

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Microsoft Corporation
APPLICATION SERIAL NO.:	90/023,489
MARK:	FABLE
OFFICE ACTION MAILING DATE:	August 29, 2020
EXAMINING ATTORNEY:	Brent M. Radcliff Law Office 123

RESPONSE TO OFFICE ACTION

I. Introduction

In the August 29, 2020 Office Action, the Examining Attorney refused registration of Applicant's FABLE mark ("**Applicant's Mark**") on the grounds of an alleged likelihood of confusion with three prior registrations: U.S. Reg. No. 5,005,492 for FABLE (The "**492 Registration**"); U.S. Reg. No. 6,115,441 for FABLE (The "**441 Registration**"); and U.S. Reg. No. 2,926,617 for FABLE (The "**617 Registration**"). Specifically, the Examining Attorney alleges that (1) the marks are identical in appearance, sound, and meaning, and (2) the goods are related because they are allegedly of a type that commonly emanate from the same source under the same mark.

As an initial matter, Applicant notes that it owns the '617 Registration and claimed ownership of the registration in the present application. Indeed, Applicant has used the FABLE mark in commerce for the goods cited in the '617 Registration since at least as early as September 14, 2004, some of which are related to the goods in Applicant's Mark. Notwithstanding the Examiner's evidence which allegedly shows that the goods and services in Applicant's Mark and the cited registrations are of a type that commonly emanate from a common source, Applicant is not aware of a single instance of consumer confusion with its '617 Registration and either of the other two cited registrations. Regardless, given the identical owner names in Applicant's Mark and the '617

Registration, Applicant presumes that this citation was issued in error and respectfully requests the Examining Attorney to withdraw the likelihood of confusion refusal with respect to the '617 Registration.

Applicant further disagrees with the Examining Attorney's conclusions for the reasons set forth below.

II. Applicant's Mark Differs from the Cited Registrations in Meaning and Commercial Impression Such that Consumer Confusion is Unlikely.

When considering likelihood of confusion, "[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered *before* similarity as to one or more of [the DuPont] factors may be sufficient to support a finding that the marks are similar or dissimilar." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000) (emphasis added).

It is a "basic principle in determining confusion between marks ... that marks must be *compared in their entirety* It follows from that principle that likelihood of confusion *cannot be predicated on dissection of a mark*, that is, on only part of a mark." TMEP § 1207.01(b) (emphasis added). *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985) (*footnotes omitted*) (*citations omitted*); *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402, 181 USPQ 272, 273-74 (C.C.P.A. 1974).

As previously stated, Applicant has used the FABLE mark as shown in the '617 Registration for over 16 years in connection with a computer game franchise, selling over 11.5 million copies worldwide. See sales reports for the FABLE franchise attached hereto as **Exhibit A**. Applicant's FABLE franchise has also won hundreds of awards, including

the BAFTA Best Action & Adventure Game of 2009 (attached hereto as **Exhibit B**), G4TV Game of the Year in 2008 (attached hereto as **Exhibit C**), and Gamespot Game of the Show from E3 2008 (attached hereto as **Exhibit D**). Indeed, the upcoming installment of Applicant's FABLE franchise is one of the most highly anticipated games of 2021. See articles discussing the upcoming release of FABLE IV attached hereto as **Exhibit E**. Given Applicant's extensive sales and significant recognition in the industry, Applicant's FABLE mark is famous within the meaning of the Lanham Act.

Moreover, to the millions of fans of Applicant's FABLE franchise, who are the target market for the goods and services in the present mark, the term "FABLE" has acquired a secondary meaning which differs from the meaning of "FABLE" in the cited registrations. While the term "Fable" itself means essentially "a short story," (see definition from Cambridge Dictionary attached hereto as **Exhibit F**) to Applicant's millions of fans, the term "Fable" has taken on a new meaning to refer to the specific story of the Hero in the fictional nation of Albion, as told in Applicant's FABLE franchise. See **Exhibit G**. Conversely, the term "Fable" in the '441 Registration indicates jewelry which is "shaped by the heritage of storytelling [in the] British countryside." See Jewelcity website attached hereto as **Exhibit H**. To the extent that the overlap of the term "Fable" in each of the marks indicates some type of "story," when the marks are viewed as a whole in relation to the relevant goods and services, each of the marks tells a strikingly different story, which changes the overall meaning and commercial impression of the marks.

Given this difference in meaning and commercial impression, there is no likelihood of confusion with Applicant's Mark and the cited registrations, and indeed, Applicant's '617 Registration has peacefully co-existed on the register with the '492 and '441

Registrations despite the Examiner's contention that all of the goods and services are related for the purposes of likelihood of confusion.

