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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86431803
Applicant	Vicis, Inc.
Applied for Mark	VICIS
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Submission	Applicants Request for Remand and Amendment
Attachments	VICIS Revised Request for Remand 86431803.pdf(38048 bytes) Exhibit A - Bloomberg - pronunciation of VICIS.pdf(739250 bytes) Exhibit B - Inc. pronunciation of VICIS.pdf(297615 bytes) Exhibit C - VICI Enterprises - pronunciation of VICI.pdf(268794 bytes) Exhibit D - NY NOW - pronunciation of VICI.pdf(78454 bytes) Exhibit E - Vici Coffee -pronunciation of VICI.pdf(642535 bytes) Exhibit F - Vici instruments - pronunciation of VICI.pdf(214656 bytes) Exhibit G - Memoria Press - classic vs eccliastic latin pronunciation.pdf(316618 bytes) Exhibit H -A Short History of Latin Pronunciation _ Memoria Press.pdf(436856 bytes) Exhibit K - Latin Dictionary - Vincere.pdf(205177 bytes) Exhibit I - Veni Vidi Vici Definition - Merriam-Webster.pdf(110760 bytes) Exhibit J - Veni vidi vici - Wikipedia.pdf(249785 bytes) Exhibit L - Cited Mark - registration - meaning of VICI.pdf(194279 bytes) Exhibit M - VICI JOUR reg. - meaning of VICI.pdf(197793 bytes) Exhibit N - VICI Productions reg. - meaning of VICI.pdf(194759 bytes) Exhibit O - VIDI VICI registration - meaning of VICI.pdf(212633 bytes) Exhibit P - Headphones VENI VIDI VICI reg. - meaning of VICI.pdf(194926 bytes) Exhibit Q - Paintball co VICI reg. - meaning of VICI.pdf(197343 bytes) Exhibit R - PM Inc. VENI VIDI VICI reg. - meaning of VICI.pdf(197216 bytes) Exhibit S - Plural of Vincere.pdf(134866 bytes) Exhibit T - Singular vs plural verbs in English.pdf(229619 bytes) Exhibit U - Oxford Dictionaries US English - no meaning of VICIS.pdf(415873 bytes) Exhibit V - Vicis - Definition Merriam-Webster Dictionary.pdf(550481 bytes) Exhibit W - vicis definition from Macmillan Dictionary.pdf(369849 bytes) Exhibit X - Vicis search - American Heritage Dictionary.pdf(470299 bytes) Exhibit Y - Words starting with vici - word hippo.pdf(85393 bytes) Exhibit Z - VICI Website compilation.pdf(609233 bytes)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

APPLICANT: Vicis, Inc.

MARK: VICIS

SERIAL NO: 86/431,803

FILING DATE: October 22, 2014

EXAMINING ATTORNEY: Robin M. Mittler
Law Office 119

REVISED REQUEST FOR REMAND

Applicant Vicis, Inc. (“Applicant”) respectfully submits this Revised Request for Remand in response to the Board’s notice dated June 24, 2016, and asks that the Board suspend this appeal and remand trademark Application Serial No. 86/431,803 for the Examining Attorney to consider additional evidence submitted herewith, in accordance with TBMP §1207.02 and 37 C.F.R. § 2.142(d).

Applicant respectfully requests that the Examining Attorney withdraw its rejections in light of the additional evidence provided with this response to the Office Action issued on December 11, 2015.

I. PROSECUTION HISTORY

On October 22, 2014, Applicant filed the instant application of the mark VICIS for use in connection with the following goods:

- Class 018: “Sports bags; backpacks; daypacks; tote bags; duffel bags; messenger bags; beach bags; overnight bags; clutch bags; grip bags; shoulder bags; traveling bags; sling bags; carryalls; hiking bags; hunting bags; satchels; luggage; rucksacks” and
- Class 025: “Clothing; headwear; footwear”

On February 2, 2015, Examining Attorney Robin Mittler issued an office action under section 2(d) of the Lanham Act on the basis that, in her opinion, Applicant's VICIS mark was confusingly similar to Trademark Registration No. 4,563,922, for the mark VICI for use in connection with "Handbags, purses and wallets" and "Fashion hats; Men's and women's jackets, coats, trousers, vests; Scarves; Women's clothing, namely, shirts, dresses, skirts, blouses" (the "Cited Mark").

