

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77560314
LAW OFFICE ASSIGNED	LAW OFFICE 104
MARK SECTION (no change)	
ARGUMENT(S)	
<p>ARGUMENT(S) In response to the substantive refusal(s), please note the following:</p> <p>Applicant, by and through its counsel, responds as follows to the Office Action issued in the above-captioned application:</p> <p>I. INTRODUCTION</p> <p>Smarty Ants, Inc. ("Applicant") has applied to register the mark SMARTY ANTS ("Applicant's Mark") in connection with educational game software as more fully stated in the application, namely:</p> <p style="padding-left: 40px;">"Downloadable electronic game software for educational games for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels; video game discs containing electronic game software for educational games for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels" in Class 9.</p> <p>The Examining Attorney has issued an Office Action refusing to register Applicant's Mark, stating that Applicant's Mark is likely to be confused with the mark SMARTY PANTS owned by Electronic Arts Inc. ("EA") for an entertainment software game and related services as specified in U.S. Registration No. 3469148 (the "EA Mark") and thus refusing registration under Lanham Act</p>	

Section 2(d), § 1052(d). As explained below, Applicant and EA have agreed in writing that it is not likely that consumers will be confused or misled by the concurrent use or registration of Applicant's Mark by Applicant and the EA Mark by EA. In light of that agreement, and the reasons stated therein as to why Applicant and EA are satisfied that there will be no likelihood of confusion arising from their use of their respective marks, SMARTY ANTS and SMARTY PANTS, for their respective goods and services, the refusal should be withdrawn and the application should proceed to publication.

II. APPLICANT'S MARK SHOULD PROCEED TO PUBLICATION BECAUSE APPLICANT AND THE OWNER OF THE CITED MARK, REGISTRATION NO. 3469148, HAVE DETERMINED THAT THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S SMARTY ANTS MARK AND THE CITED MARK, SMARTY PANTS.

The Federal Circuit has held that consent agreements should be given great weight, and that the PTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 U.S.P.Q.2d 1305 (Fed. Cir. 1988); *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 U.S.P.Q.2d 1775 (Fed. Cir. 1987); and *In re N.A.D. Inc.*, 754 F.2d 996, 224 U.S.P.Q. 969 (Fed. Cir. 1985). Likewise, the Trademark Manual of Examining Procedure (TMEP) provides that: "[t]he examining attorney should give great weight to a proper consent agreement. The examining attorney should not interpose his or her own judgment concerning likelihood of confusion when an applicant and registrant have entered into a *credible* consent agreement and, *on balance*, the other factors do not dictate a finding of likelihood of confusion." (TMEP 1207.01(d)(viii))

Based on a number of relevant factors, Applicant and EA believe that there is no likelihood of consumer confusion between Applicant's goods and services to be provided under Applicant's Mark, on the one hand, and EA's goods sold under its EA Mark, on the other hand. (See Consent Letter, Exhibit 1 hereto.) The parties believe there is no likelihood of confusion because:

- The parties' marks differ in their commercial impressions in that the EA Mark is the familiar expression "smarty pants," connoting a smart aleck, while the marks reflected in the Smarty Ants Applications are a play on words that adds to the notion of "smarty pants" the concept of small insects, namely animated ant characters, which will feature prominently in the Smarty Ants Goods and Services.

- The parties will use their marks on different types of goods and services: EA uses the EA Mark for an entertainment trivia game for the Wii console and for online play, designed for users “from eight to eighty,” while Smarty Ants intends to use the marks reflected in the Smarty Ants Applications for education game software designed to teach children younger than that (pre-Kindergarten, Kindergarten, and first grade) reading and other skills, and related products and services.
- The parties will market their goods and services under their respective marks differently: for example, while EA’s game software is typically sold in the entertainment software section of a store, Smarty Ants’ educational software is expected to be sold in the educational products or children’s educational games sections of a store; moreover, while EA’s goods and services will be targeted at a general audience, Smarty Ants’ goods and services will be targeted at parents seeking to help their young children learn.
- The target customers for the Smarty Ants Goods and Services, parents seeking to help their young children learn, are expected to be particularly careful when purchasing educational products for their children.
- The parties will use their respective marks in connection with differently themed products: the EA Mark is used in connection with a product which features a light bulb character and the Smarty Ants Mark will be used in connection with a product which features ant characters.
- The agreement between Smarty Ants and EA requires that Smarty Ants and EA will cooperate to take reasonable steps necessary to prevent the possibility of customer confusion arising in the future, should such a need arise.

