

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Artpool, LLC
Serial Number: 88/147549
Filing Date: October 9, 2018
Mark: MUSE
Examining Atty: Benjamin Rosen, Esq.

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

RESPONSE TO OFFICE ACTION

Artpool LLC ("Applicant") submits the following amendment and remarks in response to the Office Action dated January 25, 2019.


AMENDMENT

Please replace the current identification of goods with the following identification of goods (as amended, "Applicant's Amended Goods"):

Entertainment services in the nature of fashion shows; Fashion modeling for entertainment purposes; Hosting social entertainment events, namely, fashion shows, art and body art showcases, and runway events in the nature of fashion shows and art and body art showcases for others; Organization of fashion shows for entertainment purposes.

SECTION 2(d) AND ANTICIPATORY REFUSALS

The Examining Attorney initially refused registration of Applicant's MUSE mark ("Applicant's Mark") under Section 2(d), 15 U.S.C. § 1052(d), on the ground of an alleged likelihood of confusion with U.S. Registration Nos. 5462419, 4993216, 5011703, 2471368, and 4174021(dead) (the "Cited Registrations"), and prior-pending Application Nos. 79/247595 and 87/830187 (the "Cited Applications"); collectively, the Cited Registrations and the Cited Application are the "Cited MUSE Marks"):

Mark	Reg. No./Serial No.	Goods/Services	Owner
MUSE – THE ART OF STYLE	5462419	IC 41 Organization of fashion shows for entertainment purposes	The Muse Fashion LLC
MUSE	4993216	IC 41: Educational and entertainment services, namely, providing art instruction and art activities, namely, art and painting classes	Muse Paintbar, LLC
A MUSE	2471368	IC 35: Art gallery	A Muse Gallery
	5011703	IC 41: Educational and entertainment services, namely, providing art instruction and art activities, namely, art and painting classes	Muse Paintbar, LLC
MUSE GALLERY	4174021 DEAD	IC 35: Art galleries	A Muse Gallery
MUSE	79/247595	IC 35: Retail services for works of art provided by art galleries; promoting artwork of others	Bayerische Motoren Werke
MUSE	87/830187	IC; 9, 16 IC 41: Educational services in the filed of luxury goods and services	Robb Report Media LLC

		consisting of travel, automobiles, boating, aviation, jewelry, wine, spirits, vacation properties, etc.	
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For the reasons discussed below, Applicant respectfully requests that the Examining Attorney reconsider and withdraw the likelihood of confusion refusals and the anticipatory refusal.

A. The Diluted Nature of MUSE for Artwork and Fashion Makes Confusion Unlikely

It is well settled that the prevalence of third-party registrations that contain a shared term can be probative to the extent that it shows that the term "has been adopted and registered by others in a particular field, indicating that the word is more suggestive than arbitrary in a particular field and, thus, that the registration of a mark consisting of that word for goods or services in the same or a related field should be given a more restricted scope of protection."

Pizza Inn, Inc. v. Russo, 221 USPQ 281, 283 (TTAB 1983).

Such is the case here. Indeed, the diluted nature of the marks is evidenced by the coexistence of the 4 Cited Registrations, all of which are owned by 3 unrelated third-parties and which contain the literal element MUSE. The PTO has recognized the narrow scope of protection afforded the Cited Registrations by allowing them to coexist in Class 41 in carved-out, niche areas of the art and fashion. Indeed, the definition of the word "muse" is a person who is "the source of inspiration for a creative artist." The word comes from Greek and Roman mythology for each of the nine goddesses who preside over the arts and sciences. (Google Dictionary Exhibit 1.)

Just as the Cited Registrations have been allowed to coexist on the Register, and presumably in the marketplace, Applicant's MUSE trademark should be allowed to register for

its Amended Goods. The Cited Registrations and the Cited Applications have a different commercial impression that Applicant's trademark and consumer confusion is not likely.

B. There is Additional Evidence of Dilution

The Examining Attorney argues that 4 Cited Registrations bars Applicant's application for the trademark MUSE in Class 41. However, in addition to the Cited Registrations, there 348 "live" MUSE and MUSE-themed trademarks listed in TESS. Of those, 71 listings are in Class 41 and, of those, 53 MUSE trademarks are registered in Class 41. (TESS List attached as Exhibit 2.) Of the 53 MUSE registrations, approximately 34 list or include "art," "fashion," "jewelry," and "music" in the ID of Services.

Accordingly, based on the plethora of third-party use of the word MUSE and the narrow scope afforded the coexisting marks, Applicant submits that confusion between Applicant's mark and the Cited Registrations is highly unlikely.

C. Mere Possibility of Confusion is Not Enough; the PTO Must Show a Probability of Likelihood of Confusion

Finally, the Federal Circuit has stated that more than a mere possibility of confusion must be shown; instead it must be demonstrated that there is a probability of likelihood of confusion. *See Witco Chemical Co. v. Whitfield Chemical Co.*, 164 USPQ 43, 44-45 (CCPA 1969) ("We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark law deals."); *Electronic Design & Sales Inc. v. Electronic Data Sys. Corp.*, 21 USPQ2d 1388, 1391 (Fed. Cir.1992).

Applicant submits that, for the reasons detailed above, there is no probability of likelihood of confusion between Applicant's mark and the Cited Registrations listed in the Office Action.

CONCLUSION

In view of the foregoing, Applicant respectfully requests that the Examining Attorney withdraw the refusals to register and forward the application for publication.

Respectfully submitted,

Artpool LLC

/Mary F. Love/

Mary Frances Love

Attorney for Applicant