

Attorney Ref.: 31490/592

Class No. : 30  
Examiner : Jennifer McGarry Martin  
Law Office 116

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant** : **ITC Entertainment Group Limited**  
**Mark** : **THUNDERBIRDS**  
**Serial No.** : **75/547,853**  
**Filing Date** : **September 3, 1998**

Commissioner for Trademarks  
2900 Crystal Drive  
BOX RESPONSES NO FEE  
Arlington, VA 22202-3513

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on

Date 2/14/03 Atty's Reg. # \_\_\_\_\_  
Atty's Signature *Gregory N. Kenyon*  
KENYON & KENYON

**RESPONSE TO OFFICE ACTION**  
**AND REQUEST FOR RECONSIDERATION**

MADAM:

This letter is in response is in response to the Office Action mailed August 14, 2002.

**AMENDMENT**

Please amend the description of goods for the subject application to read as follows:

Candy, frozen confections, breakfast cereal, bread, pastries, flavored ices, popped, microwave and candy coated popcorn, snacks in form of chips and crackers, pasta, biscuits, ice cream, frozen yogurt, cookies, cakes, chewing gum, hot chocolate, marshmallows, pies, waffles, pancakes, and chocolate and maple syrup, all sold in connection with a children's film and television series.

## R E M A R K S

**I. Applicant's mark, as amended, is not likely to be confused with Registrant's mark**

The Examining Attorney has issued a final refusal to register the subject application owned by ITC Entertainment Group Limited on the grounds that it is confusingly similar to Registration No. 2,000,120 for the mark THUNDERBIRD FORD, owned by Ford Motor Company Corporation (hereinafter, "Registrant"). In light of the Amendment above, Applicant respectfully requests that the Examining Attorney reconsider and withdraw her refusal.

The above Amendment to Applicant's identification of goods incorporates the phrase "all sold in connection with a children's film and television series." By specifying the merchandising purpose of Applicant's goods, Applicant's Amendment emphasizes the difference between the marketing channels of Applicant and those of Registrant. Applicant submits that consumers are not likely to confuse the source of Applicant's goods, sold in connection with a children's film and television series, with the source of Registrant's goods, sold in connection with the Registrant automotive company's name ("FORD") under the THUNDERBIRD FORD mark. Registrant's two-term mark clearly identifies the source of goods as being Ford Motor Company. In light of this marked and prominent difference in source-indication, which is underscored by Applicant's Amendment, Applicant respectfully requests that the Examining Attorney reconsider and withdraw her refusal to register and pass the subject application on to publication.

## **II Consent from Registrant is expected shortly**

While Applicant disputes that its mark, as amended, is likely to be confused with Registrant's mark, in the interest of advancing this application to registration, Applicant submits, in the alternative, that the Examining Attorney should suspend the proceedings for a limited time while Applicant obtains acceptable consent from Registrant. Applicant advises that a detailed consent agreement with Registrant, concerning the use and registration of Applicant's Mark and Registrant's mark, is under final review by Registrant's counsel. Applicant expects to have a fully executed version of the consent agreement within two months' time. This agreement details, inter alia, the reasons why no likelihood of confusion exists between the two marks, as well as arrangements undertaken by the parties to avoid any future confusion to the public. These points address the concerns raised by the Examining Attorney in her second Office Action.

In view of these good faith, final negotiations going on between Applicant and Registrant concerning an acceptable consent agreement, Applicant respectfully requests that further action in connection with the subject application be suspended for a limited amount of time to allow Applicant to obtain a suitable consent agreement. This request is made in accordance with TMEP §716<sup>1</sup>. Given that the parties are in the final stage of negotiations, Applicant submits that

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<sup>1</sup> See, in particular, TMEP §716.06:

“Suspension After Final Action

If the examining attorney determines that action on an application should be suspended after issuance of a final refusal, the examining attorney must issue a suspension notice...”

this request for suspension is made for good and sufficient cause. This request is not being made for the purpose of unduly delaying the proceedings.

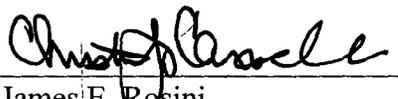
**CONCLUSION**

In view of the Amendment, as well as the dissimilar marketing conditions of Applicant's mark and Registrant's mark, Applicant respectfully requests that the Examining Attorney withdraw her refusal to register and pass the mark on for publication in the Official Gazette. In the alternative, Applicant respectfully requests that the Examining Attorney grant Applicant's request for a limited suspension of the proceedings while Applicant and Registrant finalize a detailed consent agreement. However, if for any reason the Examining Attorney does not grant this Request for Reconsideration, Applicant hereby appeals the final rejection. Attached is a copy of the Notice of Appeal being filed concurrently herewith. If the Examining attorney has any questions, she is urged to call the undersigned attorney.

Respectfully submitted,

KENYON & KENYON

February 14, 2003

By:   
James E. Rosini  
Christin J. Caroselli

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New York, New York 10004  
(212) 425-7200

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

Serial No.:	75/547,853	)	
Applicant:	ITC Entertainment Group Limited	)	Examining Attorney:
Filed:	September 3, 1998	)	Jennifer McGarry Martin
Mark:	THUNDERBIRDS	)	Law Office 116

Box TTAB  
FEE

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202

**NOTICE OF APPEAL**

M A D A M:

Applicant hereby appeals from the Examining Attorney's final refusal of its application to register the above mark on the Principal Register.

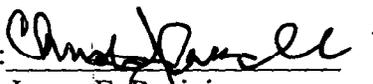
The application is now the subject of a Response to Office Action and Request for Reconsideration. This appeal is being filed to preserve Applicant's rights in the event that the Request for Reconsideration is denied.

Please charge the appeal fee to Kenyon & Kenyon's Deposit Account No. 11-0600. A duplicate of this Notice is enclosed for that purpose.

Respectfully submitted,

KENYON & KENYON

Date: February 14, 2003

By:   
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