goods, the significant dissimilarities in the appearance, sound, connotation and commercial impressions between Applicant’s mark and the Cited Mark, the differences between the respective goods and the significant length of time of concurrent use without any instances of actual confusion, it cannot be reasonably concluded that a likelihood of confusion exists. Application of all key elements of the *DuPont* test dictates the conclusion that granting Applicant’s application for federal registration of PRISMATIC is not likely to cause confusion.

A. The Significant Number of Other PRISMATIC Marks Precludes Confusion

As a threshold matter, the number and nature of similar marks in use in connection with similar goods or services must be considered and given weight. *See DuPont*, 476 F.2d at 1361. Indeed, the relative strength or weakness of a mark is “a very important element” in determining likelihood of confusion. *See MCCARTHY* § 23:48 at 23-203 (“If the common element of conflicting marks is a word that is ‘weak’ then this reduces the likelihood of confusion.”). The

Board and courts routinely hold that, “[t]he greater the number of identical or more or less similar marks already in use on different kinds of goods, the less is the likelihood of confusion between any two specific uses of the weak mark.” *First Sav. Bank, F.S.B. v. First Bank Sys.*, 101 F.3d 645, 653-54 (10th Cir. 1996).

The Board has held that “[s]uch third-party registrations and uses are competent to show that the common term has an accepted meaning in a given field and that marks containing the term have been registered and used for related goods because the remaining portions of the marks may be sufficient to distinguish the marks as a whole from one another.” *ProMark Brands Inc. and H.J. Heinz Company v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1244 (TTAB 2015); *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015) (reversing and remanding Board’s finding of a likelihood of confusion between PEACE LOVE AND JUICE and PEACE & LOVE, stating that Board improperly ignored evidence of 26 third party uses and registrations); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1375 (Fed. Cir. 2015) (reversing and remanding the Board’s finding of a likelihood of confusion between two different paw print designs for clothing, stating that the Board improperly discounted voluminous evidence of third party paw print use and registrations). Notably, the Federal Circuit did not define what constituted voluminous third party use. However, the Federal Circuit discussed 14 third party uses in its opinion. The Board recently held that evidence of 12 third party registrations was sufficient to conclude that the consumers viewing the applicant’s mark and the registrant’s mark “will look to other elements to distinguish the source of the goods and services.” *In re Boston Juicery, LLC*, Serial No. 86/877,537 (August 21, 2018) (not precedential) at p. 10. In *Boston Juicery*, the Board found that the applicant’s mark SQUEEZE JUICE COMPANY for fruit juices, vegetable juices and smoothies, juice bar services, smoothie bar services and café services was not confusingly similar to SQUEEZE & Design for bar services and juice bar services because the term SQUEEZE was “so highly suggestive” of juices, smoothies, bars and cafés and thus a weak

mark. *Id. Accord, In Re FabFitFun, Inc.*, 2018 WL 4043156 (TTAB August 23, 2018) (precedential). In *FabFitFun*, the Board held that the mark I'M SMOKING HOT for cosmetics was not likely to be confused with the registered mark SMOKIN' HOT SHOWTIME for cosmetics. *Id.* at *8. The Board found the shared component SMOKIN' HOT was "somewhat weak" given the evidence of record of ten third party uses of SMOKIN' HOT formative marks for cosmetics products, which "tend to show consumer exposure to third-party use of the term on similar goods." *Id.* at *5.

The PTO itself has allowed the registration and coexistence of multiple PRISMATIC marks for electronics, video game and software products. Attached hereto as **Exhibit A** are registration certificates for at least four PRISMATIC marks for software and technological products registered by the PTO and currently subsisting in International Class 9.

Furthermore, Applicant directs the Examining Attorney's attention to at least 17 third party common law uses of marks incorporating PRISMATIC for various electronics, computer and software products. Attached hereto as **Exhibit B** are Internet printouts of the third party common law uses of PRISMATIC marks for various computer software and electronics products. The third party uses of PRISMATIC include headphones, wireless earbuds, computer keyboards and computer software, mobile applications and video games.

