Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77789151
LAW OFFICE ASSIGNED	LAW OFFICE 117
MARK SECTION (no	o change)
ARGUMENT(S)	

REQUEST FOR RECONSIDERATION

SUBMITTED ELECTRONICALLY

This is in response to the final Office Action of April 16, 2010.

For the reasons discussed below, Applicant respectfully requests that the Examining Attorney reconsider the final refusal to register Applicant's Mark in light of additional arguments submitted herewith. *See* T.M.E.P. § 715.03.

I. APPLICANT'S MARK IS NOT LIKELY TO BE CONFUSED WITH THE CITED MARKS

The Examining Attorney initially refused registration of the mark BILL'S BAR & BURGER ("Applicant's Mark") as applied to restaurant and bar services under Section 2(d) on the ground that it is likely to be confused with the mark BILL'S of Registration No. 3,651,118 as applied to restaurant and bar services and BILL'S GAMBLIN' HALL & SALOON & Design of Registration No. 3,316,023 as applied to casino and gaming services; entertainment services, namely, arranging for ticket reservations for shows and other entertainment events; entertainment services in the nature of musical, variety and comedy shows; conducting and providing facilities for special events featuring casino and gaming contest and tournaments; hotel services; bar and restaurant services; provision of conference, exhibition and meeting facilities (collectively, the "Cited Marks"). The Cited Marks are owned by the same Registrant.

After Applicant submitted its Response to the initial Office Action, the Examining Attorney withdraw the objection based on BILL'S GAMBLIN' HALL & SALOON & Design.

In the instant case, the Examining Attorney has admitted that the term BILL is weak. Accordingly, under established precedent, when the marks as a whole are considered in their entireties, the differences between the respective Marks - *i.e.*, BILL'S BAR & BURGER on the one hand, and BILL'S (without

any additional matter) on the other - should be sufficient to distinguish them. It is further noted that when the specimen of use for the Cited Mark BILL'S is reviewed, as the Examining Attorney is entitled to do as part of the record, it is clear that BILL'S is used only in close association with the descriptive wording: "GAMBLIN' HALL & SALOON & Design," which is the relevant wording of the second originally Cited Mark. This shows that the public sees the mark in a distinguishable manner from Applicant's BILL'S BAR AND BURGER. A copy of the specimen of use submitted in support of the Cited Mark BILL'S is attached as Exhibit A.

II. THERE IS NO LIKELIHOOD OF CONFUSION

1. THE FACT THAT THE CITED MARK IS WEAK IS VERY SIGNIFICANT IN DETERMINING WHETHER CONFUSION IS LIKELY

Whether a mark is classified as "strong" or "weak" is a very important element in deciding likelihood of confusion. 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:48 (4th Ed. 2009).

The Examining Attorney has admitted that the term BILL is weak (Office Action at p. 3).

This position is supported by several factors:

- A. BILL is a personal name, and personal names are considered weak (See In re Rath, 402 F.3d 1207, 1221 (Fed. Cir. 2005) ("Both surnames and first names are regarded as descriptive terms."); Russell Harrington Cutlery Inc. v. Zivi Hercules Inc., 25 U.S.P.Q.2d 1965, 1968 n.10 (Ma. 1992) (descriptive terms are considered weak).
- B. There are numerous third party registrations for BILL formative marks as applied to identical and closely related goods and services, including:
 - (1) Reg. No. 2,622,593 for the mark BILL'S FAMOUS FOODS and design for goods which include restaurant and deli services;
 - (2) Reg. No. 1,170,668 for the mark BILL'S BARBECUE for restaurant services;
 - (3) Reg. No. 1,677,182 for the mark BILL'S PIZZA & PUB ONLY THE BEST SINCE 1957 and design for restaurant services;
 - (4) Reg. No. 2,281,824 for the mark BILLY'S for restaurant services featuring stone crabs and seafood; and
 - (5) Reg. No. 2,336,100 for the mark BILLY'S STONE CRAB for restaurant services featuring stone crabs and seafood.

