Applicant: Hive Games Limited

Serial No.: 88613170

Filed: September 11, 2019

Mark: HIVE

Examining Attorney: Cassandra Anderson, Law Office 103

APPLICANT'S RESPONSE TO OFFICE ACTION

This response is made to the Office Action dated October 7, 2019. In this action, the Examining Attorney refused registration of the Applicant's HIVE design mark on the following grounds: (1) The mark is likely to be confused with HIVE HOPPER (Registration No. 4808423), EVENT HIVE and design (Registration No. 5258152), and BUILD YOUR HIVE (Registration No. 5583519); (2) The mark is not entitled to register in light of pending trademark applications: PLAYHIVE (Serial No. 88046758), HIVE MIND PRODUCTIONS (Serial No. 88404176), HIVE MIND (Serial No. 88404191), and HIVE (Serial No. 88574299); (3) Amendment to the drawing and description thereof is required to match the specimen; and (4) Modification of application to signify representation of a U.S. licensed attorney is required.

Applicant respectfully disagrees with the Examining Attorney's substantive refusals of the Applicant's mark. Applicant submits that there are significant distinctions between the Applicant's mark and the cited marks, as well as the goods and services offered in connection therewith. These distinctions are sufficient to prevent likelihood of confusion as to whether the goods come from or are in some way associated with the same source. Applicant further seeks to amend the application record as requested in order to proceed with registration of the trademark.

I. SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

"The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used." *In re National Data Corp*., 53 F.2d 1056, 1058 (Fed. Cir. 1985) (emphasis added); *see also* TMEP §1207.01(b)-(b)(v). Likelihood of confusion between two marks is determined by a review of all of the relevant factors under the *du Pont* test, including: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) The similarity or dissimilarity and nature of the goods or services as described in an application or

registration or in connection with which a prior mark is in use; (3) The similarity or dissimilarity of established, likely-to-continue trade channels; (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing; (5) The fame of the prior mark (sales, advertising, length of use); (6) The number and nature of similar marks in use on similar goods; (7) The nature and extent of any actual confusion; (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). The Examining Attorney cited but a few of these factors in the September 27, 2019 Office Action, namely the similarity of the marks and relatedness of the goods.

A) Similarity of the Marks

Trademarks "are not similar for purposes of assessing likelihood of confusion simply because they contain an identical or nearly identical word[.]" *Mejia & Assocs. v. IBM Corp.,* 920 F. Supp. 540, 547 (S.D.N.Y. 1996). The Federal Circuit has long held that *all* additional components should be considered in determining whether marks that contain a single identical term are similar in sight, sound, meaning, and commercial impression for the purpose of assessing likelihood of confusion. *See, e.g., W.W. Pharmaceutical Co., Inc. v. Gillette Co.*, 984 F.2d 567, 573 (2d Cir. 1993) (plaintiff's mark SPORTSTICK for lip balm was not similar to defendant's mark RIGHT GUARD SPORT STICK for deodorant); *Lang v. Retirement Living Publishing Co*., 949 F.2d 576, 581–82 (2d Cir. 1991) (although both marks included the term "New Choices," the general impression conveyed by the designations was different); *Int'l Data Group, Inc. v. J & R Elecs., Inc.,* 798 F. Supp. 135, 139 (S.D.N.Y.), *aff'd*, 986 F.2d 499 (1992) (J & R COMPUTER WORLD was not confusingly similar to COMPUTERWORLD and the general impression created by the marks differed significantly). Accordingly, "[t]he commercial impression of a trademark [sic] is derived from it as a whole, not from its elements separated and considered in detail." *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents,* 252 U.S. 538, 545-46 (1920).

The Federal Circuit, for example, held that the applicant's M2 COMMUNICATIONS mark, applied for in connection with the use in the sale of computer software, was not identical to the opposing party's registered M2 mark used in the sale of computer software even when the court considered the applicant's disclaimer of the term "Communications." *M2 Software, Inc. v M2 Communications, Inc*., 450 F.3d 1378, 1381 (Fed. Cir. 2006). The overlap between the marks, if any,

was considered *de minimis*. *Id*. at 1381. Similarly, in *In re Hearst Corp.,* the Court found that conflicting marks VARGA GIRL and VARGAS, both utilized in the paper goods marketplace, were sufficiently distinct despite the fact that both marks contained variations of the term "VARGA". 982 F.2d 493, 494 (Fed. Cir. 1992) ("Although the weight given to the respective words is not entirely free of subjectivity, we believe that the Board erred in its diminution of the contribution of the word 'girl'. When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.").