On August 6, 2015, Applicant responded to the Office Action, providing arguments and some evidence demonstrating that the marks are not confusingly similarly, as well as amending/narrowing its description of goods as follows:

- Class 018: "Sports Bags"
- Class 025: "Clothing for use in sports, namely, tops, shirts, t-shirts, sweatshirts, jerseys, jackets, vests, outerwear, bottoms, pants, shorts, socks, and undergarments; headwear for use in sports; footwear for use in sports"

On September 09, 2015, the Examining Attorney maintained her position that the marks are confusingly similar and made the refusal Final.

On March 9, 2016, Applicant timely filed a Request for Reconsideration and Appeal, along with additional arguments and evidence that the mark being cited against Applicant's mark is not confusingly similar.

On May 2, 2016, the Examining Attorney denied Applicant's Request for Reconsideration.

On June 17, 2016, Applicant filed a Request for Remand. The Board issued an Order on June 24, 2016 allowing Applicant to submit this Revised Request for Remand along with additional evidence supporting Applicant's position.

II. BASIS FOR REQUEST FOR REMAND, GOOD CAUSE

Pursuant to TMEP 1207.02 (37 CFR § 2.142(d)), an applicant may request a suspension of appeal and remand to the examining attorney for purposes of submitting additional evidence after an appeal has been filed. Such a request must (1) be made prior to the Board's final determination; (2) give an explanation as to the "good cause" for the request; and (3) be accompanied by the additional evidence sought to be introduced.

a. Prior to Board's Final Determination

As the Board has not yet made a final determination regarding this appeal and Applicant's application, this request is timely. Indeed, the time for Applicant to submit its appeal brief has not yet passed. As such, Applicant's request is timely.

b. Good Cause for the Request

Pursuant to TMEP 1207.02 (37 CFR § 2.142(d)), and applicant must demonstrate "good cause" in order for the request to be considered. The TMEP explicitly states that if "[a] new attorney for the applicant, or a new examining attorney, has taken over the case and wishes to supplement the evidence of record" then such action constitutes good cause. On June 3, 2016, Applicant revoked the appointment of the attorney that was previously prosecuting this application, and appointed undersigned counsel.

Considering that appointment of a new attorney to take over prosecution of an application is explicitly provided for in the TMEP as good cause, Applicant respectfully requests that good cause be acknowledged as a matter of law.

III. ADDITIONAL EVIDENCE SOUGHT TO BE INTRODUCED

Additional evidence regarding the sound, connotation and commercial impression of Applicant's Mark in comparison with the Cited Mark is included herewith as identified and described below. Specifically, Applicant maintains that the Examiner failed to appreciate the differences in sound, connotation and commercial impression between Applicant's Mark and the Cited Mark.

a) Exhibits A-H Relate to the Sound/Pronunciation of the Marks.

Applicant's VICIS mark is pronounced VYE-sis (with a long I sound in the first syllable and a soft C and short I sound in the second syllable). See Exhibits A-B. As VICIS is an arbitrary mark that does not have a meaning, the pronunciation likely to be adopted by consumers is difficult to predict. Applicant believes consumers will use the prescribed pronunciation Applicant uses in its own communications and press releases. Under the time constraints imposed on Applicant's new counsel to gather evidence, there was insufficient time to conduct a consumer survey. However, if the Examiner does not withdraw her objections to registration of the mark, Applicant plans to seek permission to conduct a consumer survey and submit evidence regarding how consumers pronounce the term VICIS.

The Cited Mark, on the other hand, is a commonly encountered word (as it appears in the widely known quote "veni, vidi, vici"). The word VICI will most likely be pronounced by average consumers as VEE-chee (with a long E sound in both syllables and a CH sound to begin the second syllable). See Exhibits C-F. The VEE-chee pronunciation is consistent with the instructions of the "VICI" brands cited in Exhibits C-F. Common modern day English pronunciation of Latin words further confirms that VICI would not be pronounced similarly to VICIS. See Exhibits G-H. Exhibit I is a printout from the Merriam-Webster online dictionary entry for VICI showing both the "classical" and the "ecclesiastic" pronunciations, neither of which are similar to how VICIS is pronounced.

Instead of submitting evidence regarding the sound of the marks, the Examiner merely claims that the marks "could clearly be pronounced the same." However, just because two words could be pronounced the same does not mean consumers are likely to do so. The Exhibits indicate that consumers are likely to pronounce the two words in markedly different ways.

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