

## **RESPONSE TO OFFICE ACTION IN APPLICATION NO. 88893708**

This is in response to the Office Action dated June 23, 2020.

The Examining Attorney has refused registration of Applicant's mark NEW WORLD on the basis that the mark is allegedly likely to cause confusion with U.S. Registration No. 1468079, for WEBSTER'S NEW WORLD, in association with "computer programs".

Applicant deletes the applied-for goods in Class 9 in this response. Applicant respectfully submits that following the amendment of the application, and considering the relevant factors set forth by the court in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973) ("*DuPont*"), there is no likelihood of confusion between Applicant's mark and the cited registration.

### 1) The goods and services are different

Following the amendment filed with this response, the subject application will only cover the following services:

Class 41: Electronic games services provided by means of the internet; Entertainment services, namely, providing online electronic games; Entertainment services, namely, providing online video games; Entertainment services, namely, providing temporary use of non-downloadable electronic games; Providing a computer game for use network-wide by network users; Providing a web-based system and on-line portal for customers to participate in on-line gaming; Providing an on-line computer game in the field of role playing video games; Providing information on-line relating to computer games and computer enhancements for games; Providing on-line computer games; Provision of information relating to electronic computer games provided via the Internet; Organization of electronic game competitions

Class 45: Social networking services in the field of entertainment provided via a website and communications networks; On-line social networking services; Providing a social networking website for entertainment purposes

Applicant submits that these services are readily distinguishable from "computer program" in Class 9, which is reserved for downloadable and recorded computer programs, whereas all of the claimed services listed above are conducted on-line, or are non-downloadable. A "computer program" is not a "service". The services claimed (such as on-line gaming services, on-line social networking services, organization of game competitions, or providing a website for entertainment purposes) are highly different from "computer program".

In addition, the cited registration was registered in 1987, when the Trademark Office did not require specific field of use or functionality of "computer program", which resulted in a registration that is much broader in scope than what would be tolerated in today's examination standards and the reality of commerce in the United States today. However, this does not mean that the registrant had intention to use the mark in association with computer programs in every conceivable field, nor should it be assumed that the registrant's goods will travel in the

same channels of trade as all other forms of software-based goods or services. As demonstrated through the specimens filed by the owner of the cited registration, the mark has only been used in connection with word processor with thesaurus, as well as on dictionaries (see Exhibits 1-3), which are highly different in nature from gaming services and social networking services.

Owner of the cited registration has not demonstrated any intention that the WEBSTER'S NEW WORLD mark would be used on any "computer program" that would be similar to gaming, let alone social networking services.

Based on these reasons, Applicant submits that there can be no confusion between the goods in the cited registration and Applicant's applied-for services.

2) Channels of trade are different

"Computer programs" in Class 9 are presumed to be downloadable or recorded, and are not offered online. In addition, it appears that WEBSTER'S NEW WORLD has only been used with dictionaries and word processor with thesaurus. Such goods are highly different from entertainment or gaming services, and do not travel in the same channels of trade. It is simply not plausible to assume that the same consumers who would encounter a "computer program" from WEBSTER'S NEW WORLD would be seeking the sophisticated social and gaming services offered under Applicant's mark.

3) WEBSTER'S NEW WORLD and NEW WORLD create different overall impressions

The first *DuPont* factor looks at the similarity of the marks in their "entireties as to appearance, sound, connotation and commercial impression." *DuPont* 476 F.2d at 1361.

The cited registration WEBSTER'S NEW WORLD is readily differentiable from the applied-for mark by the wording "WEBSTER'S", which would carry stronger weight than "NEW WORLD" since that is the beginning of the mark. Overall, WEBSTER'S NEW WORLD creates a different commercial impression from NEW WORLD, such that there can be no confusion between the marks NEW WORLD and WEBSTER'S NEW WORLD.

**Conclusion**

Based on the reasons stated above, applicant submits that there is no likelihood of confusion between the subject application and the cited registration. Applicant respectfully requests Examining Attorney to withdraw the rejection in view of the cited registration.

