IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Niantic, Inc.	Law Office	: 126
Serial No.	: 97088390	Examiner	: Derek van den Abeelen
Intl. Class	: 9, 35, 38, 41, 45		
Filed	: October 22, 2021		
Mark	: BOARDWALK		

RESPONSE TO OFFICE ACTION

This Response addresses the Office Action dated March 31, 2022 issued against U.S. Serial No. 97088390 (the "Application") for the mark **BOARDWALK** ("Applicant's Mark"), filed by Niantic, Inc. (the "Applicant"). The Examining Attorney has refused registration of the Application in International Classes 9 and 41 pursuant to Trademark Act Section 2(d) based on a purported likelihood of confusion. For the reasons set forth in this Response, Applicant respectfully submits that no likelihood of confusion exists, and requests that the Application be published for opposition.

SECTION 2(d) REFUSAL: NO LIKELIHOOD OF CONFUSION

The Examining Attorney refused registration of the instant Application due to a purported likelihood of confusion with U.S. Registration Nos. 5281745 and 5281746 for the marks BOARDWALK SLOTS in International Classes 9 and 41, respectively. New Tropicana Holdings, Inc. ("Registrant") owns both registrations. Applicant respectfully disagrees that a likelihood of confusion exists between the subject marks, primarily given the differences in the parties' goods and services and the distinct commercial impressions each mark conveys.

Courts (and the USPTO) look to many factors when determining whether a likelihood of confusion exists—for example, courts will look to the similarity of the marks and the relatedness of the relevant goods and/or services. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d

1357,1360-61 (C.C.P.A. 1973). Examination of each of the *du Pont* factors is not necessary to a determination of likelihood of confusion, as each factor differs in significance based on the facts of a particular case. *See Bose Corp v. QSC Audio Prods., Inc.*, 293 F.2d 1367, 1370 (Fed. Cir. 2001); *E.I. du Pont de Nemours & Co.*, 476 F.2d at 1362 ("[E]ach [element] may from case to case play a dominant role. . . . In any given case, a single element may be sufficient to dispel likelihood of confusion."). A *likelihood* of confusion, and not a mere *possibility* of confusion, is the appropriate standard. *In re Fesco, Inc.*, 219 USPQ 437, 439 (TTAB 1984). The ultimate consideration is "whether the marks will confused people into believing that the goods [the marks] identify emanate from the same source." TMEP § 1207.01; *Paula Payne Prods. Co. v. Johnson's Publ'g Co.*, 473 F.2d 901, 902 (C.C.P.A. 1973) ("[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing that the [goods and/or services] they identify emanate from the same source.").

For the reasons discussed below, Applicant submits that no likelihood of confusion exists between its mark and Registrant's marks.

1. The Parties' Goods and Services are Distinct.

A fundamental inquiry under the likelihood of confusion analysis is whether the parties' respective goods and/or services are sufficiently related so as to confuse consumers as to the source or origin of those goods and/or services. *See In re St. Helena Hospital*, 774 F.3d 747, 752 (Fed. Cir. 2014). This analysis "requires a comparison between the goods or services described in the application and those described in the registration." *Coach Servs. v. Triumph Learning LLC*,

668 F.3d 1356, 1368-69 (Fed. Cir. 2012) (citing *M2 Software, Inc. v. M2 Commc'ns, Inc.*, 450 F.3d 1378, 1382 (Fed. Cir. 2006)). In this case, the parties' goods and services are clearly distinct for likelihood of confusion purposes.

The Application claims an intent to use the mark in connection with the following relevant goods and services:

> **Class 9:** Downloadable game software; downloadable game software for use on mobile devices; downloadable video game software; downloadable interactive game software; downloadable augmented reality game software; downloadable computer software for social networking; downloadable software for sending messages and chatting; downloadable software for socially interacting and connecting with other users; downloadable software for use in the management and implementation of digital currency, virtual currency, cryptocurrency, digital and blockchain assets, digitized assets, digital tokens, crypto tokens and utility token transactions; downloadable software for managing cryptocurrency transactions using blockchain technology; downloadable virtual goods, namely, computer programs featuring digital collectible emblems, trophies, badges, certificates, and cards, character clothing and character skins, wallpapers, artwork, and in-game currency for use in online virtual worlds; downloadable computer software for the collection, editing, organizing, modifying, book marking, transmission, storage, and sharing of data and information; downloadable computer software for creating and managing a personal profile that can be linked to other software applications; downloadable augmented reality software for integrating electronic data with real world environments for the purpose of mapping points of interest, communicating with other persons, and deep-linking, locating, and collecting virtual assets
>
> **Class 41:** Providing online computer games; providing online video games; providing online non-downloadable game software; providing online non-downloadable video game software; providing online non-downloadable interactive game software; providing online non-downloadable augmented reality game software; providing online non-downloadable videos in the field of video games, social networking, geolocation, live events, augmented reality, and virtual assets; entertainment services, namely, providing an online virtual environment for locating, collecting, and trading virtual assets

The registrations, on the other hand, claim use in connection with the following goods and services:

> **Class 9:** Computer game programs; computer game software; downloadable computer game software via a global computer network and wireless devices
>
> **Class 41:** Entertainment services, namely, providing on-line computer games; entertainment services, namely, providing temporary use of non-downloadable computer games; play-for-fun electronic games services provided by means of the Internet; providing an on-line computer game in the field of casino gaming for recreational computer game playing purposes

The distinct nature of the parties' goods and services are evident from the specimens of use filed with the Registrations. Specifically, the records for Registrant's BOARDWALK SLOTS marks both contain specimens of use establishing that its BOARDWALK SLOTS marks are used in connection with a slot-themed casino game. The additional term "SLOTS" in Registrant's marks further reinforces the nature of its games. Applicant, on the other hand, intends to use its mark in connection with augmented reality software that blends the virtual and real words through unique technology and features. This is completely different from Registrant's casino-themed games, and no consumer would be confused.