The Examining Attorney asserts that there is a likelihood of confusion between Applicant's HIVE mark and cited marks in Registration Nos. 4808423 (HIVE HOPPER), 5258152 (EVENT HIVE), and 5583519 (BUILD YOUR HIVE). Examining Attorney's argument is based in pertinent part on the fact that the cited marks encompass the entirety of Applicant's HIVE mark. Applicant respectfully disagrees, however, and implores the Examining Attorney to consider the substantial differences between the overall impression created by Applicant's HIVE mark and the cited marks in terms of sight, sound, and meaning.

i) HIVE HOPPER (Registration No. 4808423)

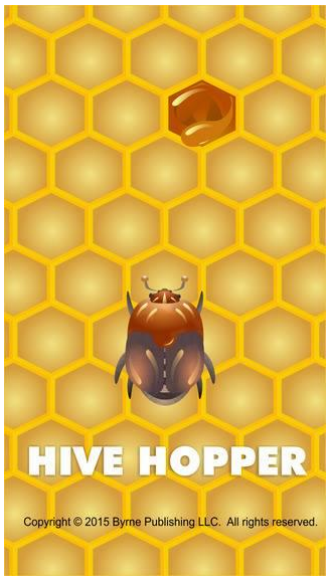
The first cited HIVE HOPPER mark and Applicant's HIVE mark both share the term "HIVE" in the video game marketplace, but are significantly distinct in terms of sight, sound, connotation, and overall commercial impression upon the consumer.

First and foremost, the cited marks are distinct in sound. Applicant's HIVE mark has one syllable while HIVE HOPPER consists of two words and comprises three syllables. While the marks both contain the term "HIVE", such overlap is not sufficient to counteract the aural dissimilarity of the remaining elements of the marks. *See Universal City Studios, Inc. v. Nintendo Co.,* 746 F.2d 112, 117 (2d Cir. 1984) (finding that the conflicting DONKEY KONG and KING KONG marks were different in their entirety and that there was no similarity between the marks as to sound despite sharing the word KONG).

Secondly, the cited marks are also distinct in sight. Applicant's HIVE mark has a distinct visual appearance relative to the HIVE HOPPER mark by virtue of the absence of the term "HOPPER". Moreover, Applicant's HIVE mark is also much shorter than the cited HIVE HOPPER mark, which contains ten letters instead of the four contained in "HIVE". Applicant's HIVE mark is further distinguished by the overall appearance of the mark. The literal element, "HIVE", is represented in

Applicant's mark with bright yellow, highly-stylized font with gradient coloring and block-like texture. Registrant's HIVE HOPPER mark, on the other hand, appears in various settings- particularly as non-stylized white text on a yellow backdrop.

Applicant's HIVE design mark



via www.facebook.com/hivehopper

Thirdly, the cited marks are dissimilar in meaning and connotation. The meaning of the term "HIVE" as utilized in Applicant's mark refers to a hub of production and innovation akin to the ever so productive beehive. HIVE HOPPER is distinct in that the additional term "HOPPER" serves as a present participle to describe the *player's* actions in connection with the noun, "HIVE".

As evidenced in the specimen submitted alongside the HIVE HOPPER trademark application, the mark appears to consumers as a game title in the mobile game marketplace. This creates a distinct commercial impression from Applicant's HIVE mark, which is utilized not as a game title, but as the source signifier for various forms of downloadable video game software to be played in conjunction with *Minecraft*, a video game that offers various downloadable expansions such as that offered by Applicant under the HIVE mark.[1] Rather than simply a single game name, Applicant's HIVE is utilized to signify an individual server for use in playing the game *Minecraft*, one of many and one of

[1] Information about the game *Minecraft* can be found at https://www.minecraft.net/en-us/. The products offered under Applicant's HIVE mark can be found at https://hivemc.com/.

the most popular and successful.[2] Additional information about Applicant's goods/services and how they differ from that of the cited registration can be found in Section II B(i) below.

ii) EVENT HIVE and design (Registration No. 5258152)

The second cited EVENT HIVE mark and Applicant's HIVE mark also share the term "HIVE", but remain significantly distinct in terms of sight, sound, connotation, and overall commercial impression upon the consumer.

