

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Discord, Inc.
Serial No. 88/531358
Filed: July 23, 2019
Mark: **DISCORD**
Examining Attorney: David Collier
Law Office: 109

RESPONSE TO OFFICE ACTION

Applicant Discord, Inc. (“Applicant”) responds as follows to the Office Action issued on August 21, 2019:

Claim of Ownership

Applicant is the owner of U.S. Registration No. 4930980 for the mark DISCORD (“Applicant’s Mark”) for *computer software and computer software application for social networking, sending messages, text, photos, graphics, audio and video files to other users; computer software for engaging in text, audio and video chats with other users; computer software programs for the integration of text, photo, graphics, audio and video files into interactive delivery multimedia applications in Class 9, and communication services, namely, transmission of data, graphics, photos, text messages, electronic mail, video and audio files by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; message sending and receiving services; text, audio and video messaging services; providing online chat rooms, online forums, and electronic bulletin boards for transmission of messages among computer and electronic game users in Class 38.*

Response to Section 2(D) Refusal


The Examining Attorney cited, as a bar to registration, the following two prior registrations (the “Cited Marks”):

No. 5008676 for DAYS OF DISCORD (the “DAYS Mark”) owned by Graham Hopper filed in connection with:

Computer game software; Downloadable computer game software; Interactive entertainment software, namely, computer game software, computer game programs, computer game cartridges, computer game discs; Downloadable software for use in connection with computer games, communication devices and mobile telephones Computer game software for use with communication devices and mobile telephones, video game programs, video game software, video game cartridges; Computer game software downloadable from a global computer network; Downloadable electronic games via the Internet and wireless devices in Class 9; and

Entertainment services, namely, providing on-line computer games; Entertainment services, namely, providing online computer games and interactive multiplayer online computer games via a global network; Entertainment services, namely, conducting entertainment exhibitions in the nature of card games, conducting card game competitions; Organizing and conducting online game tournaments and exhibitions in the field of fantasy role-playing games; Conducting card game competitions online for entertainment purposes; Conducting contests online and providing a website for organizing, planning and executing exhibitions and special events between computer game players and interest groups for entertainment purposes; Conducting entertainment exhibitions online in the nature of card games for entertainment purposes in Class 41.



No. 5532472 for  (the “LEGACY Mark”) owned by Shanghai Youzu Information Technology Co., Ltd. Limited company filed in connection with:

Downloadable image files containing artwork, text, audio, video, games and Internet Web links relating to computer gaming; tablet computers; downloadable electronic publications in the nature of ebooks, newsletters, pamphlets, and articles in the field of computer games; television apparatus for projection purposes; computer game programs; computer game software for use on mobile and cellular phones; portable media players; recorded computer gaming software for recreational game playing purposes; Internet communication equipment, namely, network routers and LAN (local area network) access points for connecting network computer users; video disks and video tapes with recorded animated cartoons in Class 9;

Organization of education or entertainment competitions in the field of computer games; providing online non-downloadable electronic publications in the nature of ebooks, newsletters, pamphlets, and articles in the field of computer games; providing on-line videos featuring computer games, not downloadable; film production; providing sports facilities; educational services, namely, providing classes, seminars, workshops in the field of computer games; game equipment rental; game services provided on-line from a computer network, namely, providing online computer games; television entertainment, namely, ongoing television programs in the field of variety; entertainment services, namely, non-downloadable ringtones, pre-recorded music, and graphics presented to mobile communications devices via a global computer network and wireless networks in Class 41.

The Examiner’s refusal only pertains to the goods in Class 9. Applicant’s word mark DISCORD was filed, in relevant part, for *Downloadable computer game software* in Class 9.

Applicant respectfully submits that there is no likelihood of confusion between its mark and the Cited Marks. Accordingly, Applicant requests that the Examining Attorney reconsider his position and withdraw the citation for the reasons discussed below.

