

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

SERIAL NO: 88/068,152 :  
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MARK: CREATEHER :  
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APPLICANT: The College of Wooster : RESPONSE TO SUSPENSION NOTICE  
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FILING DATE: August 7, 2018 : Examining Attorney – Karen K. Bush  
: Law Office - 108  
CLASSES: 009, 016, 041 :  
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**RESPONSE TO SUSPENSION NOTICE**

Applicant The College of Wooster (“Applicant”), by and through its undersigned counsel, hereby responds to the above-captioned Suspension Notice.

**I. STATEMENT OF FACTS**

On August 7, 2018, Applicant filed an application pursuant to 15 U.S.C. § 1051 to register its CREATEHER mark (“Applied-For Mark”) in International Classes 009, 016, and 041, for use with the following goods and services, respectively:

- International Class 009: Downloadable written articles in the fields of professional development, career development, personal development, and leadership development for women;
- International Class 016: Printed materials, namely, written articles, newsletters, pamphlets, brochures, and written course materials in the fields of professional development, career development, personal development, and leadership development for women;
- International Class 041: Educational services, namely, mentoring programs and services in the fields of professional development, career development, personal development, and leadership development for women; educational services, namely, programs, seminars, conferences, workshops, symposia, classes, and courses of instruction in the fields of professional development, career development, personal development, and leadership development for women, and course materials offered therewith; providing a website featuring blogs and online non-downloadable written materials, namely, articles, newsletters, pamphlets, brochures, written course materials, all in the fields of

professional development, career development, personal development, and leadership development for women.

On November 27, 2018, Examining Attorney Bush (the “Examining Attorney”) issued an office action which, in part, notified Applicant of a potential refusal of Applicant’s Applied-For Mark on the grounds that, if the mark in Prior Pending Application Serial No. 87/828,755 (identifying a prior pending CREATE(HER) Mark for use with various services in Class 41) were to register, it would block Applicant’s registration of its Applied-For Mark on the basis of a likelihood of confusion under the Trademark Act, Section 2(d). 15 U.S.C. § 1052(d), Trademark Manual of Examining Procedure (“TMEP”) §§1207.01 et. seq. On May 28, 2019, Applicant responded to goods and services amendment issues raised in the office action, but did not respond to the potential likelihood of confusion issue.

Rather, on January 16, 2019, Applicant filed a Notice of Opposition against Prior Pending Application Serial No. 87/828,755. Thereafter, on June 7, 2019, the Examining Attorney issued the above-referenced Notice of Suspension, pending the outcome of the foregoing Opposition Proceeding. On July 17, 2020, Applicant and Prior Pending Applicant settled their dispute through entry into a Consent Agreement, setting forth in basic terms how the parties’ Marks, goods and services, and channels of trade differed, and Applicant withdrew the Opposition Proceeding on that same date. Applicant submits the parties’ Consent Agreement herewith as Exhibit A, and hereby further explains why there is no likelihood of confusion between Applicant’s Applied-For Mark and Prior Pending Mark.

In light of the Consent Agreement, in which Applicant and the Prior Pending Applicant both agree that there will be no likelihood of confusion between their respective Marks due to the differences between them, the goods and services offered thereunder, and their respective

channels of trade, Applicant respectfully requests the Examining Attorney to lift the suspension and allow the Applied-For Mark to proceed to registration without further refusal.

**II. LAW & ARGUMENT - *The Consent Agreement Between The Parties Demonstrates That There Is No Likelihood Of Confusion Between Applicant's Applied-For Mark And Prior Pending Mark.***

The Trademark Trial and Appeal Board (“TTAB”) and the courts generally do not second-guess trademark consent agreements that allow two knowledgeable businesses to make concurrent use of the same or similar marks, because such knowledgeable parties are in the best position:

“...to structure such agreements in the way that the parties believe best accommodates their interests in light of trademark law .... At the time of the execution of such an agreement, the parties are in the best position to determine what protections are needed and how to resolve disputes concerning earlier trademark agreements between themselves. ... [I]t is usually unwise for courts to second-guess such decisions. In the absence of evidence to the contrary it is reasonable to presume that such arms-length agreements are pro-competitive.”