As with HIVE HOPPER, the EVENT HIVE mark and Applicant's HIVE mark are distinct in sound. Applicant's HIVE mark only has one syllable while EVENT HIVE consists of two words and comprises three syllables. Once again, the overlap of the word HIVE alone is not sufficient to counteract the aural dissimilarity of the remaining elements of the respective marks.

Secondly, the cited marks are sufficiently distinct in sight. By virtue of the absence of the term "EVENT", Applicant's mark has a distinct visual appearance relative to the EVENT HIVE mark. Moreover, Applicant's HIVE mark is distinctively short, as it only contains four letters while the cited EVENT HIVE mark contains nine. It is also relevant that the EVENT HIVE mark begins with an entirely different term, "EVENT", which further serves to preclude likelihood of confusion between the marks. In addition to the distinct nature of the literal elements therein, the design marks are also distinct in visual appearance. While Registrant's EVENT HIVE mark exists in the marketplace in various different forms,[3] the registered mark is a stylized version of the literal element, "EVENT HIVE" with a hexagon bordering the text. As pictured below, the marks are clearly distinct in that Applicant's HIVE mark does not utilize or imply the use of a hexagon in any manner. Furthermore, Applicant's HIVE mark is shown in its entirety in uppercase lettering, while the EVENT HIVE mark is a mixed variation of upper and lowercase type. The HIVE mark is further distinguished by the block-like lettering utilized in Applicant's mark. Conversely, the EVENT HIVE mark has much softer, rounded edging in both its lettering and design which creates an entirely different impression and appearance.

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[2] *See, e.g., The Best Minecraft Servers*, PCGAMESN (Mar. 13, 2020), https://www.pcgamesn.com/minecraft/15-best-minecraft-servers; Ollie Toms, *Best Minecraft servers 1.15 – Survival servers, Hunger Games, and more*, ROCK PAPER SHOTGUN (Mar 20, 2020), https://www.rockpapershotgun.com/2020/03/20/best-minecraft-servers-1-15-survival-servers-hunger-games-and-more-2/.

[3] The EVENT HIVE mark is used in a different manner than the registered mark on the Event Hive website located at https://www.eventhive.com/.

Applicant's HIVE design mark

EVENT HIVE
Design Mark Reg. No. 5258152

Thirdly, the cited marks are also dissimilar in meaning and connotation. EVENT HIVE, unlike HIVE alone as used by the Applicant, generates an entirely different mental image pertaining primarily to the dominant term of the mark, "EVENT". In the context of the cited EVENT HIVE mark, the additional term "HIVE" merely serves to provide creative imagery as to the size and nature of the service.

Finally, the Examining Attorney further proposes that the presence of a design element in the cited EVENT HIVE mark does not obviate the possibility of likelihood of confusion between EVENT HIVE and Applicant's HIVE mark based on the notion that the word portion of the mark is often considered to be the dominant feature and is therefore afforded greater weight in determining whether marks are confusingly similar. *In re Viterra Inc.,* 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.,* 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). Courts have evaluated marks *as they appear in the marketplace* in their entirety, however, which includes an analysis of how the marks are used and displayed to the consumer. *See Barbecue Marx, Inc. v. 551 Ogden, Inc.,* 235 F.3d 1041, 1044 (7th Cir. 2000) (taking into consideration the impact of the written form of the competing marks, including the design elements thereof, as the public was to encounter the marks in such form). Applicant urges the Examining Attorney to take such distinctions into account, especially in light of the fact that the EVENT HIVE trademark registration does not purport to claim protection over the standard characters of the mark. Accordingly, the EVENT HIVE mark should only be afforded the narrowly tailored protection of preventing likelihood of

confusion as to how the mark appears in the USPTO database with claim to the particular font style, size, or color referenced in the application.

iii) BUILD YOUR HIVE (Registration No. 5583519)

The third and final cited BUILD YOUR HIVE mark also shares the term "HIVE" with Applicant's HIVE mark. Again, similar to the above, however, the cited BUILD YOUR HIVE mark and Applicant's HIVE mark are significantly distinct in terms of sight, sound, connotation, and overall commercial impression upon the consumer.