No Likelihood of Confusion Exists between Applicant's Mark and the Cited Marks

The Examining Attorney determined that there is a likelihood of confusion between the marks based on a two-step analysis, which is an abbreviated analysis derived from the *thirteen* factor DuPont test. In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The goal in determining a likelihood of confusion is to protect consumers from mistakenly or deceptively believing that an applicant's goods or services emanate from the cited registrant, or are related to the registrant's business. As applied in this case by the Examining Attorney, the two-step analysis is insufficient to determine whether there is a likelihood of confusion between Applicant's Mark and the Cited Marks. Although the Examining Attorney is not required to consider all thirteen DuPont factors, the majority of the factors, including the following, provide evidence that no likelihood of confusion exists:

- The similarities and dissimilarities of the marks with respect to sight, sound, connotation, and overall commercial impression;
- The channels of distribution of the goods;
- The conditions under which purchases of the goods are made; and
- The nature and extent of any actual confusion.

I. Comparison of the Marks

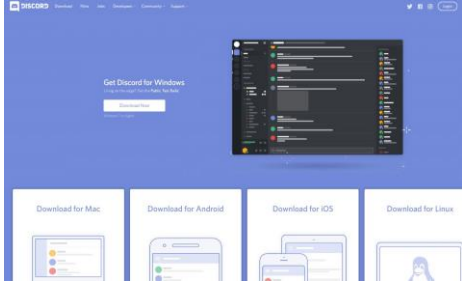

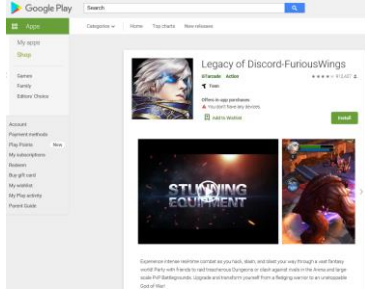
The fact that the parties' marks share the word "Discord" alone is insufficient to find a likelihood of confusion. Instead, when viewed in their entirety, the parties' marks are visually different and convey different commercial impressions. *In re Stribl*, 62 USPQ2d 1446, 1448 (T.T.A.B. 2002) (no likelihood of confusion between the marks UIS and UIS UNIVERSAL INFORMATION SYSTEMS, INC., both for computer services, because the marks create different commercial impressions).

The proper focus in evaluating the similarity of marks is not on "certain prominent features that both parties' marks have in common, to the exclusion of others which cause the parties' marks as a whole to create in the minds of consumers quite different impressions." *Washington Foods, Inc. vs Kellogg Co.*, 732 F. Supp. 1417, 1439 (S.D. Ohio 1990) (citing *Little Caesars, Inc. v. Pizza Caesar, Inc.* 834 F. 2d 568, 571 (6th Cir. 1987). Rather, "[i]t is the impression which the mark as a whole creates on the average reasonably prudent buyer and not the parts thereof which is important." *Id.*

Applicant's Mark is visually and aurally distinct from the coexisting "LEGACY OF DISCORD" and "DAYS OF DISCORD" marks and presents a distinct commercial impression. The Cited Marks both include distinct additional terms preceding and modifying the term "DISCORD." These combination marks create different commercial impressions from the term "DISCORD" alone. "LEGACY OF DISCORD" connotes the idea of a "legacy" or history of discord or disharmony, and "DAYS OF DISCORD" connotes the idea of a time period where discord reigns. This contrasts with the commercial impression presented by the word "DISCORD" by itself, which is a noun that connotes a general lack of harmony or differences of opinion.

II. Differences in the Channels of Trade And Conditions Under Which Purchases Are Made

In order for consumers to obtain Applicant’s or Registrants’ products, consumers must download the software and possibly pay a monthly or annual fee subscription. Below is a comparison chart showing each product and corresponding link on how to download the software to access the online games.

| Applicant’s Mark | DAYS Mark | LEGACY Mark |
|---|--|--|
|  |  |  |
| <p>https://discordapp.com/</p> | <p>https://downloads.tomsguide.com/Days-of-Discord,0301-63210.html</p> | <p>https://play.google.com/store/apps/details?id=com.gtarcade.lod&hl=en_US</p> |

Although the marks contain a single similar element, when viewed side by side, the overall distinctions are sufficient such that the marks may function to distinguish different sources of origin and confusion is not likely.

