

**RESPONSE**

This is a response to the Office Action issued July 12, 2019, wherein the Examining Attorney again refused registration of Applicant's CODE mark based on a likelihood of confusion with this registration:

| Mark     | CODE                                                                                                                                                                                                                                            |
|----------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Services | IC 035. Promotion consulting services; marketing consulting services in the field of business development.<br><br>IC 041. Educational services, namely, providing sales training in the field of improving promotional and marketing processes. |
| Reg. No. | 3246221                                                                                                                                                                                                                                         |
| Owner    | MarketSmartz, Inc.                                                                                                                                                                                                                              |

Applicant explained in its prior response that many CODE marks coexist for Class 35 consulting and advisory services, making CODE very weak for these services. In her response, the Examining Attorney argued that CODE is not weak because "the marks in the third-party registrations contain additional matter, which alter the commercial impressions of the marks." Applicant disagrees with this analysis.

Among the third-party registrations is No. 5007926 for C.O.D.E. for "business consulting services in the field of communication and presentation." These communication and presentation consulting services are *very closely related* to the cited registrant's promotion and marketing consulting services. Since the *nearly identical marks* C.O.D.E. and CODE already coexist for *very closely related services*, so too can Applicant's CODE mark for *different* consulting services *which specifically exclude the cited registrant's services*.

The third-party registrations also include No. 4396300 for ART COPY & CODE, *with "ART COPY" disclaimed, for the same services identified in the cited*

**registration:** “providing advertising, marketing, and promotional services; providing information in the field of advertising and marketing; providing information in the field of interactive advertising campaigns; **consulting services in the field of advertising**; providing an online, interactive website featuring advertising information, strategies, and advice.” Given the disclaimer of “ART COPY,” this mark is in effect **nearly identical** to the cited CODE mark. *In re Now Yoga, LLC*, Serial No. 85677969 (January 27, 2015) [not precedential] (matter that is descriptive of or generic for an applicant’s goods and services “do little to distinguish” marks); *In re Dixie Restaurants Inc.*, 105 F.2d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (the dominant part of applicant’s mark THE DELTA CAFÉ and design is the word “Delta” because applicant disclaimed the generic word “Café.”); *In re Denisi*, 225 UPSQ 624 (TTAB 1985) (PERRY’S PIZZA for restaurant services specializing in pizza is likely to cause confusion with PERRY’S for restaurant and bar services). *See also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting, In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1983) (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.”). If this registration can coexist with the cited registration **for the same services**, so too can Applicant’s CODE mark **for different services that specifically exclude the cited registrant’s services**.

As to the remaining third-party registrations for CODE-formative marks for the same or related services, the Board has held that such evidence indeed supports a finding that CODE is weak and that the cited registration is entitled to a narrowed

scope of protection. *See, e.g., In re 8415927 Canada, Inc.*, Serial Nos. 87056710 and 87056720 (October 25, 2018) [not precedential] (word DIVE in the marks DIVE PRIME SEAFOOD [PRIME SEAFOOD disclaimed] and DIVE COASTAL CUISINE [COASTAL CUISINE disclaimed] held conceptually weak based on third-party registrations for DIVE-formative marks such as FIVE STAR DIVE BAR, PEACE BURGER DIVE BAR AND GRILL, PEARL DIVE OYSTER PALACE, POTBELLY SANDWICH WORKS A FIRST CLASS DIVE SINCE 1977, TACO DIVE NOT YOUR AVERAGE HOLE IN THE WALL, DIVE IN. DINE. UNWIND., DIVE INN, DIVE-IN THEATER, UDE ULTIMATE DIVE EXPERIENCE, NOSE DIVE, DIG & DIVE, DIVE ‘N’ BOAR, and DUCK DIVE).

For the above reasons, Applicant maintains that CODE is weak and entitled to a narrow scope of protection for consulting and advisory services, and that CODE marks, *even without additional matter*, can coexist based on differences in the precise nature of these services.

Given the differences in the parties’ services, *which do not overlap*, and the consumers to whom they are directed, confusion is unlikely and Applicant again asks that the Examining Attorney withdraw the refusal and approve this application for publication.