These third party uses and registrations of PRISMATIC demonstrate that the term is commonly used in the software, electronics and video game industry. In other words, PRISMATIC in the Cited Mark is diluted through multiple third party uses for software and electronics products, and consequently a weak mark for software and electronics products. *See New Millennium Sports*, 797 F.3d at 1373-74; *Juice Generation*, 794 F.3d at 1338-40. Consumers for these goods are much more likely to rely on the other words or designs in the respective marks to inform their purchasing decisions. This lessens any likelihood of confusion between Applicant's mark and the Cited Mark.

In sum, the Cited Mark is weak and not entitled to a wide scope of protection. This

weighs in favor of a finding of no likelihood of confusion with the Cited Mark.

B. The Marks are Dissimilar in Appearance, Sound, Connotation and Commercial Impression

The first inquiry in testing for likelihood of confusion is the similarity or dissimilarity of the marks in their entireties, in sight, sound, connotation and commercial impression. *See DuPont*, 476 F.2d at 1361. Applicant's mark PRISMATIC is dissimilar from the Cited Mark PRISMATIC PENGUIN in appearance, sound, connotation and commercial impression.

1. The Marks are Dissimilar in Appearance

The Examining Attorney stated that Applicant's mark and the Cited Mark are similar simply because they share the component PRISMATIC. (Office Action at 2.) It is not enough to simply note that Applicant's mark shares a component with the Cited Mark. It has long been recognized that marks must be compared in their entireties to determine likelihood of confusion, because likelihood of confusion depends on the overall impression of the marks. Thus, marks should not be dissected, and no feature of a mark should be ignored. *In re Hearst Corp.*, 982 F.2d 493, 494 (Fed. Cir. 1992), *reh'g en banc denied*, 1993 U.S. App. LEXIS 7705 (Fed. Cir. Apr. 7, 1993) ("Marks tend to be perceived in their entireties, and all components thereof must be given appropriate weight."). *See Murray Corp. of America v. Red Spot Paint & Varnish Co.*, 280 F.2d 158, 161 (CCPA 1960) ("[A]lthough appellee's mark embodies appellant's entire mark, when considering those marks in their entireties, as we must . . . we are of the opinion that the likelihood of confusion, mistake or deception contemplated by Section 2(d) of the Lanham Act does not exist."); *see also General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987) ("The use of identical, even dominant, words in common does not automatically mean that two marks are similar."); *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46 (1920) ("The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.").

For example, in *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004), the

Federal Circuit affirmed the Board's holding that RITZ and PUTTING ON THE RITZ were not confusingly similar, because when properly considered in their entireties, "[t]he two marks also differ in terms of sound and appearance [and the applicant's] mark contains other words in addition to 'Ritz,' making both its visual appearance and pronunciation longer." *Shen Mfg. Co.*, 393 F.3d at 1242-43. The Federal Circuit disagreed with the opposer's contention that RITZ was the only relevant elements of the respective marks. *Id.* at 1242.

When viewed in their entireties, it is clear that Applicant's mark PRISMATIC and the Cited Mark PRISMATIC PENGUIN do not look anything alike because the Cited Mark contains the word PENGUIN. The word PENGUIN in the Cited Mark deserves equal consideration to the PRISMATIC portion of the Cited Mark.

In other words, the only common element between Applicant's mark PRISMATIC and the Cited Mark PRISMATIC PENGUIN is the term PRISMATIC, which Applicant has already demonstrated is a diluted mark in connection with software and electronics products. The TMEP acknowledges that "[i]f 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." TMEP § 1207.01(b)(viii), citing *Juice Generation*, 794 F.3d at 1338-40, 115 USPQ2d at 1674-75 (remanded for consideration of whether and to what degree the phrase PEACE & LOVE was suggestive or descriptive in the food-service industry); *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); *FabFitFun*, 2018 WL 4043156 at *5 (“Overall, we find the evidence suggests that consumers of cosmetics will look not just to the ‘SMOKIN’ [SMOKING] HOT’ component of marks containing the phrase to identify and distinguish source, but also to the other parts of the marks.”).

Therefore, it cannot be said that Applicant’s mark and the Cited Mark are similar in visual appearance.

