

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: U.S. Trademark Application
Mark: **ISE**
Serial No: 88/413,082
Applicant: Integrated Systems Events, LLC
Atty. Ref: 502416

Response to Office Action

Applicant, Integrated Systems Events, LLC, responds to the July 25, 2019 Office Action as follows.

Likelihood of Confusion

Applicant respectfully disagrees with the Examining Attorney's refusal of the application based on an alleged likelihood of confusion with U.S. Reg. No. 5,291,717. Applicant submits that, among other reasons, the goods and services associated with U.S. Reg. No. 5,291,717 are sufficiently different from those identified in Applicant's application so as to eliminate any likelihood of confusion. These differences, taken with the differences in consumers, channels of trade, and the fact that Applicant's mark has been used in connection with the identified services for over fifteen years is enough to remove any likelihood of confusion. Applicant respectfully requests that the refusal be withdrawn.

Filing Basis and Signed Declaration

Applicant has submitted a signed declaration concurrently with this response declaring an in-use Section 1(a) basis stating that the applied-for mark is in use and has been since at least as early as October, 2003. Applicant has also submitted specimens showing use of the mark in connection with the identified services.

Identification of Services

Applicant respectfully submits that its identification of services, as submitted with the application, should be accepted.

First, with respect to Class 35, Applicant respectfully disagrees that the "namely" clause should be required after "promoting public awareness in the field of the audiovisual industry." Applicant notes that the ID manual contains multiple instances of "promoting awareness in the field of" without requiring further specification. See, e.g., Term IDs 035-1940 ("Promoting public awareness of {indicate field or subject matter}"); 035-1371 ("Promoting public awareness in the field of social welfare"); 035-2255 ("Association services, namely, promoting public awareness of {indicate field or subject matter}"); 035-2262 ("Charitable services, namely, promoting public awareness of {indicate field or subject matter}"). As none of these approved identifications require further information via a "namely" clause, nor should Applicant's.

Applicant notes that it has accepted the Examining Attorney's recommended addition of "advertising and promotion of educational and cultural conferences, congresses, events, and exhibitions of others" to its Class 35 identification.

Next, regarding Class 41, Applicant similarly submits that its identification does not require further clarification. “Providing information relevant to the field of the audiovisual industry for cultural and education purposes” fully describes the services in connection with which the mark is used. This identification contains the service (providing information), the field (the audiovisual industry), and the purpose(s) (cultural and educational). Applicant respectfully submits that further clarification is not necessary.

Significance of Letters

Applicant submits that the letters in the mark “ISE” do not have any significance in the audiovisual trade or industry or as applied to applicant’s goods and/or services, nor do they represent a “term of art” within Applicant’s industry.