III. Conclusion

Applicant respectfully submits that the Examining Attorney should allow Applicant’s Mark to proceed to publication because, in addition to the reasons stated in Applicant’s June 5, 2009 response to office action, the Applicant and the owner of the cited mark believe that Applicant’s Mark creates no likelihood of confusion with respect to the cited mark and have executed a consent agreement, including an agreement to take reasonable measures to prevent any confusion.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	http://tgate/PDF/RFR/2009/12/11/20091211171516680715-77560314-001_001/evi_7113517988-171107538_.smarty.pdf
CONVERTED PDF FILE(S) (5 pages)	\\TICRS\EXPORT8\IMAGEOUT8\775\603\77560314\xml1\RFR0002.JPG
	\\TICRS\EXPORT8\IMAGEOUT8\775\603\77560314\xml1\RFR0003.JPG
	\\TICRS\EXPORT8\IMAGEOUT8\775\603\77560314\xml1

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	\\TICRS\EXPORT8\IMAGEOUT8\775\603\77560314\xml1 \RFR0006.JPG
DESCRIPTION OF EVIDENCE FILE	a copy of the consent letter referenced in the Request for Reconsideration after Final Action
SIGNATURE SECTION	
RESPONSE SIGNATURE	/John W. Crittenden/
SIGNATORY'S NAME	John W. Crittenden
SIGNATORY'S POSITION	Attorney of Record
DATE SIGNED	12/11/2009
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Dec 11 17:15:16 EST 2009
TEAS STAMP	USPTO/RFR-71.135.179.88-2 0091211171516680715-77560 314-4606fbff6450959d19c87 c228f2735694b-N/A-N/A-200 91211171107538893

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **77560314** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Applicant, by and through its counsel, responds as follows to the Office Action issued in the above-

captioned application:

I. INTRODUCTION

Smarty Ants, Inc. ("Applicant") has applied to register the mark SMARTY ANTS ("Applicant's Mark") in connection with educational game software as more fully stated in the application, namely:

"Downloadable electronic game software for educational games for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels; video game discs containing electronic game software for educational games for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels" in Class 9.

The Examining Attorney has issued an Office Action refusing to register Applicant's Mark, stating that Applicant's Mark is likely to be confused with the mark SMARTY PANTS owned by Electronic Arts Inc. ("EA") for an entertainment software game and related services as specified in U.S. Registration No. 3469148 (the "EA Mark") and thus refusing registration under Lanham Act Section 2 (d), § 1052(d). As explained below, Applicant and EA have agreed in writing that it is not likely that consumers will be confused or misled by the concurrent use or registration of Applicant's Mark by Applicant and the EA Mark by EA. In light of that agreement, and the reasons stated therein as to why Applicant and EA are satisfied that there will be no likelihood of confusion arising from their use of their respective marks, SMARTY ANTS and SMARTY PANTS, for their respective goods and services, the refusal should be withdrawn and the application should proceed to publication.

II. APPLICANT'S MARK SHOULD PROCEED TO PUBLICATION BECAUSE APPLICANT AND THE OWNER OF THE CITED MARK, REGISTRATION NO. 3469148, HAVE DETERMINED THAT THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S SMARTY ANTS MARK AND THE CITED MARK, SMARTY PANTS.

The Federal Circuit has held that consent agreements should be given great weight, and that the PTO should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 U.S.P.Q.2d 1305 (Fed. Cir. 1988); *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 U.S.P.Q.2d 1775 (Fed. Cir. 1987); and *In re N.A.D.*

Inc., 754 F.2d 996, 224 U.S.P.Q. 969 (Fed. Cir. 1985). Likewise, the Trademark Manual of Examining Procedure (TMEP) provides that: “[t]he examining attorney should give great weight to a proper consent agreement. The examining attorney should not interpose his or her own judgment concerning likelihood of confusion when an applicant and registrant have entered into a *credible* consent agreement and, *on balance*, the other factors do not dictate a finding of likelihood of confusion.” (TMEP 1207.01(d)(viii))

Based on a number of relevant factors, Applicant and EA believe that there is no likelihood of consumer confusion between Applicant’s goods and services to be provided under Applicant’s Mark, on the one hand, and EA’s goods sold under its EA Mark, on the other hand. (*See* Consent Letter, Exhibit 1 hereto.) The parties believe there is no likelihood of confusion because:

