

Mark: FAMILY CONNECTS



Serial No.: 88/201,376
Applicant: Duke University
Classes: 35, 44

RESPONSE TO OFFICE ACTION

Applicant respectfully submits the following remarks in response to the Final Office Action dated October 8, 2019, in which the Examining Attorney:

- (i) refused Applicant's registration on the basis that the applied-for mark is confusingly similar to U.S. Registration No. 3520556 (the "Cited Registration");
- (ii) required a substitute specimen for the Class 44 services; and
- (iii) requested clarification of the goods and services identification.

I. Likelihood of Confusion with Cited Registration

In response to the Section 2(d) refusal, and pursuant to Section 1207.01(d)(viii) of the Trademark Manual of Examining Procedure, Applicant hereby submits an executed Consent to Registration and Use in which American Printing House for the Blind (the "Registrant"), the owner of the Cited Registration, expressly consents to the registration of the applied-for mark. Specifically, the Registrant "consents to the use and registration by [Applicant] of the [applied-for mark] in connection with the [Class 35 and 44 Services]" and, together with Applicant, "believe that there is and will be no likelihood of confusion resulting from the simultaneous use and registration of the [applied-for mark] and the [Cited Registration] for the parties' respective goods and services[.]"

Such evidence "should be given great weight" in considering the alleged likelihood of confusion between the applied-for mark and the Cited Registration. TMEP § 1207.01(d)(viii). Indeed, "the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason . . ." *Id.*; see also *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1363, 177 USPQ 563, 568 (C.C.P.A. 1973) ("[W]hen those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't.").

In this case, given that Registrant consents to the registration of the applied-for mark and agrees that the registration will not create a likelihood of confusion, Applicant respectfully requests that the Section 2(d) refusal be withdrawn and that Applicant's application be approved for publication.

II. Substitute Specimens

Applicant also submits two substitute specimens to show the applied-for mark in connection with its Class 44 services.

III. Goods and Services Identification

Finally, Applicant amends its goods and services descriptions as follows (underlines are additions):

Class 35 – Providing information about supporting newborns and their families, namely, best practices, strategies, and tips related to healthcare, parenting, parent mental health, and connections to community agencies, namely, coordinating nurse home visits for families with newborns, assessing newborn and maternal health, and facilitating relationships between new parents and community resources regarding family health

Class 44 – Consulting services related to the implementation of a model for supporting newborns and their families, namely, best practices, strategies, and tips related to healthcare, parenting, parent mental health, and connections to community agencies, namely, coordinating nurse home visits for families with newborns, assessing newborn and maternal health, and facilitating relationships between new parents and community resources regarding family health