

Attorney Docket No.: 052999-100606
Mark: TALES OF ARISE
Application Serial No.: 88/473,322

RESPONSE TO SUSPENSION NOTICE

This is a response to the Suspension Notice issued on January 19, 2020. The Examining Attorney suspended the subject application pending the disposition of prior-filed pending U.S. Application



No. 88457468 for the mark (hereinafter the “Cited Application” and the “Cited Mark”, respectively). Applicant BANDAI NAMCO Entertainment Inc. (“Applicant”) respectfully disagrees with the Examining Attorney’s continued advisory and hereby traverses this issue below.

Likelihood of Confusion

Applicant respectfully disagrees with the Examining Attorney’s continued position that the Cited Mark is confusingly similar to Applicant’s mark TALES OF ARISE (hereinafter “Applicant’s Mark”). As an initial matter, the Examining Attorney has provided no explanation or reasoning as to why Applicant’s prior arguments against a likelihood of confusion are not convincing and has simply stated that such arguments are not sufficiently persuasive to avoid the need to suspend the application. As such, Applicant is forced to make more general arguments here in further support of no likelihood of confusion between the marks.

As set forth in Applicant’s earlier response, in determining the issue of likelihood of confusion, the Trademark Office must consider the relevant *Du Pont* factors. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ 563 (C.C.P.A. 1973). The significance of each factor is case specific. *Nina Ricci S.A.R.L. v. E.T.F. Enterprises, Inc.*, 12 USPQ2d 1901 (Fed.Cir. 1989), *rev’g*, 9 USPQ2d 1061 (TTAB 1988); *In re E. I. du Pont De Nemours & Co, supra*. In this instance, the most relevant *Du Pont* factors include the following, which weigh in favor of no likelihood of confusion:

- 1) The term ARISE is relatively weak as applied to the relevant goods and services;
- 2) There are significant differences in look, sound, connotation, and commercial impression between the marks;
- 3) Consumers use a high degree of care when purchasing goods and services under the marks; and
- 4) Applicant’s Mark is part of the well-known *Tales* series of games.

The Term ARISE is Relatively Weak

The term ARISE, which is common to both marks, is relatively weak as applied to the relevant goods and services. The strength of a mark must be considered when determining the scope of protection it should be accorded. *See Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 259, 205 USPQ 969, 975 (5th Cir. 1980). The weaker the mark, the less likely it is that consumers will

view it as an indication of origin, *see Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1006, 222 USPQ 373, 378 (2d Cir. 1983), and the narrower its scope of protection. *See Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 160, 117 USPQ 295, 297 (CCPA 1958) (“where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights”). The Trademark Trial and Appeal Board (the “Board”) has “recognized that . . . weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word.” TMEP § 1207.01(b)(ix).

Evidence establishing that the consuming public is exposed to third-party use of similar marks on similar goods supports that a mark is relatively weak and entitled to only a narrow scope of protection. TMEP § 1207.01(d)(iii); *see Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *see also In re FabFitFun, Inc.*, 127 USPQ2d 1670, 1675 (TTAB 2018) (finding the component term SMOKING HOT in the marks I’M SMOKING HOT and SMOKIN’ HOT SHOW TIME to be “somewhat weak” based in part on evidence of third-party use of the term on similar cosmetics goods, noting that such uses “tend to show consumer exposure to third-party use of the term on similar goods”); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (noting that evidence that third parties had adopted marks that were the same as or similar to opposer’s mark for use in connection with food products “may show that a term carries a highly suggestive connotation in the industry and, therefore, may be considered weak”).

Here, the term ARISE is relatively weak because there are a number of third-party uses of similar marks incorporating the term ARISE or the variation RISE used in connection with video game related goods and services. A sampling of such third-party uses is attached hereto in Exhibit A. As such, the term ARISE should only be afforded a narrow scope of protection when considering whether there is a likelihood of confusion.

