

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : MAVEN
Serial No. : 88119594
For : REMARKABLE.LEGAL
Examiner : Aaron Rosenthal
Law Office : 120

RESPONSE TO OFFICE ACTION DATED 03/22/2019

This is responsive to Office Action dated 03/22/2019. The Applicant respectfully requests that the application be reconsidered.

BACKGROUND

Applicant Maven Design seeks registration of U.S. Serial No.88119594 for MAVEN in relation to "Business consulting services, namely, providing assistance in development of business strategies and creative ideation; Creative marketing design services" in International Class 35 and "Design and testing of new products for others; Graphic design services; Industrial design; New product design services" in International class 042. The Examining Attorney has refused registration of the mark.

The Examining Attorney alleges that the applied for mark is likely to be confused with the mark(s) listed below. Trademark Act Section 2(d), 15 U.S.C. § 1052(d); see TMEP § § 1207.01 et seq.

- U.S. Registration No. 4602532 for METRIX MAVEN covering "business consulting and information services" in International Class 35.
- U.S. Registration No. 4883954 for MAVEN WAVE covering "business management consulting services" and "development of marketing strategies and concepts" amongst others, in International Class 035, and "development and creation of computer programs for data processing; design and development of computer software" in International Class 042.
- U.S. Registration No. 4883955 for MAVEN WAVE plus design, (4883955) covering “Business management consulting services” and “development of marketing strategies and concepts” amongst others, in International Class 035, and “development and creation of computer programs for data processing; design and development of computer software” in International Class 042.
- U.S. Registration No. 5150252 for MEDIA MAVEN covering “Advertising services, public relations and marketing services, namely, promoting and marketing the goods and services of others through all public communication means” in International Class 035
- U.S. Registration No.5194573 for MEDIA MAVEN” plus design covering “Advertising services, public relations and marketing services, namely, promoting and marketing the goods and services of others through all public communication means” in International Class 035

**APPLICANT'S ARGUMENT THAT THE MARK PRESENTS NO LIKELIHOOD OF
CONFUSION**

Applicant respectfully disagrees with the Examining Attorney's decision for the reasons discussed below.

The Standard for Determining Likelihood of Confusion

A determination of likelihood of confusion between two marks is determined on a case by case basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The Examining Attorney is to apply each of the applicable thirteen factors set out in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). The relevant DuPont factors as they relate to likelihood of confusion in this case are reviewed below.

**The similarity or dissimilarity of the marks in their entirety as to appearance, sound,
connotation, and commercial impression;**

In comparing two trademarks for confusing similarity, the Examining Attorney must compare the marks for resemblances in sound, appearance and meaning or connotation. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Similarity in one respect - sight,

sound, or meaning - does not support a finding of likelihood of confusion, even where the goods or services are identical or closely related. TMEP §1207.01(b)(i).

It has long been established under the "anti-dissection rule" that "the commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety." *Estate of P. D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 64 L. Ed. 705, 40 S. Ct. 414 (1920). It violates the anti-dissection rule to focus on the "prominent" feature of a mark, ignoring other elements of the mark, in finding likelihood of confusion. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). See *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233 (C.C.P.A. 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."); *Sun-Fun Products, Inc. v. Suntan Research & Development, Inc.*, 656 F.2d 186, 213 U.S.P.Q. 91 (5th Cir. 1981) (the test is "overall impression," not a "dissection of individual features").

1. No Explicit Rule that Likelihood of Confusion Applies Where Junior User's Mark Contains the Whole of Another Mark.

There is no explicit rule that likelihood of confusion automatically applies where a junior user's mark contains in part the whole of another mark. See, e.g., *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A.