First, the Applicant's HIVE mark only has one syllable while BUILD YOUR HIVE consists of three words and comprises three syllables. Once again, the overlap of the word HIVE alone is not sufficient to counteract the aural dissimilarity of the remaining elements of the respective marks. Secondly, the cited registration and Applicant's HIVE mark are sufficiently distinct in sight. By virtue of the absence of several terms, including "BUILD" and "YOUR", Applicant's mark has a distinct visual appearance relative to the BUILD YOUR HIVE mark. Moreover, Applicant's HIVE mark is incredibly short, as it only contains four letters while the cited BUILD YOUR HIVE mark contains thirteen letters. The BUILD YOUR HIVE mark also consists of several words, with "HIVE" being one component among many. It is further relevant that the BUILD YOUR HIVE mark is not utilized in a stylized manner beyond the literal element of the term "BUILD YOUR HIVE".[4] This is distinct from the manner and method in which Applicant's HIVE design mark appears, as the BUILD YOUR HIVE mark merely tends to appear as a non-stylized, informational slogan. Applicant's HIVE design mark, on the other hand, is highly stylized and, accordingly, appears drastically different.

Applicant's HIVE design mark

BUILD YOUR HIVE

BUILD YOUR HIVE
Reg. No. 5583519

[4] *See, e.g.*, Cassie Murdock, *Bumble is opening an IRL hive where you can meet your dates*, Mashable (Jun. 2, 2017), https://mashable.com/2017/06/02/bumble-irl-hive-nyc/#FGWZ1IRjGiqz ("Bumble has allowed you to build your hive digitally, and now we're giving you an extension of that physically."); Karl Klockars, *Bumblr Review*, PCMag (Feb. 11, 2019), https://www.pcmag.com/reviews/bumble ("After your first sign-in, the app explains that Bumble is where you build your Hive (which is its term for everyone you can meet on the app—love interests, new friends, and even business partners) and promises to be "the easiest and safest way" to create connections.").

Thirdly, the marks are also dissimilar in meaning and connotation for the purpose of avoiding likelihood of confusion. BUILD YOUR HIVE is a suggestion to the consumer and serves to describe the nature of the underlying product and the purpose: to create a network of social media contacts. Applicant's HIVE mark, on the other hand, does not command the user to do or take action on any goal and creates an entirely distinct mental image from the cited BUILD YOUR HIVE trademark.

B) Relatedness of the Goods

In assessing the relatedness of the goods and/or services, the more similar the marks at issue, the less similar the goods or services need to be to support a finding of likelihood of confusion. TMEP § 1207.04(a*); In re Shell Oil Co.,* 992 F.2d 1204, 1207 (Fed. Cir. 1993). If the marks of the respective parties are identical or virtually identical, the relationship between the goods and/or services need not be as close to support a finding of likelihood of confusion as would be required if there were differences between the marks. *Id*. at 1207, *In re Davey Prods. Pty Ltd.,* 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.,* 90 USPQ2d 1634, 1636 (TTAB 2009).

Confusion is not likely, however, 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, then, even if the marks are identical. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1371 (Fed. Cir. 2012) (affirming the Board's dismissal of opposer's likelihood-of-confusion claim, noting "there is nothing in the record to suggest that a purchaser of test preparation materials who also purchases a luxury handbag would consider the goods to emanate from the same source" though both were offered under the COACH mark); *Shen Mfg. Co. v. Ritz Hotel Ltd.,* 393 F.3d 1238, 1244-45 (Fed. Cir. 2004) (reversing TTAB's holding that contemporaneous use of RITZ for cooking and wine selection classes and RITZ for kitchen textiles is likely to cause confusion, because the relatedness of the respective goods and services was not supported by substantial evidence); *Local Trademarks, Inc. v. Handy Boys Inc.,* 16 USPQ2d 1156, 1158 (TTAB 1990) (finding liquid drain opener and advertising services in the plumbing field to be such different goods and services that confusion as to their source is unlikely even if they are offered under the same marks). Notably, when relatedness of the goods and services is neither evident, well known, or generally recognized, "something more" than the mere fact that the goods and services are used together must be shown. *In re St. Helena Hosp.,* 774 F.3d at 754, 113 USPQ2d at 1087 (finding that substantial evidence did not support relatedness of hospital-based

residential weight and lifestyle program and printed materials dealing with physical activity and fitness).