Dissimilarity of the Marks

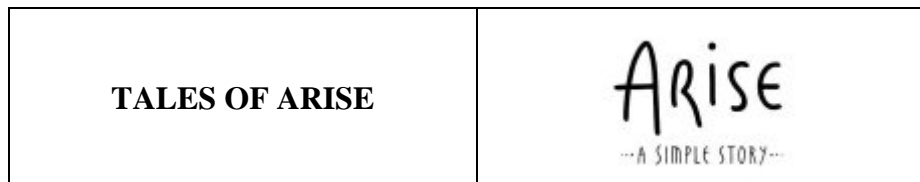
Applicant, again, asserts that Applicant’s Mark, TALES OF ARISE, and the Cited Mark,



, are sufficiently different in appearance, sound, connotation, and commercial impression such that there is no likelihood of confusion between the two marks. *See Du Pont*, 476 F.2d at 1361, 177 USPQ at 567 (noting that when conducting a likelihood of confusion analysis, marks must be compared for similarities in appearance, sound, meaning or connotation, and commercial impression). Importantly, “[s]imilarity of the marks in one respect – sight, sound, or meaning – will not automatically result in a finding of likelihood of confusion even if the goods are identical or closely related.” *See* TMEP § 1207.01(b)(i).

As pointed out previously, from a visual standpoint, Applicant’s Mark provides a very different visual impression than the Cited Mark. The Cited Mark is highly stylized. Applicant’s Mark, on the other hand, includes no stylization whatsoever. Even though both Applicant’s Mark and the Cited Mark include the term ARISE, when viewing the marks side-by-side (as shown below), there

are no visual commonalities (beyond the term ARISE) that would suggest to consumers that the marks and any related goods or services are in any way connected.



The Board has noted that prominent design features can, in fact, serve to distinguish a design mark from another mark. *See, e.g., In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1285 (TTAB 2009) (holding that VOLTA for vodka drinks and TERZA VOLTA with a stick-like design element for wines is not likely to cause confusion); *Colgate-Palmolive*, 432 F.2d at 1402, 167 USPQ at 530 (finding PEAK and PEAK PERIOD to be different in appearance); *In re Electrolyte Labs., Inc.*, 929 F.2d at 647-48, 16 USPQ2d at 1240 (finding the “substantial” differences in design of the marks to be significant in determining there was no likelihood of confusion between “K+ (and design)” and “K+EFF” for potassium supplements). For example, in *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014), the Board found that the mark REDNECK RACEGIRL and Design,



, for “Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms” was not confusingly similar to the mark RACEGIRL for “Caps; Jerseys; Leather belts; Short sets; Tops; Shirts; Shorts; Jackets; Blouses; Caps with visors; Crop tops; Hat bands; Hats; Knitted caps; Sweat bands; Sweat pants; Tank tops; Visors”. While the Board found that the relevant goods overlapped, it determined that confusion is not likely because of crucial differences between the marks. The Board reasoned that “Applicant’s mark is so different from the registered mark that even when used on in-part identical goods, confusion is unlikely.” Likewise, here, Applicant’s Mark is not likely to cause confusion with the Cited Mark due to crucial differences in appearance. *See* 4 McCarthy on Trademarks and Unfair Competition § 23:25 (5th ed.) (“If picture or symbol marks are distinctly different in overall visual appearance, confusion is not likely, even if the marks are used on competing products.”).

Further, the fact that the marks contain the term ARISE does not necessarily support a finding of likelihood of confusion. It is well settled that there is no automatic determination of likelihood of confusion merely because two marks have one or two words in common. *See, e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 159, 229 USPQ 818, 819 (Fed. Cir. 1986) (no likelihood of confusion between BED & BREAKFAST REGISTRY for “making lodging reservations for others in private homes” and BED & BREAKFAST INTERNATIONAL for “room booking agency services”); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1408-09 (TTAB 1998) (HARD ROCK CAFE and Design and COUNTRY ROCK CAFE and Design dissimilar in appearance; no likelihood of confusion); *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1566 (TTAB 1996) (BROADWAY CHICKEN and BROADWAY PIZZA dissimilar in appearance; no likelihood of confusion).