III. Peaceful Coexistence of Applicant’s Mark and the Cited Marks

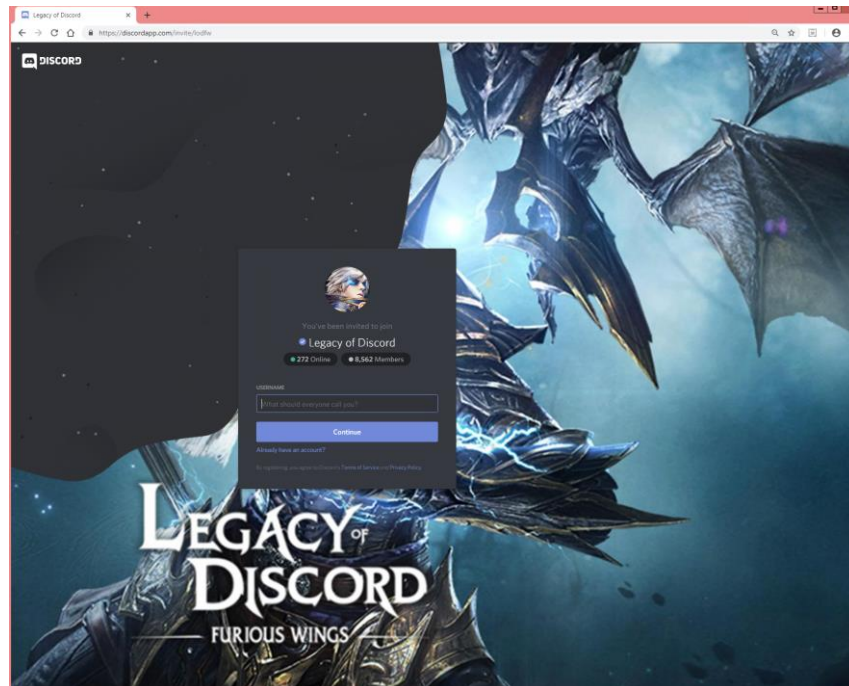
When determining whether the coexistence of an applicant’s prior registration with another party’s registration weighs against citing the latter registration in a §2(d) refusal of that applicant’s applied-for mark, the Examining Attorney should consider: (1) whether the applicant’s prior registered mark is the same as the applied-for mark or is otherwise not meaningfully different; (2) whether the identifications of goods/services in the application and the applicant’s prior registration are identical or identical in relevant part; and (3) the length of time the applicant’s prior registration has co-existed with the registration being considered as the basis for the §2(d) refusal. *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1400 (TTAB 2012); TMEP §1207.01.

Applicant is the owner of prior registration No. 4930980 for the mark DISCORD Classes 9 and 38, with a date of first use as early as March 2, 2015 (5 years of use). By virtue of the zone of natural expansion, Applicant entered into a new product line, and filed its application on July 23, 2019 for downloadable computer game software in Class 9.

The DAYS Mark was filed on October 15, 2014, and claims a date of first use as early as March 1, 2016.

Through Applicant's significant use of the mark DISCORD, Applicant and the registrant of the DAYS Mark have peacefully coexisted for the past four (4) years.

With respect to the LEGACY Mark, Applicant's website offers an invite to consumers to take part in the LEGACY OF DISCORD game as per the appended screenshot of Applicant's website.



This clearly shows that both Applicant's Mark and the LEGACY Mark are peacefully coexisting in the marketplace with no confusion.

Applicant's prior registered mark is identical to the applied for mark and covers closely related and overlapping goods. Its peaceful coexistence with the Cited Marks confirms that consumers are unlikely to think that Applicant is associated with the Cited Marks or be confused as to the source of the parties' goods and services.

Further, Applicant is not aware of any instances of actual consumer confusion with the Cited Marks.