III. The Use of Words in Common Does not Mean that Two Marks are Similar.

The use of words in common in a trademark does not necessitate the finding that the two marks are similar. “[T]he mere fact that the marks in issue share elements, even dominant elements, does not compel a conclusion of likely confusion.” Likelihood of Confusion in Trademark Law, Richard L. Kirkpatrick, 4-49 (1995). “A review of the pertinent case law shows that mere following usage by one part of a word contained in a mark of another party does not, without more, require a finding of likelihood of product or source confusion. *Bell Laboratories, Inc. v. Colonial Products, Inc.*, 231 USPQ 569, 571 (S.D. Fla. 1986). Such an interpretation has been broadly accepted by both the courts and the Board, and should be considered by the Examining Attorney in the present case.

Applicant directs the Examining Attorney to the Eleventh Circuit's decision in *Freedom Savings and Loan Assoc. v. Way*, 226 USPQ 123 (11th Cir. 1985). In *Way*, the Eleventh Circuit rejected the plaintiff's argument that the marks FREEDOM SAVINGS and FREEDOM REALTY were confusingly similar despite recognizing that FREEDOM “was the most important part of the mark.” *Id.* at 127. The court explained that “the use of an identical word, even a dominant word, does not mean that two marks are similar.” *Id.* The court reached this conclusion even though the initial portions of the two marks were identical.

Moreover, in *Miller Brewing Co. v. Premier Beverages, Inc.*, 210 USPQ 43 (TTAB 1981), the Board dismissed a likelihood of confusion claim notwithstanding the complete incorporation of one mark into another. In so holding, the Board stated that “opposer's

position that its 'MILLER' mark has been completely incorporated in applicant's mark 'OL BOB MILLER'S' is correct. This does not alone signify that the marks as a whole are 'confusingly similar.'" *Id.* at 48.

Here, the fact that Applicant's mark and the cited registrations are identical in sight and sound, does not signify that the marks as a whole are confusingly similar given the differences in the meaning and commercial impression of the marks when applied to the respective goods and services. Therefore, there is no likelihood of confusion between Applicant's FABLE mark and the cited registrations.

IV. An Analysis of the Remaining DuPont Factors Proves that there is No Likelihood of Confusion Between Applicant's Mark and the Cited Registrations.

Applicant submits that the *DuPont* factors, as further elaborated in *In re E. I. DuPont DeNemours & Co.* weigh in Applicant's favor and prove there is no likelihood of confusion between Applicant's and Registrant's trademarks. *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361-1361 (C.C.P.A. 1973).

The thirteen factors laid out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973), known as the "duPont factors," are: (1) the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made; (5) the fame of the prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under

which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which the applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion; (13) any other established fact probative of the effect of use. *Id.* Specifically, the relevant *DuPont* factors are discussed in detail below:

1. The dissimilarity of established, likely-to-continue trade channels and the conditions under which and buyers to whom sales are made:

Where the ultimate customers for the goods are dissimilar, the possibility of any confusion is lessened significantly. See *Frehling Enters., Inc. v. Int'l Select Gp., Inc.*, 52 USPQ2d 1447 (11th Cir. 1999); *M2 Software, Inc. v. Madacy Entertainment*, 76 USPQ2d 1161 (9th Cir. 2005) (finding no triable issue of likelihood of confusion and finding the channels of trade factor to weigh “strongly” in defendant's favor where only one party sold its products in retail outlets).

As previously discussed, Applicant has used the FABLE mark as shown in the ‘617 Registration for over 16 years in connection with a computer game franchise, selling over 11.5 million copies worldwide. Given these extensive sales and notoriety for Applicant's computer game franchise, Applicant has an already-established customer base for its goods that differs from those in the cited registrations. Indeed, Applicant's products are specifically targeted towards consumers who are familiar with its famous FABLE computer game franchise, who would not be confused by a seller of e.g. *jewelry* or *home goods* which lack this implicit connection to the FABLE franchise. Thus, the goods and services Applicant's mark and the cited registrations are not related or marketed in such

a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, so consumer confusion is unlikely. See *Local Trademarks, Inc. v. Handy Boys, Inc.*, 16 USPQ2d 1668 (TTAB 1986); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed Cir. 2004); TMEP § 1207.01(a)(i).

2. The nature and extent of any actual confusion and the length of time during and conditions under which there has been concurrent use without evidence of actual confusion

As discussed in detail above, Applicant has used the FABLE in connection with goods related to those in the present application since at least as early as September 14, 2004 and Applicant is aware of **no actual confusion** between Applicant's mark and the cited registrations despite their overlapping existence in the marketplace. In light of the ongoing peaceful co-existence of the Applicant's '617 Registration and the cited registrations without any evidence of actual confusion, the extent of potential confusion is *de minimis*, particularly given the fame of Applicant's FABLE mark in connection with its computer game franchise, and the starkly different meanings attributed to the marks. This factor weighs very heavily in support of Applicant's finding that consumer confusion is not likely to arise.

Applicant asserts therefore that consumer confusion is unlikely and Applicant respectfully requests the Examiner to withdraw the refusal.

V. Conclusion

In view of the arguments set forth above, Applicant respectfully submits that this Response fully addresses all issues raised in the Office Action issued on this mark, and

respectfully requests that the Examining Attorney lift his refusal and approve this application for publication.