REQUEST FOR RECONSIDERATION OF OFFICE ACTION

Applicant Top Shelf Entertainment, Inc. ("Applicant") hereby requests that the Examining Attorney reconsider its Office Action related to Trademark Application No. 0943017 (the "Application").

1. There is no Likelihood of Confusion.

The Examining Attorney has refused registration of Applicant's request to register the following mark for outerwear, namely, hats, jerseys and sweatshirts (IC 025) and Entertainment in the nature of hockey games (IC 041):

The Examining Attorney has granted excessive protection to the cited registration, and has improperly relied upon third party registrations as evidence of possible confusion. Therefore, the Examining Attorney should reconsider its decision and approve the pending application.

a. The Cited Registration.

The Examining Attorney has cited registration (No. 0943017)(the "Cited Registration") as the reason for refusal for granting the Application. However, the Cited Registration is

necessarily weak, not confusing as related to field of service and should not act as a bar for registration of the applied for mark.

The commercial impression of the marks is very different, and the Application should be allowed to proceed. Further, Applicant is amending its description of goods to only include pathology software.

b. The Owner of the Cited Registration has no fame.

There is simply no way the average consumer would confuse the Application with the Cited Registration.

The Examining Attorney has relied upon a third-party registration to allegedly show that the goods or service in the Application are related to those in the prior registration. It should be noted that the Federal Circuit has often criticized the evidentiary weight of registration as evidence of buyer perceptions. *Olde Tyme Foods, Inc. v. Roundys, Inc*., 961 F.2d 200, 22 U.S.P.Q.2d 1542 (Fed. Cir. 1992) ("as to strength of a mark, however, registration evidence may not be given any weight."). "The purchasing public is not aware of registrations reposing in the Patent and [and trademark] office and though they are relevant, in themselves they have little evidentiary value on the issue before us." Smith Bros. *Manufacturing Co. v. Stone Manufacturing Co*., 476 F.2d 1004, 177 U.S.P.Q. 462 (CCPA 1973); *see also, AMF, Inc. v. American Leisure Products, Inc.,* 474 F.2d 1403, 177 U.S.P.Q. 268 (CCPA 1973).

Only the fame of the registered mark, if present and established, is relevant to ex parte likelihood of confusion analysis. *See In re E. I. du Pont de Nemours & Co*., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973).

Attached hereto please find information showing the use of the Cited Registration. The Cited Mark and mark in the Application look completely different, and present in a very different manner. Therefore, with the information already presented, it can be said that the "fame" of the owner of the Cited Mark is negligible and does not counter-act the great deal of marketing and substance from the Applicant related to its goods.

2. <u>No evidence is presented of direct conflict.</u>

The Examining Attorney did not provide any direct evidence that the goods offered by the Applicant and the owner of the Cited Registration travel in the same channels at all. Advertising on the Internet is ubiquitous and "proves little, if anything, about the likelihood that consumers will confuse similar marks used on such goods or services. *Kinbook, LLC v. Microsoft Corp*., 866 F.Supp.2d 453, 470–71 n. 14 (E.D.Pa.2012) (*quoting* J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 24:53.50 (4th ed. Supp. 2011)). The Cited Registration is weak, and not subject to broad protection. *See McGregor-Doniger, Inc. v. Drizzle, Inc.,* 599 F.2d 1126, 1131 (2d Cir. 1979) (strength in a mark is found when consumers identify the goods as identifiable as to a particular source). "The more distinctive a . . . servicemark, the greater the likelihood that consumers will associate the registered mark and all similar marks with the

registered owner." *Freedom Sav. & Loan Ass'n v. Way*, 757 F.2d 1176, 1182 (11th Cir. 1985). This case is more similar to *Jacobs v. International Multifoods Corp.,* 668 F.2d 1234, 1236 (CCPA 1982), where the court held that the fact that restaurants serve food and beverages is not enough to render food and beverages related to restaurant services for purposes of determining the likelihood of confusion. *See also In re St. Helena Hosp*., 774 F.3d 747 (Fed. Cir. 2014)(just because party's healthcare products and services could be offered to the same company does not mean they are related enough to make confusion likely).

A mark may be "weak" in the sense that it is descriptive, highly suggestive, or is in common use by many other sellers in the market. *See Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F. 2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970). If the common elements of conflicting marks are "weak" then this reduces the likelihood of confusion. *See Nestlé's Milk Products, Inc. v. Baker Importing Co*., 182 F.2d 212, 139 U.S.P.Q. 80 (C.C.P.A. 1950) (comparing HYCAFE and NESCAFE); *Gruner + Jahr USA Publishing v. Meredith Corp.,* 991 F.2d 1072, 26 U.S.P.Q.2d 1583 (2d Cir. 1993) (comparing PARENTS and PARENTS DIGEST). Where numerous different parties use marks that contain a common term for related goods or services, the common element is weak. *Id.* Thus, evidence of third party use and registration of similar marks is admissible and relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection. *Id.; see also Sweats Fashions, Inc. v. Pannill Knitting Co*., 4 U.S.P.Q.2d 1793 (Fed. Cir. 1987); *In re J.M. Originals Inc.,* 6 USPQ2d 1393, 1394 (TTAB 1987).

Based on the foregoing, Applicant requests that the mark proceed to registration.

3. <u>The Examining Attorney cites only Class 41, ignoring the application for Class 025.</u>

No evidence or discussion is presented related to Class 025, nor is any registration cited barring registration in that Class by the Examining Attorney. Therefore, should the Examining Attorney continue the objection to registration it should only be as to