

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK EXAMINATION DIVISION

APPLICANT : HBI Branded Apparel)
Enterprises, LLC)
) Beniam Biftu
MARK : OFFICIAL HOODIE OF) Trademark Examining Attorney
ESPORTS)
) Law Office 117
SERIAL NO. : 88/514,136)
)
CLASS: : 25)

RESPONSE TO OFFICE ACTION

Applicant HBI Branded Apparel Enterprises, LLC (the “Applicant”) has received and reviewed the Office Action mailed on August 5, 2019, regarding U.S. Trademark Application Serial No. 88/514,136 (the “Application”) for the OFFICIAL HOODIE OF ESPORTS trademark (“Applicant’s Mark”). Applicant submits the following response regarding the Application.

I. DISCLAIMERS

No claim is made to the exclusive right to use the word “Hoodie” or the word “Esports” apart from the mark as shown.

II. LIKELIHOOD OF CONFUSION WITH PRIOR-FILED APPLICATION

The Examining Attorney has cited Application Serial No. 88/105,385, for the trademark THE OFFICIAL FABRIC OF ESPORTS (the “Cited Mark”) for use with chairs and furniture in Class 20, specialty textiles for the manufacture of furniture in Class 24, and apparel in Class 25, as a potential obstacle to registration of Applicant’s Mark on that ground that Applicant’s Mark may be likely to create confusion with the Cited Mark. For the following reasons, Applicant respectfully submits that Applicant’s Mark is unlikely to create confusion of any kind with the

Cited Mark and respectfully requests the Examining Attorney to approve Applicant's Mark for publication.

A threshold question in determining whether one mark is likely to create confusion with another is the degree of protection that should be afforded the prior mark at issue. *See, e.g., Amstar Corp. v. Domino's Pizza, Inc.*, 205 U.S.P.Q. 969, 975 (5th Cir. 1980) (“[T]he strength and distinctiveness of [a] mark is a vital consideration in determining the scope of protection it should be accorded.”). Where a trademark exists in a crowded field of similar marks, that mark is entitled to only a narrow scope of protection, and even small differences in appearance and connotation of other marks can be sufficient to avoid consumer confusion. *See Carefirst of Maryland, Inc. v. Firsthealth of the Carolinas*, 77 U.S.P.Q.2d 1492, 1510 (T.T.A.B. 2005) (finding that in a crowded field of marks “consumers likely are able to distinguish between entities based on distinctions among the marks.”); *accord* T.M.E.P. § 1207.01(d)(x) (ownership of similar marks by different entities may indicate dilution and lack of likelihood of confusion).

Here, the Cited Mark coexists with many other registrations and pending applications for similarly constructed trademarks incorporating the words “The Official _____ of _____.” There are at least 395 active records on the Trademark Register for similarly constructed trademarks. Notably, there are 28 active registrations and applications for marks incorporating the exact, identical words “The Official _____ of *Esports*.” Given the crowded field of similarly constructed marks, Applicant submits that the Cited Mark is entitled to only a narrow scope of protection and that marks differing from the Cited Mark by at least one word can coexist without creating confusion. *See* T.M.E.P. § 1207.01(d)(x) (ownership of similar marks by different entities may indicate dilution and lack of likelihood of confusion).

Applicant further submits that, when the appropriately narrow scope of protection is accorded the Cited Mark, Applicant's Mark is sufficiently distinguishable from the Cited Mark to avoid consumer confusion. Notably, the Trademark Office has already determined that marks differing from the Cited Mark by just one word can coexist with the Cited Mark without creating confusion, as evidenced by the marks shown in the table below.

Mark	Identical and Related Goods	Registration No./ App. No.	Owner Name
OFFICIAL CHAIR OF ESPORTS	Class 20: Chairs; office seats; seating furniture	5,863,758	Raynor Marketing Ltd. d/b/a The Raynor Group
OFFICIAL GAMING CHAIR OF ESPORTS	Class 20: Chairs, office seats; seating furniture	5,835,560	Raynor Marketing Ltd. d/b/a The Raynor Group
THE OFFICIAL GEAR OF ESPORTS	Class 20: Chairs; office chairs; office furniture; seating furniture; computer chairs; gaming chairs	88/564,666 ¹	American Esports, LLC
THE OFFICIAL SNACK OF ESPORTS	Class 29: Nut-based snack foods	88/368,319 ²	Biosilo Foods, Inc.
THE OFFICIAL JERKY OF ESPORTS	Class 29: Jerky	5,700,170	JerkyPro, LLC
THE OFFICIAL DRINK OF ESPORTS	Class 32: Energy drink powders; nutritional energy drink powders, namely, powders used in the preparation of energy drinks; powders used in the preparation of sports and energy drinks; powders used in the preparation of isotonic sports drinks and sports beverages	5,586,625	G Fuel, LLC
THE OFFICIAL BEER OF ESPORTS	Class 32: Beer	88/476,191 ³	Anheuser-Busch, LLC

¹ This pending application was filed on August 2, 2019, nearly a year after the Cited Mark was filed. Nevertheless, the Cited Mark was not cited as a potential obstacle to registration for this mark, indicating that the Trademark Office believes this mark can coexist with the Cited Mark without creating confusion.