2. The Marks are Dissimilar in Sound

Applicant’s PRISMATIC mark is phonetically distinguishable from the Registrant’s marks PRISMATIC PENGUIN for the same reasons, namely, Applicant’s mark PRISMATIC does not contain the word PENGUIN, and the Cited Mark does not contain the words ELITE or AERO. *Shen Mfg.*, 393 F.3d at 124243 (RITZ and PUTTING ON THE RITZ not confusingly similar because “[t]he two marks also differ in terms of sound and appearance. . . . [the applicant’s] mark contains other words in addition to ‘Ritz,’ making both its visual appearance and *pronunciation longer*.”) (emphasis added).

The TMEP stresses that “[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.” TMEP § 1207.01(b)(i). Furthermore, comparison of the similarity or dissimilarity of the marks must be done “in their entireties.” *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329 (Fed. Cir. 2000); *Al-Site Corp. v. VSI International, Inc.*, 174 F.3d 1308, 1330 (Fed. Cir. 1999) (comparing the number of syllables and the number of letters in MAGNAVISION and MAGNA.DOT to conclude that the marks created different commercial impressions).

When properly considered, Applicant’s mark PRISMATIC and the Cited Mark PRISMATIC PENGUIN are not phonetic equivalents and clearly have significant aural differences.

Therefore, it cannot be said that Applicant’s mark and the Cited Mark are similar in

sound and pronunciation.

3. The Marks Are Dissimilar in Connotation and Commercial Impression

The Federal Circuit and the Board have repeatedly affirmed the importance of considering a mark's connotation, meaning, and commercial impression when determining likelihood of confusion and have often found no likelihood of confusion in cases in which the parties' marks project different overall commercial impressions, despite the existence of a matter common to both marks. *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 646 (Fed. Cir. 1990) (no likelihood of confusion between the applied-for mark K+ and Design and the prior mark K+EFF & Design, both used for a dietary potassium supplement, where the element "K+" is the symbol of the potassium ion and the design portions of the marks are substantially different); *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987) (holding CROSS-OVER for bras and CROSSOVER for ladies' sportswear not likely to cause confusion, noting that the term "CROSS-OVER" was suggestive of the construction of applicant's bras, whereas "CROSSOVER," as applied to registrant's goods, was "likely to be perceived by purchasers either as an entirely arbitrary designation, or as being suggestive of sportswear which "crosses over" the line between informal and more formal wear . . . or the line between two seasons"); *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1173 (TTAB 2011); *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1076 (TTAB 2011) (no likelihood of confusion between the applied-for mark ZU ELEMENTS and opposer's registered marks ELEMENT and ELEMENTALITY). Indeed, the Board has retreated from the application of "per se" rules regarding confusion, *e.g.*, if the marks are identical and used for what the Board considers to be related goods and services, they are per se confusingly similar. Again, each case must be determined by its own facts. *See id.*

The connotation and commercial impressions of Applicant's mark differs from the Cited

Mark. The Examining Attorney submitted dictionary definitions of “Prismatic”, which means resembling the colors formed by refraction of light through a prism or highly colored. The Cited Mark also includes the word “Penguin”. The Cited Mark PRISMATIC PENGUIN thus suggests a highly colored penguin or a penguin resembling prism colors. Registrant’s use of PRISMATIC PENGUIN comports with this connotation. Attached hereto as **Exhibit C** is a printout from Registrant’s website at <prismaticpenguin.com> featuring a cartoon-like depiction of a multicolored penguin. Applicant’s mark does not connote a penguin and is thus distinguishable in connotation from the Cited Mark. *See Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 1108 (CCPA 1972) (no likelihood of confusion between the applied-for mark ALL CLEAR! and the registered mark ALL, both for household cleaning products); *see also Patrón Spirits International AG v. Conyngham Brewing Company*, 2018 WL 2938017 at *6 (TTAB Jun. 8, 2018) (finding Applicant’s mark PIRATE PISS for beer, ale and lager conveying a unique connotation and commercial impression distinguishable from PYRAT for rum).

In sum, Applicant’s mark and the Cited Mark are quite different in connotation and commercial impression.