The weakness of the term BILL is also underscored by the fact that the name William, of which "Bill"

is the most common nickname, is the 5th most popular baby name in 2009. See Print-out from Social Security Administration website, attached as Exhibit B. We think judicial notice can be taken that William's popularity over the last half century has always been on par with the 2009 statistic. Based on the ubiquitous use of BILL, it is not surprising that there are numerous co-existing registrations for restaurants named after individuals named BILL, underscoring the fact that the public recognizes that not all "BILL" restaurants are related to each other, and that they must further analyze the use and marks, in their entireties, to distinguish among them.

2. WHEN MARKS SHARE ONLY A WEAK ELEMENT, CONFUSION IS NOT LIKELY

When conflicting marks share only a weak element in common, confusion is not likely. For example, in *Tana v. Dantanna's*, 611 F.3d 767 (11th Cir. 2010), a case with striking similarities to the instant case, the Court held that there was no likelihood of confusion between DAN TANA, which consists of a name and is therefore weak, and DANTANNA, both for restaurants. *See also In re Box Solutions Corp.*, 79 U.S.P.Q.2d 1953 (T.T.A.B. 2006) (no likelihood of confusion between BOX and BOX SOLUTIONS, both for computers; "the differences outweigh the similarities given the weakness of the common element"); *Stouffer Corp. v. Health Valley Natural Foods, Inc.*, 1 U.S.P.Q.2d 1900, 1904 (T.T.A.B. 1986) (no likelihood of confusion between LEAN CUISINE and LEAN LIVING, both as applied to food products, because common portion "lean" is at least highly suggestive of low fat food).

Based on the foregoing, the difference between BILL'S BAR & GRILL on the one hand and BILL'S alone on the other, are sufficiently different to avoid any confusion.

3. The Cases and T.M.E.P. Section Relied On By The Examining Attorney Do Not Alter The Conclusion That Confusion is Unlikely

The Examining Attorney's reference to Section 1207.01(b)(ix) of the Trademark Manual does not alter the conclusion that confusion is unlikely between Applicant's Mark and the Cited Marks. Indeed, the first sentence of this Section supports Applicant's position that the Cited Marks are only entitled to a narrow scope of protection:

The Trademark Trial and Appeal Board and the courts have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word.

Although this Section also states "even a weak mark is entitled to protection against the registration of a similar mark for closely related goods or services," the case cited for this proposition, *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, (C.C.P.A. 1974), in fact supports Applicant's argument that there is no likelihood of confusion since the Court found that confusion was <u>not</u> likely between KING'S for candy and MISS KING'S for cakes.

Indeed, the Court in King Candy stated:

The expressions "weak" and "entitled to limited protection" are but other ways of saying . . . that confusion is unlikely because the marks are of such non-arbitrary nature or so widely used that the public easily distinguishes slight differences in the marks under consideration . . .

Id. at 1401.

In re Colonial Stores, Inc., 216 U.S.P.Q. (BNA) 793 (T.T.A.B. 1982), also cited by the Examining Attorney, is easily distinguishable because in that case, the marks were identical - COUNTRY PRIDE for meats on the one hand and COUNTRY PRIDE for bread on the other.

III. CONCLUSION

Based on the foregoing, Applicant respectfully submits that its Mark is not confusingly similar to the Cited Marks, and respectfully requests that the Examining Attorney reconsider its refusal to register.

