

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
PENTZ TM HOLDINGS, LLC
Serial No: 88484200
Filed: June 21, 2019
Class: 9
Mark:
HIGHER GROUND

Trademark Examining Attorney
C. Dionne Clyburn
Law Office: 110
RESPONSE TO OFFICE ACTION

Dear Ms. Clyburn:

Applicant Pentz TM Holdings, LLC (“Applicant”) responds to the Office Action dated September 19, 2019 as follows:

A. LIKELIHOOD OF CONFUSION REFUSAL

Applicant submits that there is no likelihood of confusion between Applicant’s mark and the following registrations cited in the Office Action: (1) HIGHGRND, Registration No. 5126264 and (2) HIGHER GROUND ENTERPRISES, Registration No. 5260404 (collectively “Cited Registrations”).

1. The Goods Covered By Applicant’s Mark And The Service Covered By The Mark HIGHER GROUND ENTERPRISES Are Materially Different And Non-Competitive

Here, Applicant is using the HIGHER GROUND mark in connection with a record label that releases audio and video recordings for music artists including on online music stores such as iTunes and music streaming services such as Spotify. In contrast,

the cited HIGHER GROUND ENTERPRISES mark is being used in connection with book publishing services. (See Exhibit 1 hereto.) Hence, the owner of the cited HIGHER GROUND ENTERPRISES mark uses the slogan: “Get your book on higher ground!”. (See Exhibit 1 hereto.)

Put simply, Applicant’s audio and video recordings of music artists are not competitive with the services being rendered under the cited HIGHER GROUND ENTERPRISES mark. Such differences are very meaningful to the consuming public and are sufficient to avoid a likelihood of confusion. See e.g. *In re Sears, Roebuck & Co.*, 2 U.S.P.Q.2d 1312, 1314 (TTAB 1987) (finding “competitive distance” between different types of clothing having different uses and that may be sold in different sections of department stores.)

2. Applicant’s Mark And The HIGHGRND Mark Are Materially Dissimilar

When determining whether marks are similar, it is important to compare the marks “as to appearance, sound, connotation and commercial impression”. *In re E.I. Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (CCPA 1973). Here, the marks are dissimilar for at least the following reasons.

Applicant’s HIGHER GROUND mark and the cited HIGHGRND mark have completely different appearances. More specifically, Applicant’s HIGHER GROUND mark consists of two words, whereas the cited HIGHGRND mark consists of one “word” with fanciful spelling. Accordingly, the two marks make distinctly difference commercial impressions. This difference is particularly significant because “[s]everal courts have noted that purchasers of music are generally sophisticated . . .” *Medici Classics Productions, LLC v. Medici Group, LLC*, 683 F.Supp.2d 304, 311 (S.D.N.Y. 2010).

3. The Cited Registrations Are Not Likely To Be Confused With Applicant's Mark And Are Only Entitled To Very Narrow Protection

The strength or weakness of a cited mark can be the most important factor in determining whether there is a likelihood of confusion with an applicant's mark. *In re: Hartz Hotel Services Inc.*, 102 U.S.P.Q.2d 1150 (TTAB 2012) (“[B]ecause of the highly suggestive nature of GRAND HOTEL and the number of third-party marks, consumers are able to distinguish between GRAND HOTEL marks based on small differences in the marks. . .”); also see *The Board of Trustees of the University of Alabama v. Pitts*, 107 U.S.P.Q.2d 2001(TTAB 2012) (Third-party uses consisting of websites selling competitive products evidence public awareness that the products at issue originated with parties other than those opposing registration of applicant's mark).

Here, Applicant has submitted substantial evidence of third-party uses of the HIGHER GROUND mark on the internet in connection with entertainment related businesses. (See Exhibits 2, 3, 4 and 5 hereto.) More specifically, Applicant has submitted evidence of the following such third-party uses of marks: (1) HIGHER GROUND ENTERPRISES at the website www.onhigherground.net (Exhibit 2 hereto), (2) HIGHER GROUND ENTERTAINMENT at the website www.highergroundentertainment.org (Exhibit 3 hereto), (3) HIGHER GROUND ENTERTAINMENT at the website www.higherground.com (Exhibit 4 hereto), (4) HIGHER GROUND ENTERTAINMENT at the website www.hgekc.com (Exhibit 5 hereto), and (5) HIGHER GROUND PROMOTIONS at the website www.highergroundpromo.net (Exhibit 6 hereto).

Under the authorities cited above, the substantial evidence of third-party uses of the HIGHER GROUND mark on the internet establishes that the Cited Registrations are entitled to only “a very narrow scope of protection or exclusivity of use”. *In re: Hartz Hotel Services Inc.*, *supra*. The cited authorities and evidence also establish that

consumers will be able to distinguish any of Applicant's audio and video recordings based on the difference in wording of its mark and the Cited Registrations. *1-800 Contacts, Inc. v. WhenU.com*, 309 F.Supp.2d 467, 502 (S.D.N.Y. 2003) ("Internet shoppers have a specific product in mind when they go online and have the ability to navigate the internet to get what they want").

B. CONCLUSION

In light of the above, Applicant respectfully requests that the Examining Attorney withdraw her refusal to register Applicant's mark.

DATED: March 19, 2020

By: /Ralph C. Loeb/
Ralph C. Loeb
KRANE & SMITH, APC
16255 Ventura Boulevard, Suite 600
Encino, CA. 91436
(818) 382-4000 Telephone
(818) 382-4001 Facsimile
ralph@kranesmith.com
Attorneys for Applicant Pentz TM
Holdings, LLC