ESTTA Tracking number: **ESTTA403714**
Filing date: **04/14/2011**

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

Proceeding	77820681
Applicant	Rock Communications Ltd.
Applied for Mark	CATCHFIRE MEDIA
Correspondence Address	WENDY K MARSH NYEMASTER GOODE WEST HANSELL ET AL 700 WALNUT STREET, SUITE 1600 DES MOINES, IA 50309-3800 UNITED STATES ptodm@nyemaster.com
Submission	Reply Brief
Attachments	CATCHFIRE MEDIA reply brief.pdf (7 pages)(102623 bytes)
Filer's Name	Wendy K. Marsh
Filer's e-mail	wkmarsh@nyemaster.com, ptodm@nyemaster.com
Signature	/wendy k. marsh/
Date	04/14/2011

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

IN RE: Rock Communications Ltd. SERIAL NO: 77/820,681 MARK: CATCHFIRE MEDIA FILED: September 4, 2009 LAW OFFICE: 109	Appeal No. 373649

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

REPLY BRIEF

TABLE OF CONTENTS

I. ARGUMENT.....1

A. The Examining Attorney has Not Provided Sufficient Evidence to Demonstrate that the Services of the Marks are Sufficiently Related.....1

B. The Examining Attorney's Refusal to Give Appellant's Third Party Evidence Any Weight is Legally Unsupported 2

1. Evidence of Third Party Use is Directly Relevant to the Sixth *du Pont* Factor.....2

2. Evidence of Third Party *Use* is Entitled to More Legal Weight than Evidence of Third Party Registrations.....3

II. CONCLUSION 4

TABLE OF AUTHORITIES

Cases

Fort Howard Paper Co. v. Kimberly-Clark Corp., 221 U.S.P.Q.2d 732 (T.T.A.B. 1984) ...3

In re Broadway Chicken Inc., 38 U.S.P.Q.2d 1559 (T.T.A.B. 1996) 3

In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) 2, 3

Jacobs v. International Multifoods Corp., 668 F.2d 1234 (C.C.P.A. 1982).....1

Lloyd's Food Products, Inc. v. Eli's, Inc., 987 F.2d 766 (Fed. Cir. 1993) 3

Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 U.S.P.Q.2d 1689 (Fed. Cir. 2005) 2

Statutes

37 C.F.R. § 2.142 1

Other Authorities

T.M.E.P. § 1207.01(d)(iii) 3

2

Dear Sir:

Please enter the following Reply Brief into the record. It responds to arguments made in the Examining Attorney's Appeal Brief dated March 30, 2011. As such its entry is proper under 37 C.F.R. § 2.142.

I. ARGUMENT

A. The Examining Attorney has Not Provided Sufficient Evidence to Demonstrate that the Services of the Marks are Sufficiently Related

A substantial part of the Examining Attorney's determination of likelihood of confusion is based upon the conclusion that the "advertising agency services" of the '064 mark are sufficiently related to the "social media strategy consultation" services of Appellant's mark such that the use of a similar mark for each would suggest to consumers that the two have a common source. For the following reasons, the Examining Attorney has not demonstrated that the services are sufficiently related.

The predecessor to the Federal Circuit held that the fact that restaurants serve food and beverages was not enough to render food and beverages "related" to restaurant services for purposes of determining likelihood of confusion. *Jacobs v. International Multifoods Corp*., 668 F.2d 1234, 1236 (CCPA 1982). Instead, *Jacobs* provides that "[t]o establish likelihood of confusion a party must show <u>something more</u> than that similar or even identical marks are used for food products and for restaurant services." *Id.* (emphasis added).

Appellant would respectfully submit that the "something more" requirement of *Jacobs* should also apply to the Examining Attorney's assertion that the advertising agency services of the '064 mark and the social media strategy consultation services should be considered highly related. While the evidence produced by the Examining Attorney shows that eight advertising

agencies also provide social media consulting services, the evidence does not support the Examining Attorney's conclusion that consumers are likely to conclude that advertising agencies and social media consulting firms with similar marks emanate from the same source. It is also notable that the Examining Attorney has provided no evidence or suggestion that the owner of the '064 registration actually provides social media consulting services under the '064 mark.