Applicant utilizes the HIVE mark in connection with the following listed goods identified in International Class 009: "Downloadable computer game software; Downloadable computer game software for personal computers and home video game consoles; Downloadable electronic game software; Downloadable electronic game software for handheld electronic devices; Downloadable electronic game software for wireless devices; Downloadable video and computer game programs." The HIVE mark is particularly utilized to designate Applicant's business, Hive, as the developer of downloadable video game software in connection with *Minecraft*. The Applicant offers mini-games through *Minecraft* under the HIVE mark, and such games may only be accessed and downloaded with a *Minecraft* account and through the *Minecraft* platform.

The Examining Attorney states that the goods offered under Applicant's HIVE mark are closely related to the goods and services offered under the cited registration. Applicant respectfully disagrees with this conclusion, however, and asserts that the goods offered under Applicant's HIVE mark are substantially distinct from the goods and services offered under the competing marks. Applicant addresses such distinctions in turn. Moreover, even if the cited marks offer goods which tend to exist in a similar marketplace, the Applicant asserts that the requirement of "something more" to prove that confusion may result from these similarities has not been met due to the Applicant's distinct use of the HIVE mark and the specific manner in which the Applicant offers goods thereunder.

i) HIVE HOPPER (Registration No. 4808423)

The HIVE HOPPER mark is registered in International Class 009 for use in connection with "game software". Diligent efforts by Applicant to locate current use of the HIVE HOPPER mark in connection with such products were unsuccessful, as the product evidenced in the specimen to be offered under such mark is evidently no longer available for purchase or download in the video game marketplace. Accordingly, while Applicant does not petition to cancel the HIVE HOPPER at this time, Applicant refers to the use of the HIVE HOPPER mark as previously evidenced in the specimen submitted in connection with such application for the sake of convenience. In light of such specimen, it appears that the HIVE HOPPER mark was (or is) utilized as the name of a downloadable mobile game on the iTunes App Store.

The Examining Attorney appears to rely on the assumption that the goods offered under Applicant's HIVE mark and the goods offered under HIVE HOPPER are sufficiently related for the purpose of determining likelihood of confusion because, in part, the marks are categorized into the same class of goods and pertain to the activity of gaming in some capacity. The mere fact that the goods offered under the cited marks are games, however, does not necessarily result in an assumption that consumers will be confused as to the source of the goods. *See, e.g., Echo Drain v. Newsted,* 307 F. Supp. 2d 1116, 68 U.S.P.Q.2d 1203 (C.D. Cal. 2003) (pop rock band and band that plays "progressive funk and groove with elements of heavy metal" were deemed unrelated, even though both marks pertained to music).

First and foremost, the HIVE HOPPER mark is utilized as a *game title*, which means that consumers of video game software will encounter the HIVE HOPPER mark only as it pertains to an individual game offered by a developer. Applicant's HIVE mark, on the other hand, is utilized in a manner which serves to identify the Applicant as the developer of downloadable *Minecraft* mini games.

Secondly, the games are substantially different in form, function, accessibility, and overall existence. Even if consumers are interested in playing video games, those who do not own or utilize *Minecraft* may not be able to access and download the games offered under Applicant's HIVE mark because *Minecraft* is functionally required in order to access and download the games. Unlike the Apple App store or the Google Play store, a consumer's hardware does not come stocked with *Minecraft* software. Those who purchase and download *Minecraft* are doing intentionally for a certain purpose as the level of sophistication of this consumer is quite high compared to, for instance, the mobile gamer who downloads games typically based on top reviews on the relevant pre-loaded app store. The game offered under the HIVE HOPPER mark, on other hand, is not at all associated with *Minecraft* and, as a result, does not exist in the same marketplace. Instead, it is one of the games purported to be available on mobile devices through the app stores described above. Therefore, while the goods offered under the cited registration and Applicant's mark are both technically classified as video games, there are various factors that distinguish them including consumer accessibility, consumer sophistication, game style and substance, software platforms, and the overall interactive experience.

ii) EVENT HIVE and design (Registration No. 5258152)

While the EVENT HIVE trademark is registered for use in connection with various goods listed under International Class 009, none of these goods are explicitly related to the video game marketplace and focus on corporate needs, including event planning and business organization software. In pertinent part, the EVENT HIVE trademark is registered for use in connection with providing the service of "computer and video games development; creation of computer graphics; design and development services in relation to computer and video games and interactive entertainment products" in International Class 042.