- The parties’ marks differ in their commercial impressions in that the EA Mark is the familiar expression “smarty pants,” connoting a smart aleck, while the marks reflected in the Smarty Ants Applications are a play on words that adds to the notion of “smarty pants” the concept of small insects, namely animated ant characters, which will feature prominently in the Smarty Ants Goods and Services.
- The parties will use their marks on different types of goods and services: EA uses the EA Mark for an entertainment trivia game for the Wii console and for online play, designed for users “from eight to eighty,” while Smarty Ants intends to use the marks reflected in the Smarty Ants Applications for education game software designed to teach children younger than that (pre-Kindergarten, Kindergarten, and first grade) reading and other skills, and related products and services.
- The parties will market their goods and services under their respective marks differently: for example, while EA’s game software is typically sold in the entertainment software section of a store, Smarty Ants’ educational software is expected to be sold in the educational products or children’s educational games sections of a store; moreover, while EA’s goods and services will be targeted at a general audience, Smarty Ants’ goods and services will be targeted at parents seeking to help their young children learn.
- The target customers for the Smarty Ants Goods and Services, parents seeking to help their young children learn, are expected to be particularly careful when purchasing educational products for their children.
- The parties will use their respective marks in connection with differently themed products: the EA Mark is used in connection with a product which features a light bulb character and the Smarty Ants Mark will be used in connection with a product which features ant characters.
- The agreement between Smarty Ants and EA requires that Smarty Ants and EA will cooperate to take reasonable steps necessary to prevent the possibility of customer confusion arising in the future, should such a need arise.

III. Conclusion

Applicant respectfully submits that the Examining Attorney should allow Applicant’s Mark to proceed to publication because, in addition to the reasons stated in Applicant’s June 5, 2009 response to

office action, the Applicant and the owner of the cited mark believe that Applicant's Mark creates no likelihood of confusion with respect to the cited mark and have executed a consent agreement, including an agreement to take reasonable measures to prevent any confusion.

EVIDENCE

Evidence in the nature of a copy of the consent letter referenced in the Request for Reconsideration after Final Action has been attached.

Original PDF file:

http://tgate/PDF/RFR/2009/12/11/20091211171516680715-77560314-001_001/evi_7113517988-171107538_.smarty.pdf

Converted PDF file(s) (5 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

SIGNATURE(S)**Request for Reconsideration Signature**

Signature: /John W. Crittenden/ Date: 12/11/2009

Signatory's Name: John W. Crittenden

Signatory's Position: Attorney of Record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77560314

Internet Transmission Date: Fri Dec 11 17:15:16 EST 2009

TEAS Stamp: USPTO/RFR-71.135.179.88-2009121117151668

0715-77560314-4606fbff6450959d19c87c228f

2735694b-N/A-N/A-20091211171107538893

December 8, 2009

Stephen G. Bene
General Counsel
Electronic Arts Inc.
209 Redwood Shores Parkway
Redwood City, CA 94065

Re: Trademark Application Serial Nos. 77560314, 77759811, 77759815, 77759819,
77560325, 77759833, 77759850, 77759857, 77759866, and 77759875
For Mark: SMARTY ANTS and SMARTY ANTS and Design (the "Smarty Ants
Marks")
Applicant: Smarty Ants, Inc.

Dear Mr. Bene:

By this letter Smarty Ants, Inc. ("Smarty Ants") requests that Electronic Arts Inc. ("EA") consent to Smarty Ants' use and registration of the marks SMARTY ANTS (Application Nos. 77560314, 77759811, 77759815, 77759819, and 77560325) and SMARTY ANTS and design (Application Nos. 77759833, 77759850, 77759857, 77759866, and 77759875) (collectively the "Smarty Ants Applications"), in connection with the goods and services reflected in Exhibit A to this letter (the "Smarty Ants Goods and Services"). The EA trademark SMARTY PANTS (U.S. Trademark Registration No. 3469148) (the "EA Mark") was cited by the U.S. Patent and Trademark Office as a bar to registration of Smarty Ants' applications to register the mark SMARTY ANTS in International Classes 9 and 41, Serial Nos. 77560314 and 77560325, on the ground of likelihood of confusion.

As EA and Smarty Ants have agreed, it is not likely that consumers will be confused or misled by the use or registration of the trademarks reflected in the Smarty Ants Applications by Smarty Ants, concurrently with the use and registration of the EA Mark, for at least the following reasons:

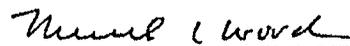
- The parties' marks differ in their commercial impressions in that the EA Mark is the familiar expression "smarty pants," connoting a smart aleck, while the marks reflected in the Smarty Ants Applications are a play on words that adds to the notion of "smarty pants" the concept of small insects, namely animated ant characters, which will feature prominently in the Smarty Ants Goods and Services.
- The parties will use their marks on different types of goods and services: EA uses the EA Mark for an entertainment trivia game for the Wii console and for online play, designed for users "from eight to eighty," while Smarty Ants intends to use the marks reflected in

the Smarty Ants Applications for education game software designed to teach children younger than that (pre-Kindergarten, Kindergarten, and first grade) reading and other skills, and related products and services.