1973) (TIC TAC not confusingly similar to TIC TAC TOE); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 507 F.2d 1404, 184 U.S.P.Q. 422 (C.C.P.A. 1975) (COUNTRY VOGUES not confusingly similar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (there is no absolute rule that no one has the right to in-corporate the total mark of another as a part of one's own mark: MMI MENSWEAR not confusingly similar to MEN'S WEAR); *Plus Products v. General Mills, Inc.*, 188 U.S.P.Q. 520 (T.T.A.B. 1975) (PROTEIN PLUS and PLUS not confusingly similar). See *Monsanto Co. v. CI-BA-GEIGY Corp.*, 191 U.S.P.Q. 173 (T.T.A.B. 1976) (use of portion of another's mark to indicate that defendant's product contains plaintiff's product held not likely to cause confusion). Even the use of identical dominant words or terms does not automatically mean that two marks are similar. *Luigino's Inc. v. Stouffer Corp.*, 50 USPQ2d 1047, the mark LEAN CUISINE was not confusingly similar to MICHELINA'S LEAN 'N TASTY though both products were similar low-fat frozen food items and both shared the dominant term "lean." Finally, "marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight." *In re Hearst*, 982 F.2d 493, 494 (Fed.Cir. 1992). In *Hearst*, Applicant registered VARGA GIRL for calendars and was refused registration by the Trademark Trial and Appeal Board because of earlier registration of VARGAS for posters, calendars, and greeting cards. The Federal Circuit reversed the refusal on appeal. The higher court found that the Board inappropriately changed the mark by diminishing the portion of "girl." When the mark was reviewed in its entirety, there was no likelihood of confusion. Here, the marks share the term "MAVEN" in common but this common term is not enough to support a finding of likelihood of confusion, particularly where there are a number of differentiating factors.

2. Marks Differ in Sight, Sound, and Commercial Impression

MAVEN, METRIX MAVEN, MAVEN WAVE,



a. Marks Differ in Sight

Where there is an addition of a distinctive element, as in a term or a design, or there is a significantly different display of the same terms, there is little likelihood of confusion. *First Savings Bank, F.S.B. v. First Bank Systems, Inc.*, 40 U.S.P.Q.2d 1865 (10th Cir. 1996) (no confusion between FIRST BANK and FIRST BANK SYSTEM (and design)). Likelihood of confusion is minimized where a design is used as part of a mark. *Harlem Wizards*, 952 F. Supp. at 1096 (citing *McCarthy* at §23:15[51]).

A visual examination of the literal elements of the conflicting marks supports a finding that they are different. Applicant's mark consists of MAVEN. In contrast, Registrants' marks consists of METRIX MAVEN, MAVEN WAVE, and MEDIA MAVEN, each with two words. Given the significantly different literal elements discussed above, there is little likelihood of confusion.

b. Marks Differ in Sound

Here, the marks vary substantially in sound. Applicant's mark is pronounced with 2 syllables whereas Registrants' marks are pronounced with 4 syllables and 4 syllables respectively. Moreover,

applicant's mark consists of only one word but the other registered marks have two words each and take longer to pronounce. As such, these marks sound little alike and have an entirely different phonetic profile.

However, even where two marks are phonetically similar, no likelihood of confusion exists if other differentiating factors can be established. See *National Distillers & Chemical Corporation v. William Grant and Sons, Inc.*, 505 F.2d 719 (finding that DUVET and DUET did not raise likelihood of confusion where other differentiating factors existed such as the term "duet" was a com-mon word whereas "duvet" was not). As stated above, the visual differences between Applicant's mark and the Registrant's mark provide one of many differentiating factors that do not support a claim of likelihood of confusion.

c. Marks Differ in Commercial Impression

The marks in this case vary substantially in commercial impression. Applicant's mark has only one word and customers can easily distinguish between a one word mark and a two word mark regardless of design. Customers are unable to decipher the services applicant provides from viewing applicant's mark alone. However, customers can almost correctly predict the services provided by registrant, MEDIA MAVEN as the presence of the word MEDIA places registrant into a certain category. The Oxford dictionary defines the word MAVEN as "An expert or connoisseur" See Exhibit A. Hence the applicant's customers can assume applicant to be an expert in the services it provides. While registrant. METRIX MAVEN's customer may not be able to automatically place registrant in a

category as the meaning of METRIX is uncertain. As well as MAVEN WAVE, customers may liken registrant's services to services that relate to the ocean or the wind.

Given the significant differences in commercial impressions, there is little likelihood of confusion between the marks.

The similarity or dissimilarity and nature of the goods as described in an application or registration or in connection with which a prior mark is in use;

Goods and services fall into three categories: (1) competitive, (2) non-competitive but related, and (3) non-competitive and non-related. *Homeowners Group, Inc. v. Home Mktg. Specialists Inc.*, 931 F.2d 1100, 18 USPQ2d 1587,1593 (6th Cir. 1991). Services in the last category are unlikely to be confused. *Murray v. Cable National Broadcasting Co.*, 86 F.3d 858,861 39 USPQ2d 1214 (9th Cir. 1996). Moreover, "the presence of goods in the same store does not necessarily lead to the conclusion that confusion would arise under such conditions." *7-Eleven, Inc. v. HEB Grocery Company, LP*, 83 U.S.P.Q.2d 1257 at *22 (TTAB 2007)(citations omitted).