Moreover, both Applicant's Mark and the Cited Mark comprise distinct added elements which serve to distinguish the marks, including Applicant's addition of the wording TALES OF and the Cited Mark's inclusion of the wording A SIMPLE STORY. Also, the Cited Mark includes added design elements. Additions to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as a distinguishing source because it is merely descriptive or diluted. TMEP 1207.01(b)(iii); *see, e.g., Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming the Board's holding that contemporaneous use of applicant's CAPITAL CITY BANK marks for banking and financial services, and opposer's CITIBANK marks for banking and financial services, is not likely cause confusion, based, in part, on findings that marks are distinct in look and sound); *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing the Board's holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, inter alia, THE RITZ KIDS creates a different commercial impression); *Bass Pro Trademarks, L.L.C. v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1857-58 (TTAB 2008) (finding that, although cancellation petitioner's and respondent's marks were similar by virtue of the shared descriptive wording "SPORTSMAN'S WAREHOUSE," this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks); *In re Farm Fresh Catfish Co.*, 231 USPQ 495, 495-96 (TTAB 1986) (holding CATFISH BOBBERS (with "CATFISH" disclaimed) for fish, and BOBBER for restaurant services, not likely to cause confusion, because the word "BOBBER" has different connotation when used in connection with the respective goods and services). In this instance, the marks perceive entirely different commercial impressions, given the distinctive added elements to each mark.

Furthermore, when pronounced, Applicant's Mark does not sound like the Cited Mark because the marks include different wording that do not sound alike. Applicant's Mark has the added wording TALES OF and the Cited Mark has the added wording --A SIMPLE STORY--. Notably too is that the common term ARISE comes at the beginning of the Cited Mark

The logo features the word "ARISE" in a large, black, hand-drawn, sans-serif font. Below it, the phrase "--A SIMPLE STORY--" is written in a smaller, black, all-caps, sans-serif font, enclosed in double hyphens.

; whereas, the term comes at the end of the Applicant's Mark TALES OF ARISE, which also further distinguishes the marks. In *Colgate-Palmolive*, the court noted there was no phonetic similarity between the marks "PEAK" and "PEAK PERIOD," stating that "[t]he difference in the appearance and sound of the marks in issue is too obvious to render detailed discussion necessary. In their entireties they neither look nor sound alike." *Colgate-Palmolive Co.*, 58 C.C.P.A. at 737. This reasoning is equally applicable in the instant case.

Thus, when properly considered in their entireties, the marks at issue, *i.e.*, TALES OF ARISE and ARISE --AS SIMPLE STORY-- (Stylized), create significantly different overall appearances,

sounds, connotations, and commercial impressions. Because of these differences between the marks, Applicant submits that there is no likelihood of confusion between Applicant's Mark and the Cited Mark.

High Degree of Care in Making Purchasing Decision

As asserted in the earlier response, consumers selecting both Applicant's and the owner of the Cited Mark's goods and/or services exercise a high degree of care when making their decisions. This high degree of care decreases any possibility of confusion that could exist between the use of the marks on these services. If confusion is to exist, it must be in the mind of some relevant consumer who encounters both marks.

The care expected of purchasers against which likelihood of confusion is measured is determined by the marketing environment in which the goods or services are ordinarily bought or sold. Some factors to be considered are the manner in which the goods are purchased. . . the manner in which the goods are marketed. . . and the class of prospective purchasers. . .

Restatement (Third) Unfair Competition § 20, comment g (1995).

In weighing the issue of likelihood of confusion, consideration should be given to the "general impression of the ordinary purchaser, buying under the normally prevalent conditions of the market and giving the attention such purchasers usually give in buying that class of goods." *W.W.W. Pharmaceutical Co. Inc. v. The Gillette Co.*, 984 F.2d 567, 575, 25 USPQ2d 1593, 1600 (2d Cir. 1993). Some conditions of purchase are more conducive than others to the exercise of a high degree of reasonable care. *Industrial Nucleonics Corp. v. Hinde Engineering Co.*, 475 F.2d 1197, 177 USPQ 386, 387 (C.C.P.A. 1973). These conditions include (1) if the purchaser is an enthusiast and (2) the price of the goods or services. *See, e.g., Turtle Wax, Inc. v. First Brands Corporation*, 781 F.Supp. 1314, 22 USPQ2d 1013, 1024 and n. 18 (N.D. Ill. 1991) (car buffs who purchase car polish exercise a high degree of care in making a selection); *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1137, 202 USPQ 81, 92 (2nd Cir. 1979) (considering the high cost of goods).

