

Trademark Law Office No.: 114
Serial Number: 88706851
Mark: REMEDY

TO: Breanna Freeman, Examining Attorney
Law Office 114

FROM: Michael A. Penn, Attorney for Applicant
APPLICANT: Remedy Films, LLC
MARK: REMEDY
Serial Number: 88706851

RE: Response to NONFINAL OFFICE ACTION issued March 9, 2020

DATE: May 7, 2020

The Applicant wishes to thank the Examining Attorney for the Office Action on the Trademark application referenced above, and acknowledges the Summary of Issues identified as follows:

1. Prior-Filed Application
2. Section 2(d) Refusal – Likelihood of Confusion
3. Specimen Refusal - International Class 035
4. Amended Identification of Services Required

Applicant submits the following argument in support of its Application and in response to the issues raised by the Examining Attorney in the Nonfinal Office Action issued on March 9, 2020.

1. Prior-Filed Application

The Examining Attorney cited pending U.S. Application Serial No. 88418584 for “Remedy Arts” as a prior-filed application, and that if the mark in said application registers, Applicant’s mark may be refused registration under Trademark Act Section 2(d) based upon a likelihood of confusion.

On March 23, 2020, this Applicant filed an opposition action before the Trademark Trial and Appeal Board (“TTAB”), Opposition No. 91254835, in which this Applicant opposed the registration of the mark listed in Application Serial No. 88418584 and cited by the Examining Attorney in the Office Action. Shortly following the filing of the opposition action, this Applicant and the owner of the mark in Application Serial No. 88418584 entered into a Mutual Trademark Coexistence and Consent Agreement. A true and accurate copy of said agreement is attached to this response to the Nonfinal Office Action. Among other things, the owner of the Application Serial No. 88418584 agreed to this Applicant’s use and registration with the USPTO of the Remedy Mark, Application Serial No. 88706851. Additionally, the owner of the Application Serial No. 88418584 agreed to modify its services listed within its pending application in order to specifically limit the type of music and video production. In fact, on April 9, 2020, the owner of the Application Serial No. 88418584 filed its Voluntary Amendment of the services listed in its application. A true and accurate copy of the Voluntary Application is attached to this response to Nonfinal Office Action.

Based upon the entering into of the Mutual Trademark Coexistence and Consent Agreement and the

modification of the services in Application Serial No. 88418584, this Applicant respectfully submits to the Examining Attorney that the prior-filed application should no longer be a bar to registration of this Applicant's mark.

2. Section 2(d) Refusal – Likelihood of Confusion

The Examining Attorney cited a likelihood of confusion with U.S. Registration Nos. 4400687, 4720423, 4958032, 5333500, 5333509 and 533511. The services listed in each of the Registrations cited by the Examining Attorney as presenting the likelihood of confusion with Applicant's mark all relate to advertising, marketing and promotional services in International Class 035, and do not relate to Applicant's services in International Class 041. Specifically, the Examining Attorney noted that this Applicant uses broad wording to describe advertising and marketing services and that this Applicant's services have no restriction as to nature, type, channels of trade, or classes of purchasers.

In an effort to obviate any likelihood of confusion, Applicant is submitting a proposed modification of the listed services in International Class 035 by removing certain services and limiting others. Applicant has not broadened or added any services. The proposed modification of the listed services in International Class 035 is as follows:

~~“Advertising and marketing services, namely video production, photography, brand development, graphic design and website design provided by means of indirect methods of marketing communications, namely, social media, search engine marketing, inquiry marketing, internet marketing, mobile marketing, blogging and other forms of passive, sharable or viral communications channels; Development of marketing strategies, concepts and tactics, namely, audience development, brand awareness, customer relations, online community building and digital word of mouth communications; Providing advertising, marketing and promotional services, namely, development of advertising campaigns for television, print media and web pages via production of video and audio content; Video production services in the field of employment recruiting; Post-production editing services for video and audio commercials,”~~ in International Class 35;

By removing all broad listings of advertising, marketing and promotional services, and limiting the development of advertising campaigns to only the production of video and audio content, the likelihood of confusion with the cited Registrations is removed. The Examining Attorney is respectfully requested to allow this Application to proceed to publication with the amended and limited services in International Class 035.

3. Specimen Refusal - International Class 035

The Examining Attorney indicated that the specimens submitted with the application do not show a direct association between the mark and services in that the webpage screenshots submitted by applicant do not mention nor advertise marketing, promotional, nor advertising services. Applicant wishes to amend its application by submitting the additional specimen attached to this Response. This additional specimen reflects that Applicant uses the Remedy mark in conjunction with being a “marketing partner” of its customers. The substitute specimen was in use in commerce at least as early as the filing date of the application.

Additionally, Applicant respectfully requests that the Examining Attorney reconsider whether two of the specimens submitted with the original application in fact satisfy the requirements pointed out in the Office Action. Specifically, the specimen submitted and identified in the application as ending with FTK005.JPG reflects the home page of Applicant's website and states, “We help brands create

exceptional commercial, branded, and social content through video production, photography, brand development, and web design.” While the specific terms, “marketing,” “advertising,” and “promotional” are not stated, Applicant submits that the explanation set out above (and in the referenced specimen) certainly indicate that Applicant provides marketing, advertising, and promotional services through video and photographic production. Additionally, the specimen submitted and identified in the application as ending with FTK006.JPG reflects the “What We Do” page of Applicant’s website. This page reflects a listing of seven examples of video and photographic production of marketing, advertising, and promotional videos for its customers, including Chic-fil-A, Streamlabs, and the Women’s Resource Center to End Domestic Violence. Again, while the specific terms, “marketing,” “advertising” and “promotional” are not spelled out, it is readily apparent that Applicant uses the Remedy mark in conjunction with developing advertising campaigns through the production of video and audio content.

4. Amended Identification of Services Required

The examining attorney indicated that Applicant incorrectly included a period in the identification of services. In its submission of the amended listing of services set out above, Applicant has removed the improper punctuation.

DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in the application and this response are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

APPLICANT:
REMEDY FILMS, LLC

By: Michael A. Penn
Name: Michael A. Penn
Title: Attorney for Applicant
Date: May 7, 2020