The EVENT HIVE trademark differs most predominantly from Applicant's HIVE mark in that it serves to designate the source of *services* provided for others. The HIVE trademark, conversely, designates the source of *goods* in the form of downloadable video game software. The nature of providing *goods* under a trademark versus providing *services* under a trademark are fundamentally distinct, and in many cases can serve to differentiate the marks even if there are, in some cases, instances of overlap in the relevant marketplaces. *See, e.g., Leathersmith of London, Ltd. v. Alleyn*, 695 F.2d 27 (1st Cir. 1982) (leather products and small, custom leather goods business were deemed unrelated); *Therma-Scan, Inc. v. Thermoscan, Inc.*, 295 F.3d 623, 63 U.S.P.Q.2d 1659 (6th Cir. 2002) (service of performing infrared thermal imaging exam on human body and hand-held electronic ear thermometers were deemed unrelated). Individuals who seek out products under Applicant's HIVE mark are not seeking video game development services but are looking to play a video game and partake in an interactive experience.

Furthermore, it is not apparent to Applicant that the EVENT HIVE trademark is utilized in the course of offering video game development services for other parties. While EVENT HIVE may offer video game development services in some capacity, the provision of these services does not tend to overlap with the goods offered under Applicant's HIVE mark as addressed above.

iii) BUILD YOUR HIVE (Registration No. 5583519)

The BUILD YOUR HIVE mark is registered for use in connection with various identified goods and services predominantly focused on computer dating software, yet includes "computer games, namely, computer game software; electronic game programs" in International Class 009. As similarly noted in the previous section, it is not evident to Applicant that the BUILD YOUR HIVE trademark is genuinely utilized in the course of offering video games. Regardless of such obscurity despite good faith efforts to determine the exact nature of use of the BUILD YOUR HIVE mark in

connection with downloadable video game software, Applicant purports that the goods offered under its HIVE mark are sufficiently distinct to avoid likelihood of confusion.

Furthermore, as evidenced by the description of goods for BUILD YOUR HIVE, the mark is predominantly used in connection with providing downloadable dating applications for adults. The goods offered under Applicant's HIVE mark are distinct from this in that they are intended for children above the age of 13 and do not require the player to take part in communicating with others or discussing relationships in any capacity. In fact, the rules of the "chat" function of games offered under the HIVE mark require users to "[k]eep the chat PG-13 at all times," and refrain from taking part in adult activities such as swearing.[5] This is substantially distinct from the downloadable software alleged to be offered under the BUILD YOUR HIVE mark, which is purported to "facilitat[e] communication between individuals based upon geographic location, mutual interests, age, profession, appearance, relationship preferences, and sexual preferences." Regardless of whether the software offered under the BUILD YOUR HIVE mark is offered in connection with video games, it is apparent that the product sought by the user in downloading software offered under the BUILD YOUR HIVE mark is substantially distinct from that experience sought by the player downloading games offered under the Applicant's HIVE mark. Applicant pleads that the Examining Attorney take into account these differences when determining whether there is truly a likelihood of confusion among the goods offered under the cited marks.

C) Similarity of Trade Channels & Class of Purchasers

While the Examining Attorney has not rejected Applicant's HIVE trademark in light of other *du Pont* factors, including channels of trade and class of purchasers, Applicant finds these factors relevant in support of its argument.

i) Channels of Trade

The channel of trade factor analyzes the extent to which the cited marks differ in regard to where, how, and to whom the goods and services are distributed. *Frehling Enterprises, Inc. v. Int'l Select Group, Inc.*, 192 F.3d 1330, 1339, 52 U.S.P.Q.2d 1447 (11th Cir. 1999). Particularly relevant to this factor is the nature in which the goods are actually distributed and consumed by customers in the relevant marketplace. *Moore Business Forms, Inc. v. Ryu*, 960 F.2d 486, 490, 22 U.S.P.Q.2d 1773

[5] *What are the rules?*, HIVE GAMES LIMITED, https://hivemc.com/support/17/what_are_the_rules.

