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Subject: U.S. Trademark Application Serial No. 88352905 - ARC - 10647510US02 - 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. 88352905

Mark: ARC

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Applicant: Panasonic Avionics Corporation

Reference/Docket No. 10647510US02

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REQUEST FOR RECONSIDERATION
AFTER FINAL ACTION
DENIED

Issue date: **June 30, 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).

In particular, in the request for reconsideration of June 1, 2020, applicant has submitted an amendment purporting to narrow the identification of services such that there is no longer likelihood of confusion between the instant applicant and the services specified in U.S. Registration Nos. 3125659, 3765901, 5168185, 3352915, and 3245853. The examining attorney disagrees.

U.S. Registration No. 3125659

At the outset the examining attorney notes that the marks at issue are comprised of the identical literal element ARC, where the applied-for mark is in standard character form and the registered mark is in stylized form with a geometric design. Where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the services needed to support a finding of likelihood of confusion declines. See *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); TMEP §1207.01(a).

As set forth in the final Office action issued on November 30, 2019, U.S. Registration No. 3125659 uses broad wording to describe registrant's "Advertising agency services **in all media**," which presumably encompasses all services of the type described, including applicant's more narrow identification (as amended) for various dissemination of advertising services offered inflight. As argued in the response to Office action of October 29, 2019, and again in the request for reconsideration of June 1, 2020, applicant improperly imputes limitations regarding the nature of these services that are not set forth in the registration. 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)).

Further, the evidence accompanying the final Office action of November 30, 2019, shows that advertising agencies provide a very broad range of services that may include far more than designing marketing campaigns, such as creating websites, engaging in social media and public relations communications, procuring and managing online advertising, and search engine optimization, among others. See previously attached screenshots from BalcomAgency.com, AdHouseAdvertising.com, and Forbes.com. Additional evidence shows that companies that provide inflight advertising on screens also provide other types of advertising services. See previously attached screenshots from TheAirport.org and PXCom.Media. As the evidence shows, modern advertising agency services are broadly offered and such services include not just the creation of advertisements, but also include advertising, display, and dissemination of advertising content across all potential forms of media.

Finally, it is noted that registrant's services have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)).

U.S. Registration Nos. 3765901, 5168185, 3352915, and 3245853

U.S. Registration Nos. 3765901 and 5168185 are comprised of the mark ARC in stylized and standard character form. As such the marks at issue are identical or near-identical. As stated above, where the marks of the respective parties are identical or virtually identical, as in this case, the degree of similarity or relatedness between the services needed to support a finding of likelihood of confusion declines. See *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993)), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); TMEP §1207.01(a).

U.S. Registration Nos. 3352915 and 3245853 are for the standard character marks MY ARC and ARC MARKETPLACE. The marks share the identical element ARC with the registered marks encompassing the entirety of the applied-for mark. The additional wording appearing in these marks is insufficient to differentiate the marks. 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.

With respect to the referenced registrations, the services at issue are "electronic commerce services, namely, providing information on travel-related goods and services via telecommunications networks for advertising and sales purposes for use by authorized persons/entities in the travel industry."

Applicant again argues the narrowing amendments made in the request for reconsideration are sufficient to avoid likelihood of confusion here. The examining attorney disagrees because applicant's limitations regarding the services provided in flight do not sufficiently avoid the services as set forth in the registration, which may also be provided in flight because registrant's services are provided "via telecommunications networks," which may encompass inflight telecommunications networks, and "for use by authorized persons/entities in the travel industry" could include airlines or airline passengers. Applicant primarily argues against likelihood of confusion by improperly imputing limitations about the users of registrant's services that are not set forth in the registration. Applicant argues that the term "for use by authorized persons/entities in the travel industry" appearing in the registrations means that

registrant's services are accessible only to "travel agents and others engaged in the travel industry" however, the registration does not indicate who the "authorized users" of registrant's services and this language certainly is not conclusive evidence that the consumers of registrant's and applicant's services do not overlap.

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)). The primary substance of applicant's arguments are based on improperly reading limitations into the recitation of services in the registrations and these arguments are found unpersuasive.

Finally, to the extent that that the request for reconsideration argues that the consumers of the services are sophisticated, such arguments are rejected for the reasons previously stated in the final Office action of November 30, 2019. Even if consumers of the compared services could be considered sophisticated and discriminating, it is settled that "even sophisticated purchasers are not immune from source confusion, especially in cases such as the present one involving identical marks and related goods [and/or services]." *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1413 (TTAB 2015) (citing *In re Research & Trading Corp.*, 793 F.2d 1276, 1279, 230 USPQ 49, 50 (Fed. Cir. 1986)), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *see also In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). The identity of the marks and the relatedness of the goods and/or services "outweigh any presumed sophisticated purchasing decision." *In re i.am.symbolic, llc*, 116 USPQ2d at 1413 (citing *HRL Assocs., Inc. v. Weiss Assocs., Inc.*, 12 USPQ2d 1819, 1823 (TTAB 1989), *aff'd*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990)); *see also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014).

Accordingly, the following refusal made final in the Office action dated November 30, 2019, is **maintained and continued**:

- Registration is Refused: Likelihood of Confusion

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).

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