Here, the respective consumers of Applicant's goods and services and the goods and services associated with the Cited Mark, which generally relate to video games, are sophisticated and knowledgeable consumers who exercise a high degree of ordinary care when selecting such goods and services. Careful thought, consideration, and evaluation goes into the selection of a video game. Accordingly, a consumer seeking such goods or services would spend a noteworthy amount of time researching, examining and inspecting the goods or services where possible before making a decision.

Typically, when a consumer elects to purchase a video game, he or she is seeking a specific game, or at the very least, a specific genre of a game. The genres and themes associated with the games offered under Applicant's Mark and the Cited Mark are entirely distinct. In particular, Applicant's TALES OF ARISE game takes place in a setting divided between the medieval world of "Dahna" and the advanced world of "Rena." *See* Exhibit B. Rena's superior technological and magical

advancement cause it to hold power over Dahna, taking its resources and treating its people as slaves. *Id.* The protagonists are a man named Alphen, native to Dahna, and a woman named Shionne, from Rena, who end up travelling together. *Id.* In stark contrast, the game offered under the Cited Mark is described as a journey through the lives of two people where memories come alive and time bends to your will. *See* Exhibit C. The game starts out at a funeral pyre and treks through the characters' lives, reliving various moments and memories. *Id.* Based on these brief descriptions of the games alone, it is clear that Applicant's and the owner of the Cited Mark's video games are in no way similar or even of the same genre. In view of these notable differences between the video games offered under the marks, consumers are not likely to be confused as to the source or sponsorship of the goods and services.

Moreover, as discussed in more detail below, because Applicant's Mark is for a game that is part of the *Tales* series of games, consumers are even more unlikely to be confused between Applicant's Mark and the Cited Mark and the associated goods and services.

Applicant's Tales Series and Related Marks

Applicant's TALES OF ARISE game is part of the well-known *Tales* series of games, which consumers will immediately recognize and associate directly with Applicant. *See* Exhibit D. The *Tales* series is a franchise of fantasy role-playing video games. *Id.* The series first began in 1995 and currently includes sixteen main titles, multiple spin-off games and supplementary media in the form of manga series, anime series, and audio dramas. *Id.*

Applicant is the owner of the following registrations and allowed application for its various *Tales* games, which incorporate the terms TALES OF and are also registered or applied-for in connection with video game related goods and services. True and correct copies of the TSDR records for the below marks are attached hereto as Exhibit E.

Serial No.	Reg. No.	Mark
88321980		TALES OF CRESTORIA
86848273	5396921	TALES OF THE RAYS
86851067	5147894	TALES OF ZESTIRIA THE X
86716050	5042596	TALES OF LINK
86673275	5311859	TALES OF BERSERIA
86065287	4978419	TALES OF ZESTIRIA
85575868	4325711	TALES OF XILLIA
85546423	4325606	TALES OF HEARTS
77689925	4242274	TALES OF GRACES
77463490	3607384	TALES OF VESPERIA
77240639	3450688	TALES OF THE WORLD
76645196	3340554	TALES OF PHANTASIA
76635047	3268850	TALES OF THE ABYSS

76624233	3149282	TALES OF LEGENDIA
76599009	3090772	TALES OF SYMPHONIA
75151613	2249989	TALES OF DESTINY

In view of the above, Applicant's Mark TALES OF ARISE is directly associated with Applicant's *Tales* franchise of games, which also include the terms TALES OF, and therefore, will not be confused with the Cited Mark.

Because of the term ARISE is relatively weak as applied to the goods and services, the significant differences in appearance, sound, connotation and commercial impression of the marks and the high level of consumer sophistication in purchasing the related goods and services, Applicant submits that there is no likelihood of confusion between Applicant's Mark and the Cited Mark.

Accordingly, Applicant respectfully requests that the advisory be withdrawn and the application be removed from suspension and approved for publication.