C. The Goods Offered Under the Respective Marks Are Not Marketed Such that a Mistaken Belief of Common Source Would Likely Arise

The courts and the Board routinely hold that, even in a situation where two marks are identical, which is not the case here, there is no likelihood of confusion “if the goods or services in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source . . .” TMEP § 1207.01(a)(i) (citing *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ.2d 1156, 1158 (TTAB 1990) (“[A]s far as the general public is concerned confusion would not be likely because the goods and services are sold through different channels of trade to different classes of consumers.”). For example, in *Sunenblick v. Harrell*, the court

found no confusion between jazz records and hip-hop records sold under the identical mark UPTOWN RECORDS because, although the recordings were both musical products, they were marketed to different consumers and sold in separate sections of record stores. *Sunenblick v. MCA Records, Inc.*, 895 F. Supp. 616, 629 (S.D.N.Y. 1995). *See also Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1095 (D.N.J. 1997) (HARLEM WIZARDS for showcase basketball team and WASHINGTON WIZARDS for professional basketball team not likely to be confused).

The Examining Attorney states that Applicant's mark and the Cited Mark are related because the respective goods can be used together. (Office Action at 3.) However, Applicant has demonstrated that PRISMATIC is commonly used as a mark for various different types of software, including mobile apps and online games. Given the multiple software developers who provide PRISMATIC software, it is highly unlikely that the relevant consumers would confuse Applicant's video gaming products with one particular software developer, namely, Registrant. Because each party's respective services are not "marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source," it is highly unlikely, if not impossible, that consumers would confuse Applicant's goods and Registrant's goods.

1. There Has Been A Period Of Concurrent Use Without Actual Confusion

The length of time and conditions under which there has been concurrent use without evidence of actual confusion must be considered under the *Dupont* test. *See DuPont*, 476 F.2d at 1361. Concurrent use of two marks over a substantial length of time without actual confusion strongly suggests that there is no likelihood of confusion. *See Falcon Rice Mill, Inc. v. Community Rice Mill, Inc.*, 725 F.2d 336, 348 n.13, 222 USPQ 197 (5th Cir. 1984); *Swatch*

Group (U.S.) Inc. v. Movado Corp., 2003 U.S. Dist. LEXIS 6015, *15-*16 (S.D.N.Y. Apr. 9, 2003) (coexistence of virtually identical marks on identical goods for four years indicated confusion was unlikely).

Applicant's date of first use is April 30, 2013. Registrant's first date of use is May 13, 2015. Therefore, Applicant and Registrant's marks have been in concurrent use for almost five years. Applicant is not aware of a single instance of actual confusion during this time period. This favors a finding that no likelihood of confusion exists between the marks at issue.

In sum, the Examining Attorney should withdraw the refusal to register Applicant's mark because there is no likelihood of confusion between Applicant's mark and the Cited Mark.

II. THE MARK IS NOT MERELY DESCRIPTIVE

The Examining Attorney has refused to register Applicant's mark PRISMATIC under Section 2(e)(1) of the Lanham Act on the grounds that the term immediately conveys information about Applicant's goods, namely, "Audio headsets for use in playing video games; gaming headsets adapted for use in playing video games; headsets for use with video game consoles; headsets for use with hand-held units for playing video games other than those adapted for use with an external display screen or monitor; player-operated electronic controllers for electronic video games; controllers for video game consoles" in Class 28. The Examining Attorney stated that Applicant's "specimens show that the applied-for goods feature prism-like colors. Therefore, the mark is descriptive of a characteristic of the mark." (Office Action at 5.)

The question of whether a particular designation is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the designation is being used on or in connection with said goods or services, and the possible significance that it would have, because of such manner of use, to the average purchaser of the goods or services. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 592 (TTAB 1979); *Q-Tips, Inc. v. Johnson & Johnson*, 95 USPQ 264, 277 (D.N.J. 1952), *aff'd*, 98 USPQ 86 (3d Cir. 1953), *cert. denied*, 346 U.S. 867 (1953).