- The parties will market their goods and services under their respective marks differently: for example, while EA's game software is typically sold in the entertainment software section of a store, Smarty Ants' educational software is expected to be sold in the educational products or children's educational games sections of a store; moreover, while EA's goods and services will be targeted at a general audience, Smarty Ants' goods and services will be targeted at parents seeking to help their young children learn.
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- The parties will use their respective marks in connection with differently themed products: the EA Mark is used in connection with a product which features a light bulb character and the Smarty Ants Mark will be used in connection with a product which features ant characters.
- The Agreement requires that Smarty Ants and EA will cooperate to take reasonable steps necessary to prevent the possibility of customer confusion arising in the future, should such a need arise.

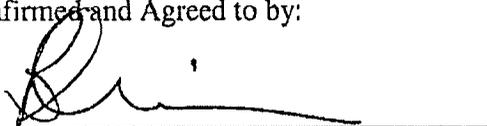
Your signature below constitutes EA's consent to Smarty Ants' use and registration with the United States Patent and Trademark Office of the marks reflected in the Smarty Ants Applications in connection with the Smarty Ants Goods and Services.

Very truly yours,



Smarty Ants, Inc.
Michael C. Wood
President

Confirmed and Agreed to by:



Electronic Arts, Inc.
~~Stephen G. Bene~~ Brian Deppiesse
~~General Counsel~~ Senior Vice President

Dated: 12/11/09

EXHIBIT A

**SMARTY ANTS, INC.
SMARTY ANTS U.S. TRADEMARK APPLICATIONS**

MARK	COUNTRY	APPLICATION/ REGISTRATION NO.	CLASS/GOODS/ SERVICES
SMARTY ANTS	United States	Application No. 77/560,314	Class 9: downloadable electronic game software for educational games for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels; video game discs containing electronic game software for educational games for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels
SMARTY ANTS	United States	Application No. 77/759,811	Class 16: educational publications, namely, educational learning cards, flash cards, activity cards, workbooks, textbooks, activity books, story books, puzzle books, printed puzzles, teacher guides, manuals, posters and educational booklets in the field of early childhood education
SMARTY ANTS	United States	Application No. 77/759,815	Class 25: clothing, namely, headwear, shirts, jackets, sweat shirts, sweaters, fleece tops, vests, jerseys, shorts, pants, dresses, skirts, neckties, scarves, bandannas, sleepwear, socks, slippers, children's and infants' bibs, infant and toddler one piece clothing, infant sleepers, swimwear, underwear
SMARTY ANTS	United States	Application No. 77/759,819	Class 28: educational toys for teaching reading, language and other early childhood education subjects, namely, interactive stuffed toys; electronic educational game machines for children; electronic games for the teaching of children; electronic learning toys; stuffed dolls and animals; accessories for stuffed dolls and animals

MARK	COUNTRY	APPLICATION/ REGISTRATION NO.	CLASS/GOODS/ SERVICES
SMARTY ANTS	United States	Application No. 77/560,325	Class 41: education and entertainment services, namely, providing online interactive educational role-playing computer learning games for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels; Providing an interactive website featuring learning games and activities in the fields of children's education and entertainment, for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels
	United States	Application No. 77/759,833	Class 9: computer software for educational games for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels
	United States	Application No. 77/759,850	Class 16: educational publications, namely, educational learning cards, flash cards, activity cards, workbooks, textbooks, activity books, story books, puzzle books, printed puzzles, teacher guides, manuals, posters and educational booklets in the field of early childhood education
	United States	Application No. 77/759,857	Class 25: clothing, namely, headwear, shirts, jackets, sweat shirts, sweaters, fleece tops, vests, jerseys, shorts, pants, dresses, skirts, neckties, scarves, bandannas, sleepwear, socks, slippers, children's and infants' bibs, infant and toddler one piece clothing, infant sleepers, swimwear, underwear

MARK	COUNTRY	APPLICATION/ REGISTRATION NO.	CLASS/GOODS/ SERVICES
	United States	Application No. 77759,866	Class 28: educational toys for teaching reading, language and other early childhood education subjects, namely, interactive stuffed toys; electronic educational game machines for children; electronic games for the teaching of children; electronic learning toys; stuffed dolls and animals; accessories for stuffed dolls and animals
	United States	Application No. 77759,875	Class 41: education and entertainment services, namely, providing online interactive educational games for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels; Providing an interactive website featuring learning games and activities in the fields of children's education and entertainment, for children at the pre-Kindergarten, Kindergarten, and First Grade levels, featuring the teaching of reading and language learning through the principles of phonics and other educational content designed for those grade levels