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Sent: 7/31/2020 12:49:21 PM

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Subject: U.S. Trademark Application Serial No. 88041695 - 094239Lion - Request for Reconsideration Denied - Return to TTAB

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Files: 88041695.doc

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

U.S. Application Serial No. 88041695

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Reference/Docket No. 094239Lion

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REQUEST FOR RECONSIDERATION
AFTER FINAL ACTION
DENIED

Issue date: **July 31, 2020**

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).

Accordingly, the following requirement(s) and/or refusal(s) made final in the Office action dated January 6, 2010 are **maintained and continued**:

- Trademark Act Section 2(d) Refusal – Likelihood of Confusion with U.S. Reg. Nos. 5568720 and 5604679

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

TRADEMARK ACT SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 5568720 and 5604679. Trademark Act Section 2(d), 15 U.S.C. §1052(d); see TMEP §§1207.01 *et seq.* See the previously attached registrations.

Applicant's mark is a design consisting of a lion in a standing position appearing next to a human person for "Legal services, namely, personal injury legal services" in International Class 45.

Registrant's marks are designs consisting of a lion in a standing position appearing next to a human person for "legal services" in International Class 45.

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 goods and/or 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 goods and/or 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.

The test for determining likelihood of confusion is the same for certification marks – the *du Pont* analysis. *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2049 (TTAB 2012) (quoting *Motion Picture Ass’n of Am., Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1559-60 (TTAB 2007)); see *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). However, because a certification mark owner does not use the mark itself, the likelihood of confusion analysis is based on a comparison of the mark as applied to the goods and/or services of the certification mark users, including the channels of trade and classes of purchasers. *In re Accelerate s.a.l.*, 101 USPQ2d at 2049 (quoting *Motion Picture Ass’n of Am., Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d at 1559-60); see also *Jos. S. Cohen & Sons Co. v. Hearst Magazines, Inc.*, 220 F.2d 763, 765, 105 USPQ 269, 271 (C.C.P.A. 1955).

A) Similarity of the Marks

i. U.S. Reg. No. 5568720

In a likelihood of confusion determination, the marks in their entireties are compared for similarities in appearance, sound, connotation, and commercial impression. *In re i.am.symbolic, llc*, 866 F.3d 1315, 1323, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017); *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 Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b)-(b)(v).

In the present case, applicant’s mark is a design consisting of a lion in a standing position appearing next to a human person and registrant’s mark is the exact same design consisting of a lion in a standing position appearing next to a human person. These marks are identical in appearance “and have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff’d*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because they are identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant’s and registrant’s respective services. *Id.*

Therefore, the marks are confusingly similar.

ii. U.S. Reg. No. 5604679

When the marks at issue are both design marks, similarity of the marks is determined primarily on the basis of visual similarity. *See, e.g., Volkswagenwerk Aktiengesellschaft v. Rose 'Vear Enters.*, 592 F.2d 1180, 1183, 201 USPQ 7, 9 (C.C.P.A. 1979) (quoting *In re ATV Network Ltd.*, 552 F.2d 925, 929, 193 USPQ 331, 332 (C.C.P.A. 1977)); *Ft. James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1628 (TTAB 2007); TMEP §1207.01(c). However, a side-by-side comparison is not the test. *See Grandpa Pidgeon's of Mo., Inc. v. Borgsmiller*, 477 F.2d 586, 587, 177 USPQ 573, 574 (C.C.P.A. 1973). When comparing design marks, the focus is on the overall commercial impression conveyed by such marks, not on specific differences. *See Grandpa Pidgeon's of Mo., Inc. v. Borgsmiller*, 477 F.2d at 587, 177 USPQ at 574; *In re Triple R Mfg. Corp.*, 168 USPQ 447, 448 (TTAB 1970); TMEP §1207.01(c).

Here, both marks consist of a virtually identical or highly similar lion design. The only minor difference is that the lion appears in a different position in each mark—sitting in the registered mark; standing in the applicant's mark. Thus, the marks evince a similar overall commercial impression to the average purchaser.

In this case, consumers will likely focus on the lion design in applicant's mark and may confuse the mark with registrant's lion design mark, especially since the services of the respective parties are legally identical, as established in the previous Office actions.

B) Relatedness of the Services

Determining likelihood of confusion is based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, the registrations uses broad wording to describe the services (i.e., "legal services"), which presumably encompasses all services of the type described, including applicant's more narrow services (i.e., "personal injury legal services"). *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). Thus, applicant's and registrant's services are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

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