In class 042, applicant and registrant's marks are noncompetitive and non-related. Applicant provides "Design and testing of new products for others; Graphic design services; Industrial design; New product design services" while registrants' provide "development and creation of computer programs for data processing; design and development of computer software" MAVEN WAVE" (4883954) and development and creation of computer programs for data processing; design and development of computer software"MAVEN WAVE" plus design, (4883955) respectively. Applicant

does not provide any software services either in the design or development of software, although it might use software in the design of its graphics, applicant is not trying to trademark its mark for the use of software in its graphic design services.

Applicant designs and tests Consumer Electronics, Medical Devices and Consumer Packaging for customers, hence customers seeking this service will not hire any of registrants listed above as they do not provide this service, See EXHIBIT B. Given the dissimilar nature of the services of both parties, there is little likelihood of confusion.

The number and nature of similar marks in use on similar goods;

Marks may contain elements in common without creating consumer confusion if the common matter is merely descriptive or diluted. See *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (Holding that GOLDEN CRUST for flour not likely to be confused with ADOLPH'S GOLD'N CRUST AND DESIGN for coating and seasoning for food items). In *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986), the Federal Circuit found no likelihood of confusion existed between the marks BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL. Not only were the marks not confusingly similar in sound or appearance, but because that record showed a "large number of variously named 'bed and breakfast' services," the Applicant's mark would be unlikely to cause consumer confusion. *Id.* at 159. In *The Plak-Shack, Inc. v. Continental Studios of Georgia, Inc.*, 204 USPQ 242 (TTAB 1979), The Trademark Trial and Appeal Board found no likelihood of confusion existed between PLAQUE VILLAGE and PLAK-SHACK. The Board cited the descriptive nature and dilution of the word "plaque," listing marks such as PLAK-A-RAMA,

PLAK-TIME, PLAKTIQUE, COUNTRY MALL PLAQUE SHOP, DAISY TREE SHOPS PLAKS, THE FINISHING TOUCH PLAQUE SHOP, PLACK-BOUTIQUE, YE OLD PLAK SHOP, PLAQUE SHOP, and THE PLAQ PLACE.

Dilution of a common element can be shown by the existence of several third-party registrations, or by evidence of actual third party use. *AMF Inc. v. American League Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269-7- (CCPA 1973) (The multiplicity of fish names used to designate a variety of boats may serve to weaken the distinctiveness of any particular fish name as part of a mark for a boat); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (Existing, widespread third-party use of "VEUVE" on alcoholic beverages could serve to indicate the weakness of the term in the context of its source-identifying significance).

Here, the word MAVEN, much like the terms cited in the examples above, is common between the marks and diluted as applied to the field of business consulting and marketing in international classes 035 and 042. Applicant attaches evidence showing the existence of various other marks containing the word MAVEN in the relevant classes, including but not limited to the registrations in Exhibit C.

Consumers are inundated by the word MAVEN with respect to these goods and services, and will not assume that goods or services stem from the same source merely because marks share this single term. The term is individually diluted and weak, and should be given even less weight in a likelihood of confusion analysis regarding marks which share it.

Given the significant dilution of the word MAVEN for the relevant market, there is little likelihood of confusion.

CONCLUSION

For the reasons listed above, Applicant respectfully requests that the Examining Attorney should remove all refusals for the trademark MAVEN (U.S. Serial No. 88119594) and approve the mark for publication.

Respectfully submitted:



Miriam Eniolorunda, Esq.
Attorney of Record, Wisconsin Bar Member

REMARKABLE.LEGAL
P.O. BOX 4120
ECM #72065
PORTLAND, OR 97208
503-549-4854
docket3@remarkable.legal

EXHIBIT

A



SIGN IN

DICTIONARY



Home British & World English maven

GET WORD OF THE DAY BY EMAIL

Enter your email address

Click here to see our privacy policy.

Definition of *maven* in English:



maven

NOUN

North American informal

[often with modifier] An expert or connoisseur. *'fashion mavens call beige oatmeal'*

More example sentences

Synonyms



Try our interactive feature to learn how words enter the OED!