EVIDENCE SECTION				
EVIDENCE FILE NAME(S)				
ORIGINAL PDF FILE	evi_208229218102- 164248665A_and_B_to_Request_for_Reconsideration _BILL_S_BARBURGER.pdf			
CONVERTED PDF FILE(S) (9 pages)	\\TICRS\EXPORT11\IMAGEOUT11\777\891\77789151\xml1\RFR0002.JPG			
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	\\TICRS\EXPORT11\IMAGEOUT11\777\891\77789151\xml1\RFR0010.JPG			
DESCRIPTION OF EVIDENCE FILE	Exhibit A - scanned images of specimen of use in support of Cited Mark for BILL'S; and Exhibit B - scanned images of printout from Social Security website			
SIGNATURE SECTIO	N .			
RESPONSE SIGNATURE	/Chester Rothstein/			
SIGNATORY'S NAME	Chester Rothstein			
SIGNATORY'S				

POSITION	Attorney of Record
DATE SIGNED	10/14/2010
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATI	ON SECTION
SUBMIT DATE	Thu Oct 14 16:54:44 EDT 2010
TEAS STAMP	USPTO/RFR-208.229.218.102 -20101014165444141142-777 89151-470a4555f968b69f1c5 08ba9777838eece-N/A-N/A-2 0101014164248665970

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. 77789151 has been amended as follows:

ARGUMENT(S)

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

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Original PDF file:

evi_208229218102-164248665_._A_and_B_to_Request_for_Reconsideration_-BILL S BAR BURGER.pdf

Converted PDF file(s) (9 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

Evidence-5

Evidence-6

Evidence-7

Evidence-8

Evidence-9

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Chester Rothstein/ Date: 10/14/2010

Signatory's Name: Chester Rothstein 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: 77789151

Internet Transmission Date: Thu Oct 14 16:54:44 EDT 2010 TEAS Stamp: USPTO/RFR-208.229.218.102-20101014165444

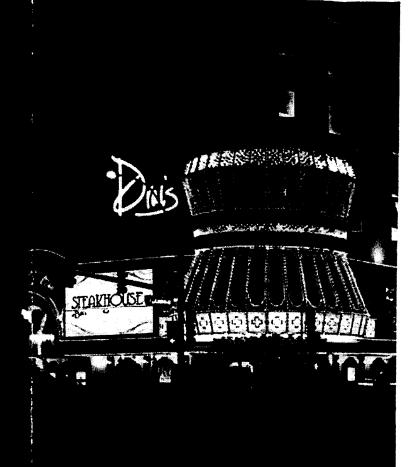
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EXHIBIT A



3595 Las Vegas Blvd., South Las Vegas, 8V 89109 702737 2100

www.billslasvegas.com 866-BHLS-45



On the corner where Lamingo meets the Strip-





Welcome

to

CANDIN HALL

This directory will introduce you to many of our facilities and services.

We take great pride in providing all the best that Las Vegas has to offer in comfort, convenience, food and beverage.

We hope your visit is a pleasant one.

If there is anything that our staff can do to make your stay more enjoyable, please don't hesitate to ask.

Thank you for choosing Bill's Gamblin' Hall & Saloon.

STAFF AND MANAGEMENT



RESTAURANTS AND BARS

At Bill's, we offer restaurant experiences, from elegant to casual, that will appeal to your individual tastes.



Intimate dining in a comfortable, casual environment. Specializing in steaks, seafood and chops, plus chicken and pasta. Enjoy table preparations of Caesar and spinach salads, cherries jubilee and bananas Foster,

Dial 856 for reservations.

Victorian Room

Round-the-clock dining and fast, friendly service distinguish the Victorian Room. The menu features a wide variety of reasonably priced breakfast, lunch and dinner specialties, including delicious Chinese cuisine.

Dial 855 for reservations.



Reservations and special arrangements can be made by calling 702-737-0555 or dial 600 for reservations.





Relax and unwind with your favorite cocktail and live entertainment nightly featuring Top 40 bands. Big "Elvis" performs Monday through Friday from 3 p.m. to 7:15 p.m. for his fans.

CASINO

TABLE GAMES

The casino features Blackjack, Craps, Roulette, Big Six, Three Card Poker, WSOP, Texas Hold 'Em and Fortune Pai Gow Poker,

BILL'S PLAYERS CLUB

Be sure to sign up for Bill's Players Club. As a member, you will be entitled to special rewards and benefits based on your play.



