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Subject: U.S. Trademark Application Serial No. 87882281 - ASK JIM FIRST - 1075512 - Request for Reconsideration Denied - Return to TTAB

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

U.S. Application Serial No. 87882281

Mark: ASK JIM FIRST

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Reference/Docket No. 1075512

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REQUEST FOR RECONSIDERATION
AFTER FINAL ACTION
DENIED

Issue date: **April 20, 2020**

Applicant's request for reconsideration is denied. *See* 37 C.F.R. §2.63(b)(3). In applicant's January 27, 2020 request for reconsideration, applicant submitted an amended identification of services and attached additional evidence. The trademark examining attorney has carefully

reviewed applicant's request and determined the request did not: (1) raise a new issue, (2) resolve the outstanding issue, (3) provide any new or compelling evidence with regard to the outstanding issue, or (4) present analysis and arguments that were persuasive or shed new light on the outstanding issue. TMEP §§715.03(a)(ii)(B), 715.04(a). Accordingly, the Trademark Act Section 2(d) refusal made final in the Office action dated February 8, 2019, and for which a subsequent final Office action was issued on November 27, 2019, is **maintained and continued**. See TMEP §§715.03(a)(ii)(B), 715.04(a).

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3289118. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the previously attached registration.

Applicant's mark is ASK JIM FIRST (in standard character form) which, per applicant's January 27, 2020 request for reconsideration, is amended from "Lawyer referral services provided to consumers on personal injury matters" to "Lawyer referral services provided to consumers who seek to retain an attorney to represent them in personal injury matters excluding business advice, inquiries and information services" in International Class 35.

Registrant's mark is ASK JIM (in standard character form) for "Business advice, inquiries or information" in International Class 35.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the "du Pont factors"). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, "not all of the *DuPont* factors are relevant or of similar weight in every case." *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared services. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29

(C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

Comparison of Marks

Applicant’s January 27, 2020 request for reconsideration does not include any new arguments regarding the similarity of the marks.

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

Applicant’s mark is ASK JIM FIRST and registrant’s mark is ASK JIM. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Detroit Athletic Co.*, 903 F.3d at 1305, 128 USPQ2d at 1050 (citing *In re Dixie Rests.*, 105 F.3d at 1407, 41 USPQ2d at 1533-34). Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); see also *In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”). Thus, the first part of applicant’s mark “ASK JIM”, is dominant for purposes of determining the mark’s commercial impression and identical to registrant’s mark, ASK JIM.

Further, both marks are in standard characters and the only difference between the marks is that applicant's mark has the additional term "FIRST" added after the wording "ASK JIM", which is the entirety of registrant's mark. This is a minor difference because adding a term to a registered mark generally does not obviate the similarity between the compared marks, as in the present case, nor does it overcome a likelihood of confusion under Section 2(d). See *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 557, 188 USPQ 105, 106 (C.C.P.A. 1975) (finding BENGAL and BENGAL LANCER and design confusingly similar); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1269 (TTAB 2009) (finding TITAN and VANTAGE TITAN confusingly similar); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002, 2004 (TTAB 1988) (finding MACHO and MACHO COMBOS confusingly similar); TMEP §1207.01(b)(iii). In the present case, the marks are identical in part as to the wording "ASK JIM". Moreover, consumers are likely to perceive the applied-for mark as an extension of registrant's brand.

Therefore, applicant's mark and registrant's mark share the same commercial impression and are confusingly similar.

Comparison of Services

Applicant's January 27, 2020 request for reconsideration includes an amendment of the identification of services from "Lawyer referral services provided to consumers on personal injury matters" to "Lawyer referral services provided to consumers who seek to retain an attorney to represent them in personal injury matters excluding business advice, inquiries and information services." Applicant's attached evidence from the USPTO's ID Manual and third-party websites is not persuasive for the reasons stated below.

The services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi). Generally, the greater degree of similarity between the applied-for mark and the registered mark, the lesser the degree of similarity between the services of the parties is required to support a finding of likelihood of confusion. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009). As discussed above, the marks are highly similar with the only difference being that applicant has added the wording "FIRST" to the end of registrant's mark.

Applicant previously argued that applicant's services differ from and "does not remotely overlap" registrant's "business advice, inquiries or information" services and the January 27, 2020 request for reconsideration includes a proposed amendment to applicant's identification of services that expressly exclude registrant's services. However, even with the amendment to the identification of services, the

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