In support of the refusal, the Examining Attorney merely states that the identifications feature no restrictions, are presumed to travel in the same channels of trade, and are therefore related for purposes of likelihood of confusion. However, one cannot analyze the parties' respective marks in a vacuum. As stated above, the evidence of record in the Registrations clearly indicates the distinct nature of the parties' goods and services.

2. The Marks Convey Significantly Different Commercial Impressions.

An analysis of likelihood of confusion requires consideration of more than mere visual or aural similarity. In fact, even identical marks can convey different overall meanings and commercial impressions when considered in different contexts. *See* 4 McCarthy on Trademarks and Unfair Competition § 23:28 (5th ed.) (citing *Revlon, Inc. v. Jerell, Inc.*, 11 USPQ2d 1612, 1616 (S.D.N.Y. 1989) ("Such differences of connotation and meaning are key factors in determining the likelihood of confusion. Differing connotations themselves can be determinative, even where identical words with identical meanings are used.")). For example, the Board found that an application for the mark COACH in connection with study materials did not create a likelihood of confusion with the mark COACH for use with luggage, as the former context connoted training or tutoring, while the latter connoted travel accommodations by "coach." *See Coach Servs.*, 668 F.3d at 1369. In *In re Sears, Roebuck & Co.*, the Board found no likelihood of confusion between CROSS-OVER for bras and CROSSOVER for ladies' sportswear because the respective goods were "different types of clothing, having different uses, and are normally sold in different sections of department stores." *In re Sears, Roebuck & Co.*, 2 USPQ2d 1312, 1314 (TTAB 1987). Accordingly, use of the same mark in connection with different goods can convey distinct commercial impressions.

In this case, the marks connote different overall commercial impressions despite their common element, "BOARDWALK". Specifically, when considered in connection with Registrant's

casino-themed games (and its affiliation with an actual casino in Atlantic City, NJ),[1] the term "BOARDWALK" in Registrant's marks clearly connotes the Boardwalk in Atlantic City. The Boardwalk in Atlantic City is a famous entertainment district featuring various casinos, restaurants, and other attractions. *See* **Exhibit A**. Accordingly, consumers will immediately understand Registrant's marks to refer to this specific location.

In contrast, Applicant's BOARDWALK mark will not conjure an association with this specific location because its goods and services will not feature or pertain to casinos, casino-themed games, or Atlantic City. When properly considering the parties' respective marks in connection with the relevant goods and services, it is clear they connote distinct commercial impressions.

CONCLUSION

Applicant has addressed all issues raised by the Examining Attorney. Therefore, we respectfully request that the partial refusal be withdrawn, and that the subject Application be approved for publication.

Respectfully submitted,

/s/ Jenifer deWolf Paine

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[1] Page 2 of Registrant's specimen of use list numerous Tropicana businesses, including the "Tropicana Atlantic City" casino.

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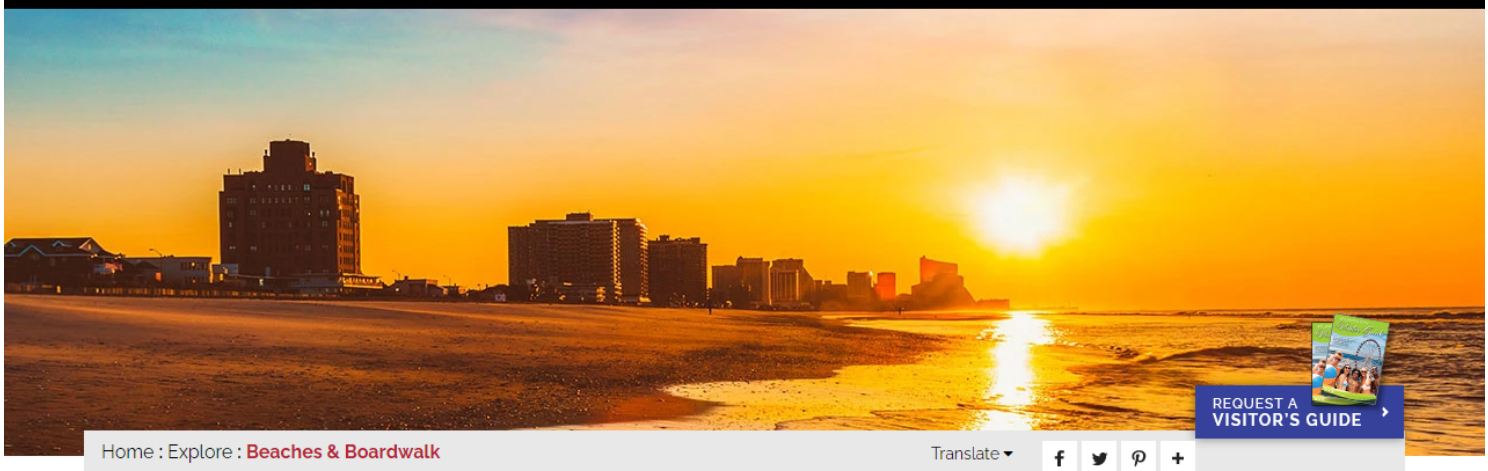

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