UNITED STATE PATENT AND TRADEMARK OFFICE

Applicant: Blue River Solutions, LLC

Mark: CLEARCUT

Serial No.: 88600833

Examining Attorney: Matthew Tully

REQUEST TO WITHDRAW SUSPENSION

Applicant seeks to register the mark CLEARCUT in IC 036 for brand management services ("Applicant's Mark"). The Examiner has suspended Applicant's application due to the presence of a pending application, CLEAR/CUT (Serial No. 88080588) in IC 045 for the following services:

> Legal and litigation consultancy services; Litigation consultancy and advice; Legal advisory services and consulting in the field of legal document review, and early case assessment; Legal consulting featuring the use of analytic and statistic models for understanding and predictive modeling of legal issues, legal trends and actions; Legal services, namely, litigation management consulting, data analysis, damage quantification, litigation prevention and early case assessment; Providing information in the field of litigation; Legal services, namely, providing customized information, counseling, advice and litigation services in all areas of commercial and international law; Litigation support services, namely, conducting electronic legal discovery in the nature of reviewing e-mails and other electronically stored information that could be relevant evidence in a lawsuit; Litigation support services, namely, conducting electronic legal discovery in the nature of review of electronically stored information and data; Legal document review in the nature of legal document preparation services and consulting related thereto; Legal services, relating to electronic discovery services utilizing predictive analytics, namely, litigation consultancy and legal document preparation services.

("Pending Application").

Applicant requests that the Examiner withdraw the suspension of Applicant's Mark, because the following render confusion unlikely: (a) the difference in goods and services between

Applicant's Mark and the Pending Application: (b) the level of sophistication of consumers who are purchasing the services of the Pending Application; and (c) the narrow scope of protection afforded to the term CLEARCUT in light of the Third-Party Registrations (attached at Exhibit "1").

DISCUSSION

I. Differences in Services Between Applicant's Mark and the Pending Application is Sufficient to Quell any Likelihood of Confusion.

Applicant's Mark is for brand management services versus the Pending Application which is limited exclusively to a variety of legal services. Each of the applications occupy a different International Class, and neither of the applications' description of services overlap. The stark contrast between each of the applicants' services suggests that consumers would not encounter the marks under circumstances likely to give rise to the mistaken belief that the services emanate from the same source destroying any likelihood of confusion. *See In Re Victor Alfonso Suarez*, 2017 WL 2572829 (TTAB Mar. 15, 2017))(reversing §2(d) refusal for marks within the same International Class, solely because the applicant's mark and registered mark recite different services, and consumers would not encounter the marks under circumstances likely to give rise to the mistaken belief that the services emanate from the same source).

The difference in Applicant's Mark and the Pending Application's services is sufficient in and of itself to destroy any likelihood of confusion, but this conclusion is even more compelling in light of the fact that consumers seeking to purchase the services in the Pending Application would be sophisticated legal professionals who would exercise greater care further quelling any likelihood of confusion. See *In Re Coty Us LLC,* 2012 WL 1267919, at *3 (TTAB Mar. 29, 2012)(reversed §2(d) refusal despite the marks being legally identical, because the differences in

the goods and the sophistication of the consumers are sufficient to conclude that confusion is not likely).

II. Differences in Goods and Services Permit Multiple Third-Party Registrations to Peacefully Co-Exist on the Principal Registry.

The Third-Party Registrations are either identical or almost identical to the Pending Application, yet the Pending Application was permitted to proceed to publication despite the existence of these Third-Party Registrations. The most logical explanation for such occurrence is that the term CLEARCUT enjoys a narrow scope of protection, where the use of such term in different classes for different goods and services renders likelihood of confusion unlikely. *In re Donald S. Dowden*, 2003 WL 22102385 at *2 (TTAB 2003)(third party registrations may be used to assist in determining how the average consumer would perceive a certain term in order to determine the strength or weakness of a mark).

The Third-Party Registrations evidence that the term "CLEARCUT" is afforded a very limited scope of protection. In fact, the Federal Circuit in *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015) stressed the importance of analyzing the strength or weakness of a mark when conducting the likelihood of confusion analysis, because it determines the scope of protection afforded to the mark, with weaker or highly suggestive marks being afforded a very narrow scope of protection thereby permitting an applicant's mark to come closer to the registered mark without causing any likelihood of confusion. It is through this narrow lens of protection in which the Examining Attorney should conduct the likelihood of confusion analysis, and if conducted in such fashion reveals that the differences between Applicant's Mark and the Pending Application is sufficient to destroy any likelihood of confusion.

The Third-Party Registrations are the exact type of evidence that the Federal Circuit in *Juice Generation* admonished the Board for failing to appropriately consider in determining the narrow protection of the registered mark. *Id.*; *In Re Donald S. Dowden*, 2003 WL 22102385, at *2 (TTAB Aug. 8, 2003); *In re Dayco Products-Eaglemotive*, Inc., 9 U.S.P.Q. 2d 1910 (TTAB Dec. 14, 1988) (reversing §2(d) refusal, because the weakness of the marks were a significant factor that tipped the scales in favor of a finding of no likelihood of confusion); *In re Bay State Brewing Co*., 117 USPQ2d 1958, 1960 (TTAB 2016).

CONCLUSION

Applicant requests that the Examiner withdraw the suspension and permit Applicant's Mark to proceed to publication, because likelihood of confusion is quelled due to: (a) the difference in goods and services between Applicant's Mark and the Pending Application: (b) the level of sophistication of consumers who are purchasing the services of the Pending Application; and (c) the narrow scope of protection afforded to the term CLEARCUT in light of the Third-Party Registrations.

Dated: December 5, 2019

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