

## **Suspension Inquiry Response Serial No. 86/828,302 (BREVILLE)**

This responds to the Suspension Inquiry dated March 27, 2017 issued for U.S. Serial No. 86/828,302. Further, to the request of the Examining Attorney, Applicant has submitted a certified copy of Australian Registration No. 1734902.

The Examining Attorney has also maintained and continued refusals from the Office Action dated March 21, 2016, including likelihood of confusion refusal and identification amendment requirement. Applicant responds to each of these refusals in turn.

### **Foreign Registration**

In response to the Suspension Inquiry, Applicant has submitted a certified copy of Australia Trademark Registration No. 1734902.

### **Amendments To Description of Goods**

While the Examining Attorney has maintained and continued refusals with respect to the identification of goods, there is no explanation with respect to any outstanding issues. Additionally, it appears that the Applicant's amendments made in the September 20, 2016 Office Action response was not entered. Therefore Applicant resubmits the amendments made in the Office Action Response dated September 20, 2016 for Class 9 as reflected below. Should the Examining Attorney require further amendments, Applicant request an explanation of the remaining issues.

Electrical apparatus, appliances, equipment and instruments in this class, namely household and industrial kitchen appliances embedded with computer hardware and electronic controls; computer software for use with kitchen appliances in the field of food and beverage preparation and cooking; computer software that allow users to remotely interact with, access, control, connect to, monitor and operate kitchen and domestic appliances; electronic devices, namely, controllers, transmitters and receivers and computer software that allow the sharing and transmission of data and information between devices for the purposes of operating and monitoring kitchen and domestic appliances, including the aforesaid controlled wirelessly from a remote location; computer software accessible on computers, electronic devices and mobile communication devices, all for operating, remotely accessing, controlling, interacting with or monitoring kitchen and domestic appliances; computer software for use on handheld mobile digital electronic devices and other consumer electronics, namely smart phones, smart watches, tablets, laptops and computers; computer software namely, computer software for use in downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organising data including audio and video data; downloadable software for accessing a recipe database; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing

electronic media or information via computer and communication networks; downloadable digital applications and apps for use with household and industrial kitchen appliances in the field of food and beverage preparation and cooking; downloadable electronic publications in the nature of magazines, newsletters, books, and recipes; computer programs including interactive computer programs; pre-recorded media, namely videos, downloadable and streamable videos and podcasts, in the field of beverage and food preparation and cooking.

In addition to the amendments made to Class 42 in the September 20, 2016 response to Office Action, Applicant submits the following amendments. The strikethroughs indicate changes made to the description of goods as submitted on September 20, 2016.

Non-downloadable software for accessing a recipe database; providing temporary use of online, non-downloadable software for accessing a recipe database; creating and maintaining weblogs in the nature of blogs for others hosting of weblogs in the nature of blogs; ~~creating, designing, maintaining and hosting web pages and web sites~~; providing temporary use of on-line non-downloadable software to enable users to program audio, video, audio-visual, text and other multimedia content, including entertainment-related programs; ~~maintenance of computer software~~; cloud computing featuring an accessible online computer database and web portal containing data and multi-media content in the field of beverage and food preparation and cooking; advisory, support, information and consultancy services of beverage and food preparation and cooking

Further, as suggested by the Examining Attorney, in the September 20, 2016 Office Action Response, Applicant added Class 43 as reflected below. No further amendments are made to this class.

Computer databases in the field of cooking.

### **No Likelihood of Confusion**

In the September 27, 2017 Suspension Inquiry, the Examining Attorney continued and maintained likelihood of confusion refusals without comment on the arguments previously submitted by Applicant on September 20, 2016.<sup>1</sup> Therefore, Applicant incorporates all arguments from the September 20, 2016 Office Action response as if fully restated herein and makes the additional comments and arguments.

