


Mark:



Serial No.: 88229942

I. REQUEST FOR SUSPENSION

The August 16, 2019 Office Action (“Office Action”) provided notice that the mark SOOTHE in a prior-filed pending application, Application Serial No. 88226702 (the “‘702 Application”), may present a bar to registration of the Applicant’s design mark  in Application Serial No. 88229942 (the “‘942 Application”) under Trademark Act § 2(d), 15 U.S.C. § 1052(d), based on a potential likelihood of confusion.

Applicant requests suspension of action in this application pursuant to 37 C.F.R. §2.67. An examining attorney has the discretion to suspend an application “for good and sufficient cause” under 37 C.F.R. §2.67. TMEP §716.02. Applicant respectfully submits that good and sufficient cause for suspension exists for the following reasons:

- Suspension of the application will avoid the potential for issuance of piecemeal refusals based on the pending ‘702 Application (See TMEP 716.02(c)) (an examining attorney will normally not issue a refusal of registration until all conflicting application(s) are registered or abandoned, in order to avoid issuing piecemeal refusals); and,
- Suspension of the application will facilitate procedural fairness in that it will allow Applicant to present a full and unified response to the Office Action and any refusal under Trademark Act § 2(d), including without limitation arguments related to (1) the strength of the cited mark, (2) the co-existence of other relevant registrations notwithstanding potential similarity in mark elements, and (3) Internet evidence probative of public perception that currently exists or will exist in the future at the time the pending application registers. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009) (evidence obtained from the Internet may be used to support a determination under Section 2(d) that goods are related); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007) (same).

Applicant believes this request for suspension for good cause constitutes a proper response to the Office Action and that the rules of procedure permit Applicant to request such a suspension under these circumstances in order to efficiently present a fair and full response to the Office Action. *See* TMEP § 716 (“[A]n applicant’s timely filed request for suspension for good cause may constitute a proper response to an Office action.” “When an acceptable ground for suspension is immediately apparent (e.g., prior-filed applications for conflicting marks are pending), the examining attorney will suspend an application only when the application is in condition for approval or final action, except for the matter on which suspension is based. Otherwise, the applicant must request suspension.”). For all these reasons, Applicant respectfully submits that good and sufficient cause for suspension exists to suspend further action until resolution of the pending ‘702 Application. As provided in the Office Action, Applicant notes its election not to submit arguments at this time in no way limits Applicant’s right to address this issue later if a refusal under Section 2(d) issues.