² Notice of Allowance issued on September 17, 2019.

(Copies of the TESS records for these registrations are attached as Exhibit A).

In particular, the Cited Mark, which was issued a Notice of Allowance, coexists with the marks OFFICIAL CHAIR OF ESPORTS, OFFICIAL GAMING CHAIR OF ESPORTS and THE OFFICIAL GEAR OF ESPORTS, all shown above, despite the fact the both the Cited Mark and each of those three marks are used or intended for use in connection with chairs and seating furniture. The coexistence of the Cited Mark with these three similar marks indicates that a difference of merely one word in marks made up of the phrase “The Official _____ of Esports” is sufficient to distinguish such marks, *even when the marks are used on identical goods*.

Similarly, THE OFFICIAL SNACK OF ESPORTS coexists with THE OFFICIAL JERKY OF ESPORTS, both for use with snack foods, and THE OFFICIAL DRINK OF ESPORTS coexists with THE OFFICIAL BEER OF ESPORTS, for use with energy drinks and beer.⁴ This further underscores the point that a difference of at least one word in marks comprised of the phrase “The Official _____ of Esports” is sufficient to distinguish those marks and avoid consumer confusion. Applicant’s Mark, which differs from the Cited Mark in the same manner as the marks listed above, is similarly distinguishable from the Cited Mark to avoid consumer confusion.

In addition, the Trademark Office has approved registration of the following pairs of similarly constructed marks, which are each used on goods similar and related to one another,

³ Reg. No. 5,586,625 for THE OFFICIAL DRINK OF ESPORTS was not cited as an obstacle to registration for this pending application, indicating the Trademark Office believes these two marks can coexist.

⁴ The T.T.A.B. has found energy drinks and beer to be related goods. *See e.g., Tap it Brewing Co., LLC v. Tap or Nap LLC*, Opp. No. 91208370, 2016 WL 54872 (T.T.A.B. 2016).

despite their each incorporating the phrase “The Official _____ of _____.”

Mark	Identical and Related Goods	Registration No./ App. No.	Owner Name
THE OFFICIAL BEER OF GAMERS	Class 32: Beer	88/476,193 ⁵	Anheuser-Busch, LLC
OFFICIAL SODA OF GAMERS	Class 32: Beverages, Non-alcoholic carbonated and non-carbonated beverages, namely, soda pops, soft drinks, soft drink colas, and soft drinks in the form of concentrated syrups for fountain soda machine	88/597,927 ⁶	SOL Global Investments Corp.
THE OFFICIAL SHOE OF CHEERLEADING	Class 25: Footwear	3,562,774	Nfinity Products and Services, Inc.
THE OFFICIAL HAIR TIE OF CHEERLEADING	Class 26: Hair accessories, namely, hair ties	5,450,449	Yehi Ventures, LLC
THE OFFICIAL BEER OF FOOTBALL FANS	Class 32: Beer	4,672,008	Anheuser-Busch, LLC
THE OFFICIAL WINE OF FOOTBALL SEASON	Class 33: Alcoholic beverages except beer	4,368,560	E&J Gallo Winery

(Copies of the TESS records for each of these marks is attached as Exhibit B). Undoubtedly, additional examples exist. Applicant submits that Applicant’s Mark is no more similar to the Cited Mark than the above pairs of marks are to one another. Moreover, these marks, and the numerous other similarly constructed marks on the Trademark Register further indicate that consumers are accustomed to seeing “The Official _____ of _____” marks, and will therefore distinguish these and other similar marks based on their differences. “The rationale is, of course, that the common presence in marks of elements extensively used by others may cause

⁵ Notice of Allowance issued on December 10, 2019.

⁶ App. Ser. No. 88/476,193 was not cited as a potential obstacle to registration of this mark, indicating the Trademark Office believes these marks can coexist with the without creating confusion.

purchasers to not rely upon such elements as source indicators but to look to other elements as a means of distinguishing the source of the goods and/or services.” *Carefirst of Maryland, Inc.*, 77 U.S.P.Q.2d. at 1509. Accordingly, the coexistence of such marks and uses alongside the Cited Mark indicates that confusion between Applicant’s Mark and the Cited Mark is highly unlikely.

III. CONCLUSION

Having addressed all of the issues raised by the Examining Attorney, Applicant respectfully requests that the objections raised in the Office Action be withdrawn and that Applicant’s Mark be approved for publication in due course.