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Subject: U.S. Trademark Application Serial No. 87645025 - PURE LAW - N/A - Request for
Reconsideration Denied - Return to TTAB - Message 1 of 3

Attachment Information:

Count: 12

Files: def1-1.jpg, def2-1.jpg, def2-2.jpg, web1-1.jpg, web1-2.jpg, web1-3.jpg, web1-4.jpg, web1-5.jpg,
web2-1.jpg, web2-2.jpg, web2-3.jpg, 87645025.doc

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 87645025

Mark: PURE LAW

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Reference/Docket No. N/A

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**REQUEST FOR RECONSIDERATION
AFTER FINAL ACTION
DENIED**

Issue date: **August 01, 2019**

This Office action is in response to applicant's communication filed on July 22, 2019.

Applicant's request for reconsideration is denied. *See* 37 C.F.R. §2.63(b)(3). The trademark examining attorney has carefully reviewed applicant's request and determined the request did not: (1) raise a new issue, (2) resolve all the outstanding issue(s), (3) provide any new or compelling evidence with regard to the outstanding issue(s), or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue(s). TMEP §§715.03(a)(ii)(B), 715.04(a).

Specifically, applicant's request for reconsideration consists of over three hundred third-party registrations without any explanation. It appears that applicant has submitted printed or electronic copies of third-party registrations for marks containing the wording "PURE" to support the argument that this wording is weak, diluted, or so widely used that it should not be afforded a broad scope of protection. These registrations appear to be for goods and/or services that are predominantly different from or unrelated to those identified in applicant's application.

The weakness or dilution of a particular mark is generally determined in the context of the number and nature of similar marks in use in the marketplace in connection with similar goods and/or services. *See Nat'l Cable Tel. Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1579-80, 19 USPQ2d 1424, 1430 (Fed. Cir. 1991); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of widespread third-party use of similar marks with similar goods and/or services "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection" in that particular industry or field. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); *see In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

However, evidence comprising only a small number of third-party registrations for similar marks with similar goods and/or services, as in the present case, is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). These few registrations are "not evidence of what happens in the market place or that customers are familiar with them." *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269; *In re I-Coat Co.*, 126 USPQ2d 1730, 1735 (TTAB 2018). Thus, the few similar third-party registrations submitted by applicant are insufficient to establish that the wording "PURE" is weak or diluted.

Further, evidence comprising third-party registrations for similar marks with different or unrelated goods and/or services, as in the present case, has "no bearing on the strength of the term in the context relevant to this case." *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751). Thus, these third-party registrations submitted by applicant are insufficient to establish that the wording "PURE" is weak or diluted.

In the present case, the applied-for mark “PURE LAW” is highly similar to the registered mark “PURE-IP” and both create the same commercial impression of the wording “PURE” combined with a legal reference for closely related legal services. Please see attached dictionary definitions of “IP” and web pages showing a variety of legal services provided by a single source under a common mark, including intellectual property litigation.

Accordingly, the following requirement(s) and/or refusal(s) made final in the Office action dated January 21, 2019, are ***maintained and continued***:

- Likelihood of confusion refusal as to U.S. Registration No. 2945955 for the mark “PURE-IP”

See TMEP §§715.03(a)(ii)(B), 715.04(a).

Please note that, upon further consideration, the following requirement(s) and/or refusal(s) made final in that Office action are ***withdrawn***:

- Likelihood of confusion refusal as to U.S. Registration No. 5393399 for the mark “IT’S PURE” and design
- The objection as to those third-party registrations previously referenced only in summary form that are attached to applicant’s request for reconsideration

See TMEP §§715.03(a)(ii)(B), 715.04(a).

If applicant has already filed an appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If applicant has not filed an appeal and time remains in the six-month response period, applicant has the remainder of that time to (1) [file another request for reconsideration](#) that complies with and/or overcomes any outstanding final requirement(s) and/or refusal(s), and/or (2) [file a notice of appeal](#) to the Board. TMEP §715.03(a)(ii)(B). Filing a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §715.03(c).

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