SLOTS

Bill's features a vast selection of the most popular slots and video poker, as well as traditional favoriles. Choose from more than 600 machines in a wide variety of types and denominations. Just insert your free Bill's Players Club card into any machine and you'll earn comps and more while playing. Be sure to ask about our monthly promotions.



Cheer all the action in our Race and Sports Book. With individual monitors for your viewing pleasure, new generation LED reader boards, and the most up-to-date high-resolution glant-screen televisions, the Race and Sports Book brings all major race and sports events to Bill's. The Race Book provides six betting windows for pari-mutuel wagering, while the Sports Book features four betting windows.

AMENITIES

Some of the amenities offered at Bill's include high-speed Internet capabilities and high-definition plasma screen televisions in each room, a Seattle's Best Coffee bar and Western Union so you can send and receive money quick and easily.



WESTERN UNION





LAS MIGAS, MINIMA

HOTEL CASINO DIMING ENTERTAINMENT EMPLOYMENT CONTACT

- Rooms
- Amenities

Flamingo Poo! Western Union

Seattle's Best Coffee

Maps



Check Room Kates

When will you be arriving? February 4 2009

Word Pages Check Rate

Have a promo code?

Call in reservations.

(666-245-5745)

Welcome to Bill's Gamblin' Hall & Saloon

Best Strip Deal says the New York Post

"Our favorite affordable hotel is...Bill's Gamblin' Hall & Saloon..."

Located on the corner where the Flamingo meets the Strip, Bill's Gamblin' Hall & Saloon, named after company founder Bill Harrah, combines personalized service, outstanding quality and exceptional value with the charm of a warm and friendly smaller hotel.

Your Bill's Room Key Unlocks Vegas' Hottest Pool!

Indulge your senses, cool your body and quench your thirst at the Flamingo pool. Bill's guests simply show their room key for access.

For Reservations Call: 866-BILLS-45 (866-245-5745)

Join the Bill's interest fist. Sign up here:

First Name

Last Name

E-Mail

601

Hotel | Casino | Dinling | Entertairment | Employee of | Control | Media Conte

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EXHIBIT B

Social Security Online

Social Security Administration



Popular Baby Names

Social Security Information for Parents and Guardians

Baby's First Number -A Social Security Number

Benefits for Children

Benefits for Grandchildren

What Every Parent Should Know About Social Security

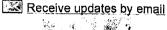
Plan Your Family's Financial Security

Calculate Your
Retirement Benefits

Future Financial Status of Social Security

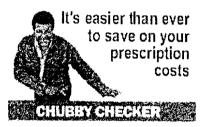
Top 10 Names for 2009

Rank	Male name	Female name
1	Jacob	Isabella
2	Ethan	Emma
3	Michael	Olivia
4	Alexander	Sophia
5	William	Ava
6	Joshua	Emily
7	Daniel	Madison
8	Jayden	Abigail
9	Noah	Chloe
10	Anthony	Mia





Chubby Checker Announces the Top Baby Names of the Decade



Baby Name Data

Change in popularity

Popular names...

by decade

by State

for twins

in U.S. territories

Top 5 names over the last 100 years

Background Information

Other Sites of Interest

Healthy Pregnancy Caring for Your Newborn Childhood

Popular Names by Birth Year

For a list of the most popular names for a particular year of birth (any year after 1879), enter the year and the length of the popularity list.

Enter year of birth

.Go

Popularity

Reset

Name rankings may include:

- Percent of total births
- Number of births

Popularity of a Name

See how the popularity of a name has changed over time!

Name?

Ģo

Do not use spaces, hyphens, or other nonalphabetic characters in the name.

Reset

Sex associated with name C Male C Female None

Number of years? 0

Immunizations Child Safety Publications Food Stamps and WIC

Infant/child Product Recalls Toy Hazard Recalls Other Resources