The Office bears the burden of demonstrating that Applicant's mark is merely descriptive from the vantage point of Applicant's consumers. *In re Merrill Lynch, Pierce, Fenner, and Smith, Inc.*, 828 F.2d 1567, 4 USPQ.2d 1141, 1144 (Fed. Cir. 1987). Moreover, where doubt exists as to whether a term is descriptive, such doubt should be resolved in favor of the applicant. *Id.*; see also *In re The Rank Org. Ltd.*, 222 USPQ 324, 326 (TTAB 1984) (“[I]f there was any doubt about whether the term . . . is merely descriptive . . . that doubt should be resolved in favor of the applicant.”); *In re Gourmet Bakers, Inc.*, 173 USPQ 565 (TTAB 1972) (any doubt in determining the registrability of THE LONG ONE for bread is resolved in favor of applicant “on the theory that any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark and to present evidence, usually not present in the ex parte application, to that effect.”). Here, and respectfully, the Examining Attorney has not met the burden of demonstrating that Applicant's mark PRISMATIC is merely descriptive.

1. **Applicant's Mark is Suggestive and Not Descriptive of Applicant's Services**

A term is merely descriptive “if it *forthwith* conveys an *immediate* idea of the ingredients, qualities or characteristics of the goods.” *In re Stroh Brewery Co.*, 34 USPQ.2d 1796, 1797 (TTAB 1994) (emphasis added) (quoting *In re Abcor Development Corp.*, 588 F.2d 811, 814 (CCPA 1978) (VIRGIN not descriptive of non-alcoholic malt beverage). The primary criterion for distinguishing descriptive and suggestive marks is “the imaginativeness involved in the suggestion, . . . that is, how immediate and direct is the thought process from the mark to the particular product.” *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979). Importantly, “the question as to whether a particular term is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the term is being used on or in connection with those goods or services, and the possible significance that it would have, because of such manner of use to the

average purchaser of the goods or services.” *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 951 (TTAB 1981).

Applicant seeks registration of PRISMATIC for “Audio headsets for use in playing video games; gaming headsets adapted for use in playing video games; headsets for use with video game consoles; headsets for use with hand-held units for playing video games other than those adapted for use with an external display screen or monitor; player-operated electronic controllers for electronic video games; controllers for video game consoles” in Class 28. Applicant’s PRISMATIC mark, when applied to Applicant’s goods, does not convey an “*immediate* idea of the ingredients, qualities or characteristics of the [services].” *In re Stroh Brewery Co.*, 34 USPQ.2d at 1797. The term PRISMATIC suggests but does not immediately describe the possible colors or color changes of Applicant’s goods to the relevant consumers. *In re Reynolds Metals Co.*, 480 F.2d 902, 904, 178 USPQ 296, 297 (CCPA 1973) (holding that the mark BROWN-IN-BAG for transparent plastic film bags is not merely descriptive, but rather “is suggestive of one purpose to which the goods may be put, i.e., to brown meats in an oven.”). Accordingly, Applicant’s mark is suggestive, not merely descriptive, of Applicant’s goods.

2. Any Doubt about Descriptiveness Should Be Resolved in Applicant’s Favor

In the event that there was any doubt as to whether the present mark is merely descriptive, it must be resolved in Applicant’s favor according to the case law authority. *In re The Rank Org. Ltd.*, 222 USPQ 324, 326 (TTAB 1984). “[I]f there was any doubt about whether the term . . . is merely descriptive . . . that doubt should be resolved in favor of the applicant.” *In re The Noble Co.*, 225 USPQ 749, 750 (TTAB 1985); *In re Bed-Check Corp.*, 226 USPQ 946, 948 (TTAB 1985) (“[A]ll doubt is resolved in favor of publishing the mark for opposition.”); *In re Mobile Ray Inc.*, 224 USPQ 247, 248 (TTAB 1984) (“[W]hen there is doubt in the matter, the doubt should be resolved in Applicant’s behalf and the mark should be published for

opposition.”). In keeping with the controlling case law, any doubt here must be construed in Applicant’s favor and in favor of withdrawing the refusal to register.

III. CONCLUSION

Having fully responded to the Office Action, Applicant requests that the Examining Attorney withdraw the refusals to register under Sections 2(d) and 2(e)(1) and pass the mark to publication.

SMRH:4827-4178-4754.1