Clorox Co. v. Sterling Winthrop, Inc., 117 F.3d 50, 60 (2nd Cir. 1997). See also Fuddrucker, Inc. v. Fudpucker's, Inc., Case No. 3:04CV168/RS/EMT, 2006 U.S. Dist. LEXIS 33217 (N.D. Fla. May 25, 2006); Gander Mountain Co. v. Cabela's Inc., Civ No. 04-3125, 2005 U.S. Dist. LEXIS 17376 (D. Minn. Aug. 18, 2005) (both cases holding that “trademark agreements, in which two parties agree on their respective rights in a mark, ‘are favored under the law’”).

Further:

“It can be safely taken as fundamental that reputable businessmen-users of valuable trademarks have no interest in causing public confusion .... Thus when those most familiar with use in the marketplace and most interested in precluding confusion enter into agreements 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.”

In re E. I. DuPont De Nemours & Co., 476 F.2d 1357, 1362-1363 (C.C.P.A. 1973).

As such, a consent agreement should be presumed to prevent public confusion, since the very essence of such an agreement is an effort to avoid customer confusion by defining and delimiting the parties' respective trademark uses. See id. See also McCarthy on Trademarks and Unfair Competition, §§ 18:79 – 18:81 (2008).

Noting that a trademark consent agreement is “in essence, an admission that the subsequent party’s use of the mark for its goods is not likely to cause confusion,” the TTAB has held that a consent to use necessarily includes a consent to register, whether that consent to register is expressed or not. See Richdel, Inc. v. Mathews Co., 190 U.S.P.Q. 37 (T.T.A.B. 1976). Agreements giving consent to use and register are also accepted and given heavy weight by the USPTO if they are more than mere “naked” consents – that is, if they clearly delimit the respective product lines of the parties so that the probability of consumer confusion is clearly minimized or eliminated. See McCarthy, § 18:80 at 18-175.

Here, as shown in Exhibit A, Applicant and the Cited Registrant have agreed to concurrent use of their respective CREATEHER and CREATE(HER) Marks. See Exhibit A. In the Consent Agreement, Applicant and Prior Pending Applicant expressly state that they each agree that “due to differences between their respective Marks, their respective Services, and their respective Trade Channels, there will be no likelihood of confusion”. See Exhibit A, ¶ 5.

First, the parties specifically state and agree that their respective services are different in purpose and nature, and that each offers their respective services through their respective and distinct channels of trade. See Exhibit A, ¶¶ 1, 2. Second, the parties note that they have been using their respective Marks concurrently in commerce for more than one year (now almost two years) and during that time, no known instances of actual confusion have occurred. See id., ¶ 6. Third, the parties agree to market and sell their respective goods and services in such a way as to

avoid any likelihood of confusion, mistake, and/or deception. See id., ¶ 8. These limitations clearly minimize or eliminate the probability of consumer confusion. See McCarthy, § 18:80, at 18-175. To the extent that any confusion were to occur, the parties have further agreed to take action to minimize or eliminate it. See Exhibit A, ¶¶ 8, 9.

As Exhibit A demonstrates, both parties are intimately familiar with their own goods and services, the marketing and trade channels through which those goods and services travel, and other details associated with the uses of their respective Marks with their respective goods and services. As such, Applicant and Prior Pending Applicant – two parties who have no interest in creating consumer confusion and are in the best position to determine whether a likelihood of consumer confusion exists – believe there is no likelihood of confusion and that no party will be damaged by the concurrent use and registration of their respective marks.

For these reasons, Applicant respectfully requests that the Examining Attorney lift the suspension based upon a potential likelihood of confusion between these two parties' Marks, and allow Applicant's Application Serial No. 88/068,152 for registration without further refusal.

Respectfully submitted,

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