Finally, the following marks containing the word DISCORD filed for goods in Class 9 have been co-existing on the Federal Register for many years:

| Trademark | App. No. / Reg. No. | (Class) Description of Goods and Services | Status | Owner |
|--------------------|------------------------|---|------------|---------------|
| DISCORD | 86635386 / 4930980 | (9) Computer software and computer software application for social networking, sending messages, text, photos, graphics, audio and video files to other users; computer software for engaging in text, audio and video chats with other users; computer software programs for the integration of text, photo, graphics, audio and video files into interactive delivery multimedia applications (38) Communication services, namely, transmission of data, graphics, photos, text messages, electronic mail, video and audio files by telecommunications networks, wireless communication networks, the internet, information services networks and data networks; message sending and receiving services; text, audio and video messaging services; providing online chat rooms, online forums, and electronic bulletin boards for transmission of messages among computer and electronic game users | Registered | Discord Inc. |
| DAYS OF DISCORD | 86424216 / 5008676 | (9) Computer game software; downloadable computer game software; interactive entertainment software, namely, computer game software, computer game programs, computer game cartridges, computer game discs; downloadable software for use in connection with computer games, communication devices and mobile telephones computer game software for use with communication devices and mobile telephones, video game programs, video game software, video game cartridges; computer game software downloadable from a global computer network; downloadable electronic games via the internet and wireless devices (41) Entertainment services, namely, providing on-line computer games; entertainment services, namely, providing online computer games and interactive multiplayer online computer games via a global network; entertainment services, namely, conducting entertainment exhibitions in the nature of card games, conducting card game competitions; organizing and conducting online game tournaments and exhibitions in the field of fantasy role-playing games; conducting card game competitions online for entertainment purposes; conducting contests online and providing a website for organizing, planning and executing exhibitions and special events between computer game players and interest groups for entertainment purposes; | Registered | Graham Hopper |

| Trademark | App. No. / Reg. No. | (Class) Description of Goods and Services | Status | Owner |
|--|---------------------|--|--------------------------|---|
| | | conducting entertainment exhibitions online in the nature of card games for entertainment purposes | | |
| LEGACY OF DISCORD  | 79223534 / 5532472 | (9) Downloadable image files containing artwork, text, audio, video, games and internet web links relating to computer gaming; tablet computers; downloadable electronic publications in the nature of ebooks, newsletters, pamphlets, and articles in the field of computer games; television apparatus for projection purposes; computer game programs; computer game software for use on mobile and cellular phones; portable media players; recorded computer gaming software for recreational game playing purposes; internet communication equipment, namely, network routers and LAN (local area network) access points for connecting network computer users; video disks and video tapes with recorded animated cartoons (41) Organization of education or entertainment competitions in the field of computer games; providing online non-downloadable electronic publications in the nature of ebooks, newsletters, pamphlets, and articles in the field of computer games; providing on-line videos featuring computer games, not downloadable; film production; providing sports facilities; educational services, namely, providing classes, seminars, workshops in the field of computer games; game equipment rental; game services provided on-line from a computer network, namely, providing online computer games; television entertainment, namely, ongoing television programs in the field of variety; entertainment services, namely, non-downloadable ringtones, pre-recorded music, and graphics presented to mobile communications devices via a global computer network and wireless networks | Registered Section 66(a) | Shanghai Youzu Information Technology Co., Ltd. |
| DISCORD | 86379649 / 4726974 | (9) Military combat training simulation software that records simulation network traffic to provide debrief and after-action review of mission rehearsal and training in the areas of air, land and sea warfare | Registered | Battlespace Simulations, Inc. |
| RELEVANT DISCORD | 77918478 / 3849790 | (9) Digital media, namely, CDs, DVDs, and downloadable audio files featuring music (41) Entertainment, namely, live performances by a musical band | Registered | Nicholas Depew |

As the marks have peacefully coexisted in commerce for several years, Applicant respectfully requests that the Examiner allow the continued coexistence of the marks.

Response to Specimen Issue – Classes 9 and 45

The Examiner rejected the originally submitted specimen of use indicating that the specimen is not acceptable because it does not show the applied-for mark used in connection with the goods and services specified in the application.

Applicant respectfully submits the attached substitute specimens consists of Applicant's webpage displaying the DISCORD mark for the goods and services listed in the application.

Applicant further declares that the substitute specimens were in use in commerce at least as early as the filing date of the application for each classification.

Respectfully submitted,

LATHAM & WATKINS LLP



By: _____

Jennifer L. Barry
650 Town Center Drive, Suite 2000
Costa Mesa, CA 92626
(714) 540-1235
ipdocket@lw.com

Dated: February 21, 2020