

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
THE CORYN GROUP II, LLC	Examining Attorney:
Serial No.: 88/455,007	Megan Mischler
Filed: May 31, 2019	Law Office 127
Mark: BLUEPRINT	

**APPLICANT’S RESPONSE TO OFFICE ACTION IN SUPPORT OF REGISTRATION
FOR THE MARK BLUEPRINT**

Ms. Mischler:

I. INTRODUCTION

On May 31, 2019, Applicant The Coryn Group II, LLC (“Applicant”) filed U.S. Application Serial No. 88/455,007 (the “Application”) pursuant to Trademark Act Section 1(a) to register the mark BLUEPRINT (the “Mark”). On June 18, 2019 the USPTO issued an office action stating that registration is refused due to likelihood of confusion with the mark, BLUEPRINT+CO. (the “Cited Mark”) in U.S. Registration No. 5,246,010 (the “Cited Registration”), pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d). As detailed below, Applicant recently executed a consent agreement (the “Consent Agreement”) with Blueprint Co., LLC (the “Registrant”) for the Cited Mark, agreeing that there is no likelihood of confusion between their respective use of the BLUEPRINT (“Applicant’s Mark”) and BLUEPRINT+CO. marks. The Consent Agreement should be given great weight and lead to a conclusion that there is no likelihood of confusion between Applicant’s Mark and the Cited Registration. Applicant therefore respectfully submits that the Examining Attorney’s refusal should be withdrawn and the Application should proceed to publication.

II. SECTION 2(D) REFUSAL – LIKELIHOOD OF CONFUSION

a. Background

i. Applicant’s Execution of a Consent Agreement Regarding the Cited Registration

Applicant filed its application to register the mark BLUEPRINT on May 31, 2019, and the Application was refused because the Examining Attorney contends that there is a likelihood of confusion between Applicant’s Mark and the mark BLUEPRINT+CO., under Section 2(d) of the Trademark Act. On October 15, 2019, Applicant received confirmation from Blueprint Co., LLC, the owner of U.S. Registration No. 5,246,010 for BLUEPRINT+CO. that the owners of the company consent to registration of Applicant’s Mark, BLUEPRINT, in Application Serial Nos. 87/774,789 and 88/455,007, for various services in Class 43. As a result, Applicant entered into a Consent Agreement with the Registrant, a copy of which is attached as Exhibit A. The Agreement confirms the realities of the marketplace, namely, that the Parties, “can use their respective marks such that confusion, mistake, or deception is not likely to result from their concurrent use throughout the United States.” As detailed in the Consent Agreement, Registrant expressly consents to the “use, application, and registration by Coryn Group of BLUEPRINT in connection with hotels, resort hotels, and hotel and travel related services, including the registration by Coryn Group of U.S. Application Serial Nos. 87/774,789 and 88/455,007.” The parties also agree that should any confusion arise in the future, they will “promptly notify the other party and the parties will confer in an effort to resolve the issue of confusion.” Accordingly, Applicant respectfully submits that there is no likelihood of confusion, and requests that Applicant’s Mark be approved for publication.

b. Analysis

i. Consent Agreements Are Entitled to Great Weight and Authority

The recently executed Consent Agreement directly impacts the refusal issued by the Examining Attorney, and provides a basis for withdrawal of the refusal to register Applicant's Mark. "The Court of Appeals for the Federal Circuit has made it clear that consent agreements should be give great weight, and that the Office should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion." *See* TMEP § 1207.01(d)(viii); *see also Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1987); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

"Thus, when those most familiar with use in the marketplace and most interested in precluding confusion enter into agreement 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." *Amalgamated Bank of New York*, 842 F.2d 1270, 1273, 6 USPQ2d 1305, 1307 (Fed. Cir. 1988) (citing *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1362-63, 177 USPQ 563, 568 (CCPA 1972)); *see also In re Four Seasons Hotel Ltd.*, 987 F.2d 1565, 1569, 26 USPQ2d 1071 (Fed. Cir. 1993) (reversing the prior TTAB decision refusing registration between applicant's mark FOUR SEASONS BILTMORE and the registered mark THE BILTMORE LOS ANGELES because applicant and registrant executed a consent agreement). An Examining Attorney should not substitute his or her "judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason", and "great weight" should be given to the executed Consent Agreement. *See* TMEP

§1207.01(d)(viii). Given that the parties agree that there is no likelihood of confusion between BLUEPRINT and BLUEPRINT+CO. for different services, there is no basis to conclude that a likelihood of confusion exists.

**ii. Registrant's Execution of the Consent Agreement Warrants
Withdrawal of the Refusal to Register**

As previously mentioned, Registrant and Applicant entered into a Consent Agreement under which both parties agree that confusion is not likely to arise from use and registration of their respective marks, in connection with their respective services. See Exhibit A. The Consent Agreement was executed on behalf of Applicant by Applicant's President & Secretary, and on behalf of Registrant by Registrant's CEO. *Id.* Both individuals are knowledgeable about the marketplace, the particular industries in which each mark targets, and the services associated with each mark. The parties agree that they "can use their respective marks such that confusion, mistake, or deception is not likely to result from their concurrent use throughout the United States." *Id.* This conclusion is due to the "differences in their respective marks, the differences in their respective services identified by the respective marks, the differences in the channels of trade in which those services travel, as well as other differences". *Id.* The parties also agreed that if any confusion arises in the future, the parties will notify each other and take reasonable action to address any such confusion. *Id.* Finally, Registrant expressly consents to the "use, application, and registration by [Applicant] of U.S. application Serial Nos. 87/774,789 and 88/455,007."