For these reasons, in addition to those set forth in Appellant's main brief, in evaluating the similarity between the '064 registration and Appellant's mark in terms of appearance, sound, connotation, and commercial impressions, it is respectfully submitted that the Examining Attorney's conclusion that the '064 mark and Appellant's mark are similar is not sufficiently supported.

B. The Examining Attorney's Refusal to Give Appellant's Third Party Evidence Any Weight is Legally Unsupported

The Examining Attorney asserts that Appellant's evidence of third party use "is not persuasive." (Examining Attorney's Brief, p. 11). In fact, the Examining Attorney's statement that Appellant's evidence was considered but deemed "not persuasive" does not reflect the reality that the Examining Attorney failed to give Appellant's third party use evidence <u>any</u> weight in the likelihood of confusion analysis. The Examining Attorney's failure to properly consider this evidence, however, runs directly contrary to established Federal Circuit law.

1. <u>Evidence of Third Party Use is Directly Relevant to the Sixth *du Pont* Factor</u>

TMEP Section 1207.01(d)(iii) provides that evidence of third-party use qualifies as evidence under the sixth *du Pont* factor, namely, the "number and nature of similar marks in use on similar goods." *In re E. I. du Pont de Nemours & Co*., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). More particularly, if the evidence establishes that the consuming

public is exposed to third-party use of similar marks on similar goods, this evidence "is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Id.; see also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005).

2. Evidence of Third Party *Use* is Entitled to More Legal Weight than Evidence of Third Party Registrations

The Examining Attorney argues that Appellant's third party evidence, "should be given little weight since these uses do not involve actual trademark registrations." (Examining Attorney's brief, p. 11). Ironically, though, the Board has held that evidence of search reports listing marks and registrations are "incompetent by themselves to prove that those marks and trade names are in use of that the public is exposed to them." *Lloyd's Food Products, Inc. v. Eli's, Inc*., 987 F.2d 766, 768 (Fed. Cir. 1993); *see also Fort Howard Paper Co. v. Kimberly-Clark Corp*., 221 USPQ 732 (TTAB 1984). Instead, third-party registrations are only relevant for showing, "that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services." TMEP § 1207.01(d)(iii).

Thus, contrary to the Examining Attorney's contention, Appellant's evidence of actual third party use of "CATCHFIRE" in conjunction with services which the Examining Attorney has already conceded are as related to those of Appellant's "CATCHFIRE MEDIA" mark as those of the '064 registration, is actually more relevant in the Section 2(d) analysis than would be federal trademark registrations.

The Examining Attorney also cannot discard Appellant's third party evidence in view of *In re Broadway Chicken Inc*., 38 USPQ2d 1559 (TTAB 1996) simply because the quantity of

previous uses of "CATCHFIRE" for marketing-type services does not match that of the 9 million plus uses of "BROADWAY" for restaurant services found by the applicant in that case. *Broadway Chicken* is distinguishable on the basis that "BROADWAY" is obviously a well known and frequently used term for many different goods and services in many fields, versus the less well known term "CATCHFIRE." In this respect, Appellant would argue that since there are a relatively large number of prior third party uses of "CATCHFIRE" for services the Examining Attorney considers "highly similar" to that of Appellant's should be considered especially probative towards demonstrating that consumers in the relevant industry will not necessarily associate the Appellant's social media services with the advertising agency services of the '064 registration, both due to the differences in their respective services as well as the differences in their respective wordings.

II. CONCLUSION

For all of the foregoing reasons, Appellant respectfully requests that the Board reverse the Examining Attorney's refusal to register CATCHFIRE MEDIA.

Respectfully submitted,

/wendy k. marsh/

Wendy K. Marsh
NYEMASTER, GOODE, WEST, HANSELL
& O'BRIEN, P.C.
700 Walnut Street, Suite 1600
Des Moines, IA 50309
Phone: 515-645-5502
Fax: 515-283-8045
Email: wkmarsh@nyemaster.com

ATTORNEY FOR APPELLANT