In the Office Action dated March 21, 2016, the Examining Attorney stated that “Applicant and registrant both provide hosting services.” (Office Action, dated 3/21/16 at p.3). The Examining Attorney continued to state “hosting services are often provided together with

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<sup>1</sup> Applicant notes that, in the September 27, 2016 Suspension Notice, the Examining Attorney withdrew the refusal based on U.S. Application Serial No. 86/781,486 but did not comment on Applicant's other arguments. Applicant appreciates the withdraw of this refusal.

the design, maintenance, advisory, information and support services” (Office Action, dated 3/21/16 at p. 3). Applicant has amended the description of goods and services to remove reference to “creating, designing and hosting web pages and websites” and “maintenance of computer software”. Although, Applicant maintains for the reasons stated in the Response to Office Action dated September 20, 2016 that there is no likelihood of confusion between Applicant’s listed goods and services and registrant’s listed goods and services, these amendments further differentiate the goods and further avoids any potential likelihood of confusion.

The Examining Attorney further states that “Applicant also provides software, computer programs, applications and publications, all of which may relate to the services of registrant.” (Office Action, dated 3/21/16 at p. 3). Registrant’s registered services are “hosting of web sites; domain registry operator services, namely, conducting computerised searches for the availability of domain names.” In support of this, the Examining Attorney submitted third-party marks registered in connection with the same or similar services of applicant and registrant in an attempt to show that the services listed herein may emanate from a single source under a single mark. However, as stated in Applicant’s Office Action response dated September 20, 2016, none of the cited third-party registrations exactly overlap with Applicant’s goods/services and the services listed in the cited registration. *See e.g. In re Capital Blue Cross*, Serial No. 78869843 at p. 8 (TTAB 2012), decision (Office Action Response, dated 9/20/16 at Exhibit B). This is particularly true in view of the further amendments made by Applicant. Specifically, Applicant has removed “creating, designing and hosting web pages and websites” from its description of services. Therefore, removing this overlap from the third-party registrations. Further, only one third-party registration cited by the Examining Attorney lists domain registry services (the service the cited registration is registered for) in its registration and that third-party registration does not list publications. As such, the third-party registrations are not probative that the services listed in the Applicant’s application and the cited registration would emanate from the same source. Moreover, while it may be possible for the same customer to purchase both Applicant’s and registrant’s goods/services, the Federal Circuit has cautioned that it is error to deny registration simply because an applicant markets and sells its goods in the same general field as those sold by the registrant. *See In re Itec Manufacturing, Ltd*, 2008 WL 885926 (TTAB 2008) (reversing the refusal to register in each instance (citing *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).)

Additionally, the Applicant’s mark has been used in connection with its website Food Thinkers by Breville which provides a recipe database, weblog, publications, etc. (a copy of the website is attached as **Exhibit A**) since at least as early as 2010. According to registrant’s registration the BRAVELL mark has a date of first use in 2000. Therefore, both Applicant’s mark and the cited registration have been concurrently used in commerce for at least seven (7) years and there has not been any evidence of actual likelihood of confusion. *See Pignons S.A. de Mecanique de Precision v. Polaroid Corp.*, 657 F.2d 482 (1<sup>st</sup> Cir. 1981) (“[A]bsent evidence of actual confusion, when the marks have been in the same market, side by side, for a substantial period of time, there is a strong presumption that there is little likelihood of confusion.” (quoting 3 Callman, § 82.3(a) at 849)); *see also Kozak Auto Drywash, Inc. v. Enviro-Tech Intern., Inc.*, 823 F. Supp. 120 (W. D. N.Y. 1993) (“Here, after more than two years of concurrent use... the plaintiff’s failure to demonstrate instances of actual confusion significantly weights against a

finding of a likelihood of confusion.” (internal citations omitted).) Therefore, given the long-standing concurrent use of Applicant’s mark and the cited registration without any actual confusion along with the reasons stated above and in the Office Action Response dated September 20, 2016, Applicant requests that the Examining Attorney withdrawal this refusal and permit the application to proceed to registration.