OED

Oxford English Dictionary
The definitive record of the English language

Purchase an OED subscription for just £90 / \$90

EXHIBIT

B

WE ABSOLUTELY LOVE WHAT WE
DO
AND THAT REFLECTS IN THE
EXPERIENCE
OF WORKING WITH US.

ENVISIONING

Envisioning is the creative process of visualizing the future. We start by meeting with your team to define your target consumer and their specific needs. We analyze technological and social trends to define a whitespace in your market. We then help flesh out big ideas and frame them in a way that will align shareholders with your team. We work with you to map the road ahead, imagine new projects, and prepare for innovation so you're always one step ahead.

UNDERSTAND

- Design research
- User testing
- Workshop facilitation
- Persona development
- Opportunity identification

CREATE

- Prototyping
- Journey mapping
- Product roadmapping
- Investor presentations
- User experience design
- Visual storyboarding

DESIGN

We leverage our multidisciplinary experience to create solutions that are not just beautiful, but functional and relevant to your business. We collaborate closely with your product team to understand technical constraints, identify undiscovered opportunities, and develop award-winning solutions with a clear line of sight to your marketplace.

DESIGN

- Industrial design
- Interaction design
- Concept generation
- Ideation facilitation
- Usability Evaluation
- Product Design

DEVELOP

- Visual design language
- Rapid prototyping
- CAD surfacing
- CMF specification
- Technical specification
- Manufacturing

EXHIBIT

C

United States of America

United States Patent and Trademark Office

MINDMAVEN

Reg. No. 4,657,704

MINDMAVIN (CALIFORNIA SOLE PROPRIETORSHIP)
12 BAYVIEW

Registered Dec. 16, 2014

MILL VALLEY, CA 94941

Int. Cl.: 35

FOR: BUSINESS MANAGEMENT CONSULTANCY AND ADVISORY SERVICES; BUSINESS CONSULTANCY, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

SERVICE MARK

FIRST USE 9-27-2014; IN COMMERCE 9-27-2014.

PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 86-193,616, FILED 2-14-2014.

JORDAN BAKER, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

United States of America
United States Patent and Trademark Office

MAVEN

Reg. No. 4,289,153

Registered Feb. 12, 2013

Int. Cls.: 35, 42 and 45

SERVICE MARK

PRINCIPAL REGISTER

MAVENSAY INC. (CANADA CORPORATION)
SUITE 802
150 FERRAND DRIVE
TORONTO, CANADA M3C3E5

FOR: ADVERTISING AND MARKETING SERVICES PROVIDED BY MEANS OF INDIRECT METHODS OF MARKETING COMMUNICATIONS, NAMELY, SOCIAL MEDIA, SEARCH ENGINE MARKETING, INQUIRY MARKETING, INTERNET MARKETING, MOBILE MARKETING, BLOGGING AND OTHER FORMS OF PASSIVE, SHARABLE OR VIRAL COMMUNICATIONS CHANNELS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-9-2012; IN COMMERCE 3-25-2012.

FOR: COMPUTER SERVICES, NAMELY, CREATING AN ON-LINE COMMUNITY FOR REGISTERED USERS TO MAKE, DISCOVER AND SHARE RECOMMENDATIONS ABOUT PLACES, GOODS, SERVICES AND OTHER CONTENT, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 1-9-2012; IN COMMERCE 3-25-2012.

FOR: ON-LINE SOCIAL NETWORKING SERVICES, IN CLASS 45 (U.S. CLS. 100 AND 101).

FIRST USE 1-9-2012; IN COMMERCE 3-25-2012.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 4,200,064.

SER. NO. 85-692,248, FILED 8-1-2012.

ELLEN PERKINS, EXAMINING ATTORNEY



Lisa Stansel

Acting Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office

Mingling Maven

Reg. No. 3,705,249 ROANE, SUSAN (UNITED STATES INDIVIDUAL), DBA THE ROANE GROUP
Registered Nov. 3, 2009 320 VIA CASITAS, #310
GREENBRAE, CA 94904

Int. Cl.: 35 FOR: BUSINESS CONSULTATION IN THE FIELD OF COMMUNICATION/BUSINESS NETWORKING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

SERVICE MARK FIRST USE 1-1-1992; IN COMMERCE 1-1-1992.
PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 77-716,327, FILED 4-17-2009.

DOMINICK J. SALEMI, EXAMINING ATTORNEY



David J. Kyros

Director of the United States Patent and Trademark Office