

Trademark Office Action Response

Response to March 20, 2019 Office Action

Applicant: Go Church Corporation

Serial No. 88231142

Filed: December 16, 2018

Mark: "GO" with design elements

Examining Attorney: Justin Miller

The Examining Attorney has refused registration of the Applicant's mark "GO" with design elements based on a likelihood of confusion from earlier registrations for the mark "GO MINISTRIES." Applicant respectfully submits this response.

1. Likelihood of Confusion

Refusal of Registration. The Examining Attorney has taken the initial position that the Applicant's mark "GO" with design elements, and the registered mark "GO MINISTRIES" share the identical wording "GO" and that because the additional wording "MINISTRIES" has been disclaimed in the registered mark, it does not obviate the similarity between it and the applied for mark, because disclaimed matter that is descriptive of or generic for a party's services is typically less significant or less dominant when comparing marks. In re Detroit Athletic CO., 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing In re Dixie Rests., Inc., 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP § 1207.01(b)(viii), (c)(ii). With all due respect to the Examining Attorney, the registered mark consists of two words beginning with the phrase "GO" and ending with a three-syllable word (i.e., "MINISTRIES"). The Applicant's mark consists of one word, "GO," with design elements composed of more than one arrow. Unlike the marks in In re Detroit Athletic CO., here, both marks do not conjure the same image. "GO MINISTRIES" conjures the image of Christian ministry services, while the mark "GO" with design elements does not conjure any image of Christian ministry services, or of any specific service whatsoever. The identical wording "GO" cannot act as a description for the goods and services that either party provides and therefore cannot create a similar commercial impression between the two marks.

Additionally, the mere fact that "MINISTRIES" is disclaimed does not give one license to simply ignore those words in the likelihood of confusion analysis because confusion is evaluated from the perspective of the purchasing public, which is not aware of that certain words or phrases have been disclaimed. Id at 1305. Similarly, it is well established that "likelihood of confusion cannot be predicated on dissection of a mark . . . the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); TMEP § 1207.01(b)(iv). When the marks are compared in their entireties, they are significantly different in visual and aural impression, in meaning, and in overall commercial impression.

The Word "GO" is Not Dominant. The Examining Attorney acknowledges that marks are compared in their entireties yet asserts that the word "MINISTRIES" in the registered mark is less significant or less dominant because it has been disclaimed, therefore rendering the word "GO" as the dominant element of the mark. However, the records of the Patent and Trademark Office demonstrate that many entities have used "GO" in relation to the Applicant's services, making it unlikely that consumers would give significant weight to this term in ascertaining the source of such services. Examples of this practice are set forth in the following table, along with the registrations cited by the Examining Attorney:

| Mark/Owner | Goods or Services | Reg. No./Date |
|--|--|----------------------------|
| GO HARD FOR CHRIST YOUTH MINISTRY/ Living Word Christian Center DBA Go Hard For Christ Youth Ministry | Entertainment services, namely, providing a web site featuring photographic, video and prose presentations featuring Christian Religion and Education | 4256575/December 11, 2012 |
| WAY TO GO MINISTRIES/ Everett, Leshia Campbell | Ministerial and evangelistic services | 2600963/July 30, 2002 |
| GO TELL IT EVANGELISTIC OUTRACH MINISTRIES, INC./ Redd, Charles B. Jr. | Evangelistic and ministerial services | 1751665/February 9, 1993 |
| A CHURCH FOR PEOPLE WHO DON'T GO TO CHURCH/ Grace Community Church of Arlington | Christian ministry services | 5049428/September 27, 2016 |
| LET'S GO TO CHURCH/ Hayden Huddleston Advertising Agency, Inc. | Non-denominational religious program | 0909823/March 9, 1971 |

As can be seen from the illustrative registrations above, use of the word "GO" in conjunction with religious services is quite common. As a result of being exposed to numerous marks containing "GO", relevant consumers are likely to consider the entire mark in ascertaining the source of the goods and services, and to differentiate goods and services using the entire mark, which must be taken into consideration in the likelihood of confusion analysis. In re Detroit Athletic CO., 903 F.3d 1297 at 1035. Therefore, Applicant maintains that "GO" is not the dominant portion of the registered mark and should not be given special weight in comparing Applicant's mark to the registered mark.

Connotation of the Marks. The Examining Attorney correctly notes that the Applicant's mark incorporates the identical wording "GO". However, Applicant respectfully disagrees with the Examining Attorney's opinion that the addition of the word "MINISTRIES" in the registered mark does not create a commercial impression that is different than the Applicant's mark. Applicant notes that the Examining Attorney does not provide any evidence as to the likely commercial impressions of the two marks taken in their entirety. Applicant is aware that the registered mark "GO MINISTRIES" conjures an image of Christian ministry services, while the Applicant's mark "GO" with design elements including more than one arrow, taken by itself, does not conjure an image of any form of Christian service whatsoever.

Strength of the Cited Mark. In comparing Applicant's mark with the registered mark, one factor that must be considered is the impact of prior registrations on the strength of the registered marks. TMEP § 1207.01 ("In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered: . . .6. The number and nature of similar marks in use on similar goods.")

In light of the foregoing evidence that many entities have used GO-based marks in connection with religious based services and activities, it would be disingenuous to claim that the registered mark is a strong mark. "[I]n a 'crowded' field of similar marks, each member of the crowd, is relatively 'weak' in its ability to prevent use by others in the crowd." J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 11:85 at 11-163 (4th Ed. 2001). Accordingly, the cited "GO" registrations should be given a narrow scope of protection, in light of their coexistence, barring registration of only virtually identical marks.

Visual Impression. Applicant's mark is drastically different in its visual appearance from the registered mark. Because the marks must be considered in their entirety, the word "GO" with design elements creates a markedly different visual appearance from the wording "GO MINISTRIES". While both the marks contain the word "GO," the change in the second term is telling: "GO MINISTRIES" and "GO" do not share any visual similarities. This makes consumer confusion highly unlikely.

Aural Impression. Spoken aloud, "GO" does not sound similar to "GO MINISTRIES". Due to the lack of aural similarity between the registered mark and Applicant's mark, there is no likelihood of confusion among consumers who hear the registered mark and Applicant's marks.

Meaning. The meaning of the Applicant's mark and the cited mark is also very different. While the word "MINISTRIES" refers to the services that a minister offers to others, the word "GO" used by itself is commonly used for all manner of human action.

Taken together with the visual and aural differences between the marks, it is clear that the marks are not likely to be confused in the marketplace. The registered mark is different from Applicant's mark with design elements in sight, sound, and meaning, as well in overall commercial impression. The protection afforded the registered mark has been tightly circumscribed by the extensive third party use of "GO" based marks for similar goods. Accordingly, there is no likelihood of confusion between the registered mark and Applicant's mark.

2. Conclusion

For the foregoing reasons, Applicant respectfully requests that the refusal be withdrawn, and its mark be passed on to publication.

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