

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark: **THE ROCK**

Applicant: The Prudential Insurance Company of America

Serial No.: 88/899,576

Filing Date: May 4, 2020

Attorney Ref.: 522044

RESPONSE

The following is in response to the Office Action dated June 6, 2020.

I. No Likelihood of Confusion

The Examining Attorney cited prior pending U.S. Trademark Application No. 88/976,710 for THE ROCK owned by National Dragway Corporation, and indicated that if this application proceeds to registration, there would be a likelihood of confusion between this mark and Applicant's mark. Applicant respectfully submits that if the prior pending application were to proceed to registration, there is no likelihood of confusion as Applicant and the owner of the prior pending application have entered into the attached Trademark Coexistence and Consent-to-Register Agreement, by which the parties have agreed that they can peacefully co-exist in light of the differences in their respective goods and services and other differences between the marks. *See Exhibit A.*

Section 1207.01(d)(viii) of the Trademark Manual of Examining Procedure provides the following guidance with respect to consent agreements:

1207.01(d)(viii) Consent Agreements

In the *In re E. I. du Pont de Nemours & Co.* decision, the Court of Customs and Patent Appeals stated as follows:

[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

476 F.2d at 1363, 177 USPQ at 568.

Accordingly, the Court of Appeals for the Federal Circuit has indicated that consent agreements should be given great weight, and that the USPTO should not substitute its

judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other relevant factors clearly dictate a finding of likelihood of confusion. *See In re Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993); *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985); *see also du Pont*, 476 F.2d at 1362-63, 177 USPQ at 568. Thus, examining attorneys should give substantial weight to a proper consent agreement. When parties have entered into a credible consent agreement and, on balance, the other factors do not dictate a finding of likelihood of confusion, an examining attorney should not interpose his or her own judgment that confusion is likely.

The Board has held that in cases involving letters of consent, “a great deal of weight must be given to the parties’ assessment as to whether or not confusion is likely to occur.” *In re Fieldcrest Cannon Inc.*, 5 USPQ2d 1142, 1143-1144 (TTAB 1987). In this case, the combination of the provisions of the Trademark Coexistence and Consent-to-Register Agreement, the amendments the owner of the cited application has made to the goods/services its application, and the differences in the parties’ goods/services all serve as compelling evidence in this case that confusion between the marks or as to source is not likely. *See, e.g., Fieldcrest*, 5 USPQ2d 1142; *In re SGS Tool Co.*, 24 USPQ2d 1382 (TTAB 1992); *In re Donnay Int’l, Societe Anonyme*, 31 USPQ2d 1953 (TTAB 1994).

In the *Donnay* case, the Board accepted a letter of consent that was, in fact, a “naked consent” to register. *See Donnay*, 31 USPQ2d 1953. Trademark Coexistence and Consent-to-Register Agreement in the present case, however, is more than a mere consent to register. It provides steps as to how Applicant and the owner of the cited application will avoid confusion between their respective marks, as based on a reasoned assessment of the marketplace.

Moreover, the very fact that the owner of the cited application has given its consent to registration of Applicant’s mark -- at the very least -- negates the presumption that all doubts about likelihood of confusion are to be resolved in favor of the prior registrant. *See Donnay*, 31 USPQ2d at 1957. Accordingly, by giving its consent, the owner of the cited application has, in effect, removed the basis for applying this equitable consideration. *Id.* It is therefore requested that, should the cited application proceed to registration, that there is no likelihood of confusion.

II. Declaration to Perfect Application

Applicant submits a Declaration to Perfect Application, establishing a 1(a) application filing basis.

CONCLUSION

Applicant submits that it has addressed all of the issues raised in the Office Action and respectfully requests that the Examiner approve the Application for publication in the *Official Gazette*, for opposition purposes, without further delay.