IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Microsoft Corporation
APPLICATION SERIAL NO.:	97/669,269
MARK:	WASTELAND
OFFICE ACTION MAILING DATE:	August 31, 2023
EXAMINING ATTORNEY:	Brittany Schrader Law Office 306

RESPONSE TO OFFICE ACTION

I. Introduction

In the August 31, 2023 Office Action, the Trademark Office refused registration of Applicant's WASTELAND mark for (as amended herein) *printed posters; printed books in the field of computer and video games; printed instructional and teaching materials in the field of computer and video games; art prints; stickers, sticker albums, sticker books* in Class 16; and *playing cards* in Class 28 on grounds of an alleged likelihood of confusion with U.S. Registration No. 5421762 for NEON WASTELAND in connection with *video game software* in Class 9; and *comic books* in Class 16.

Specifically, the Trademark Office alleges that (1) the marks look and sound similar and share a similar overall commercial impression due to the overlap of the term "WASTELAND," and (2) the goods at issue are allegedly of a type that commonly emanate from the same source under the same mark.

In response, Applicant respectfully informs the Trademark Office that it has entered into a consent agreement with the owner of the cited registration, pursuant to which the parties agree that there is no likelihood of confusion between their respective marks. Since substantial deference is given to parties that have entered into such agreements, Applicant respectfully requests the refusal to be withdrawn.

II. Argument

A. Applicant and Registrant Have Entered into a Consent Agreement.

Under TMEP § 1207.01(d)(viii) an applicant may submit a consent agreement to overcome a refusal of registration under Trademark Act § 2(d). Moreover, the Court of Appeals for the Federal Circuit has consistently held that consent agreements should be given substantial weight in determining likelihood of confusion, and reiterated that 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 Four Seasons Hotels Ltd.*, 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993) ("We again remind the TTAB that 'reliance on its own views…rather than the views of the parties in question, contravenes the scope and intent of this court's precedent in *DuPont* and *Bongrain.*'"). Indeed, such agreements evidence that the parties have "clearly thought out their commercial interests with care," because it is "highly unlikely" that parties would deliberately create a situation that leads to source confusion for their respective products. *In re N.A.D., Inc.*, 224 U.S.P.Q. 969, 970 (Fed. Cir. 1985).

Here, the consent agreement reached between Applicant and Registrant sets forth the parties' shared view that there will be no likelihood of confusion between the parties' respective marks, confirms that neither party has observed or experienced any instances of actual confusion, and contains a commitment that the parties will undertake certain actions to avoid the possibility of consumer confusion, as well as cooperate with one another to eliminate such confusion in the unlikely event that confusion does occur. A copy of the consent agreement is attached hereto as **Exhibit A**. This is more than a "mere consent," but instead, contains terms that evidence a valid indication that consumer

confusion is unlikely to occur. *In re DuPont de Nemours & Co.,* 166 USPQ 351, 352 (TTAB 1970) (finding that when such agreements "constitute far more than mere 'consent,'" they ought to play a more "dominant role" in the likelihood of confusion analysis.)

Thus, because the parties themselves agree that there is no likelihood of confusion between their respective marks, and the substantial weight and deference that should be given to such agreements, Applicant respectfully requests the likelihood of confusion refusal to be withdrawn.

III. Conclusion

In view of the arguments set forth above, Applicant respectfully submits that this Response fully addresses all issues raised in the Office Action, and respectfully requests that the Examining Attorney approve this application for publication.