As mentioned above, the Consent Agreement must be accorded great weight. The Consent Agreement reflects a careful decision between the parties, who are each knowledgeable about the separate industries in which the services associated with each mark are offered, and is a "credible" assessment by the parties. *See* TMEP §1207.01(d)(viii). In addition, because the other

factors do not dictate a finding of likelihood of confusion, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register.

iii. There is No Likelihood of Confusion Between Applicant's Mark and the Cited Registration

In further support of the argument to withdraw the refusal to register, Applicant provides arguments against the Examining Attorney's refusal to register Applicant's Mark for likelihood of confusion. Upon review of the relevant factors, there is no likelihood of confusion between Applicant's Mark and the Cited Registration.

First, as detailed above, the parties have executed a Consent Agreement, which includes the reasons confusion is not likely; a statement proclaiming that confusion is not likely; and the steps the parties will take in the unlikely event that the parties learn of any instances of confusion. *See Exhibit A*. Consent agreements where “competitors have clearly thought out their commercial interests should be given great weight, and the USPTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason”. *See In re American Cruise Lines, Inc.*, 128 USPQ2d 1157 (TTAB 2018) [precedential] (where the TTAB gave “great weight” to two consent agreements, and the Board reversed a Section 2(d) refusal to register AMERICAN CONSTELLATION, finding that the mark is not likely to cause confusion with the registered mark CONSTELLATION, with both marks for cruise ship services); *see In re Four Seasons Hotels Ltd.*, 26 USPQ2d at 1073 (quoting *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985)); *see also du Pont*, 177 USPQ at 568.

Here, the Consent Agreement clearly acknowledges that Registrant, who is of course knowledgeable about its offerings under BLUEPRINT+CO. and its target consumers, consents to Applicant's use of BLUEPRINT, for Applicant's distinct services, finding no likelihood of

confusion. Accordingly, there is therefore no reason for the Examining Attorney to substitute her judgment for the judgment of the parties.

Second, Applicant's services are dissimilar from, and do not overlap with the services associated with the Cited Registration. The Cited Registration is used in connection with business related services, namely, a membership-only open executive workspace and entrepreneurial network located in New York. Registrant's potential customers must apply to become members through Registrant's website, <https://blueprintandco.com>, where, if selected, consumers commit to at least a 3-month membership which begins at hundreds of dollars per month. In contrast, Applicant's services are limited to the travel and hospitality industry, and do not extend into business related services, such as the leasing of offices and workspaces, business development, and business networking. Rather, Applicant's services are limited to hotel reservation services and providing personalized information about hotels and temporary accommodations for travel. Consumers viewing Registrant's offerings are in need of workspaces, and are looking to be surrounded by, and network with, a community of professionals. Consumers viewing Applicant's offerings are in need of the exact opposite – a vacation, away from the office.

Third, the respective trade channels and target consumers are distinct, further leading to a finding of no likelihood of confusion. As stated in the Consent Agreement, the parties believe that the differences in the channels of trade will prevent any consumer confusion. Consumers are not likely to assume that the services originate from a single source.

Fourth, the marks differ in sight, sound, connotation and commercial impression. While both marks include the word BLUEPRINT, common use of dominant or even identical words does not automatically indicate that the marks are similar. *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d

622,627 (8th Cir. 1987). Even the slightest variation can distinguish marks and avert a likelihood of confusion. *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 928 (C.C.P.A. 1978).

Based upon the foregoing, it is clear that there is no likelihood of confusion between Applicant's Mark and the Cited Registration, and the refusal to register should be withdrawn.

III. SECTION 2(D) ADVISORY – PRIOR-FILED APPLICATION

The Examining Attorney's June 18, 2019 office action also included an advisory statement, which states that the "filing date of pending U.S. Application Serial Nos. 87774789 and 87774796 precede applicant's filing date", and if said marks register, "applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the marks." To provide clarification, Application Serial No. 87/774,796 was abandoned on June 4, 2019, and Application Serial No. 87/774,789, which is scheduled for publication in the *Official Gazette* on December 24, 2019, is owned by the Applicant, The Coryn Group II, LLC.

IV. CONCLUSION

Because Registrant and Applicant have entered into a Consent Agreement under which both parties agree that confusion is not likely to arise from their use and registration of their respective marks, used in connection with their respective services, Applicant respectfully submits that there is no likelihood of confusion between Applicant's Mark and the Cited Registration. The Consent Agreement is entitled to great weight and there is no reason for an Examining Attorney to substitute his or her judgment for those of the real parties in interest. Moreover, a consideration of relevant factors dictates a finding of no likelihood of confusion. Applicant

therefore requests that the refusal to register be withdrawn and the Application be approved for publication in the *Official Gazette*.

Respectfully submitted,

Dated: December 18, 2019

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