(5th Cir. 19 92) ("Dissimilarities between the retail outlets 'lessen the possibility of confusion, mistake, or deception.'")

As previously noted, it is apparent that Applicant's HIVE mark travels in a particularly distinct channel of trade. It predominantly serves to provide downloadable mini game content to individuals who seek out or are already utilizing the underlying program, *Minecraft*. The cited marks, including HIVE HOPPER, EVENT HIVE, and BUILD YOUR HIVE do not travel in this same channel of trade and are not available in connection with the same platform.

ii) Class of Purchasers & Degree of Care

The class of prospective purchasers and degree of care exercised by such purchasers can play a role in the determination of whether there is a likelihood of confusion between cited marks. This *Du Pont* factor requires an analysis of what type of purchaser is bound to purchase the goods and services offered under the mark, and whether such purchasers tend to exercise a higher degree of care based on the underlying goods/services offered thereunder. *See Wynn Oil Co. v. American Way Service Corp.*, 943 F.2d 595, 602, 19 U.S.P.Q.2d 1815 (6th Cir. 1991) ("In general, the less care that a purchaser is likely to take in comparing products, the greater the likelihood of confusion.").

In most cases, the selection and download of a video game is not simply one of "click and play". Most if not all consumers of video games and entertainment products such as those offered under Applicant's HIVE mark will seek out further, detailed information about downloadable video game software before committing to a purchase. Such research may include a brief look into information regarding the developer or creator of the game, the genre, and the underlying software requirements. An ordinary consumer seeking a puzzle game, for example, would not decide to download a random game in hopes that the content therein meets their criteria.

Applicant hereby urges the Examining Attorney to take into account the sophistication of consumers in the video game marketplace, especially as applied to the products it distributes under the HIVE mark. Users are not likely to mistakenly purchase or download Applicant's products as a result of confusion with the cited marks due to various factors, including the additional software-related steps required for accessing Applicant's software through *Minecraft*. The manner and method in which the Applicant's goods can be acquired require the consumer to have a high-level understanding of the product itself, and Applicant hereby asserts that this requirement further distinguishes and strengthens the Applicant's HIVE trademark for the purpose of determining likelihood of confusion.

D) Conclusion

Applicant respectfully asks the Examining Attorney to reconsider the decision to refuse registration of Applicant's HIVE trademark based on likelihood of confusion with HIVE HOPPER (Registration No. 4808423), EVENT HIVE and design (Registration No. 5258152), and BUILD YOUR HIVE (Registration No. 5583519) based on the foregoing analysis of the *Du Pont* factors addressed above.

II. PENDING MARKS

The Examining Attorney has noted that the filling dates of pending U.S. Application Serial Nos. 88046758, 88404176, 88404191 and 88574299 precede Applicant's filing date and may result in a suspension pending final disposition of the applications. Applicant elects not to submit arguments at this time. As stated by the Examining Attorney, Applicant's election not to submit arguments at this time in no way limits Applicant's right to address these issues later should a refusal under Section 2(d) be issued.

III. AMENDMENT TO DRAWING AND DESCRIPTION

The Examining Attorney further noted that refusal of Applicant's HIVE design mark was refused because the specimen does not show the mark in the drawing in use in commerce in International Class 009. Specifically, the Examining Attorney has noted that the drawing displays the mark as stylized wording "HIVE" on a specific background, but asserts that the mark on the specimen does not match the mark in the drawing because the background elements are missing from the specimen. The Examining Attorney has invited the Applicant to submit a new drawing of the mark that shows the mark on the specimen and, if appropriate, an amendment to the description that agrees with the new drawing.

Accordingly, Applicant hereby amends the mark in the drawing to reflect the following:

Applicant further amends the description to the following, as suggested by the Examining Attorney:

"The mark consists of a literal element, the 3-dimensional capital letters "H," "I," "V," and "E." The bottom half of the letter "V" features a 90 degree indentation from the left and the right sides."

IV. MODIFICATION – REPRESENTATION OF U.S. ATTORNEY

Applicant agrees to submit a consecutive amendment with this Response in order to ensure that requirements regarding representation of a licensed U.S. Attorney are met in accordance with the Office Action.

Regards,

Allison Rothman
MORRISON ROTHMAN LLP