

Mark: FAMILY CONNECTS
Serial No.: 88201376
Applicant: Duke University
Classes: 35, 44

RESPONSE TO OFFICE ACTION

Applicant respectfully submits the following remarks in response to the Examining Attorney's Office Action dated March 1, 2019.

I. Outstanding Issues

The Examining Attorney raised the following issues with respect to Applicant's application:

1. Perceived likelihood of confusion with Reg. 3520556;
2. Request for disclaimer of FAMILY;
3. Requested amended identification of certain services in Classes 35 and 44;
4. Request for substitute specimen in Class 44.

Applicant addresses all four outstanding issues below and in the accompanying TEAS form.

II. Likelihood of Confusion

Applicant respectfully submits that there is no likelihood of confusion, because the visual dissimilarities are sufficient to obviate consumer confusion in light of the differing fields covered by Applicant's application and the cited registration.

Applicant's mark consists of two words, while the cited mark consists of one word. Applicant's mark incorporates the term CONNECTS, while the cited mark incorporates the term CONNECT. Moreover, this isn't a simple "pluralization" of an existing mark. Since Applicant's mark consists of two words, the addition of the s is meaningful with respect to connotation and commercial impression. Finally, Applicant's mark consists of a design element, which is not a component of the cited mark.

Both Applicant and the registrant are providing information, but the information they are providing is totally unrelated. The registrant's registration covers information about eye conditions, while applicant is providing services and information about supporting newborns. Applicant has further narrowed and specified its services (as shown in Section IV below). Applicant's narrowed service description does not overlap with registrant's services in any way.

When viewed as a whole, consumers would not have any reason to think that FAMILYCONNECT in connection with information about eye conditions is related to, or originates from the same source as, FAMILY CONNECTS & Design in connection with information and consulting services regarding support for newborns.

III. Disclaimer

No claim is made to “FAMILY” apart from the mark as shown.

IV. Identification of Services

Applicant agrees to narrow its service descriptions as follows:

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

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

V. Amended Specimen

As requested by the Examining Attorney, Applicant has submitted a substitute specimen. Applicant declares that the substitute specimen was in use in commerce at least as early as the filing date of the application or prior to the filing of the amendment to allege use.

VI. Conclusion

Having responded to all outstanding issues, Applicant respectfully requests that the application be approved for publication. The Examining Attorney is invited to contact the undersigned with any questions.