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

Proceeding	77826338
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Serial No.:** 77/826,338  
**Applicant:** Macor, Janet  
**Mark:** BEREAN COMMUNICATIONS  
**Filed:** September 15, 2009

**BEFORE THE TRADEMARK TRIAL AND  
APPEAL BOARD ON APPEAL**

**APPLICANT’S APPEAL BRIEF**

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**DESCRIPTION OF THE RECORD**

Applicant’s trademark application was filed on September 15, 2009, on an actual use basis under Section 1(a) of the Trademark Act. In its Response to the first Office Action filed on January 28, 2010, Applicant amended the trademark application to an intent-to-use basis under Section 1(b) of the Trademark Act.

A final Office Action issued on March 25, 2010, maintained and made final the Examiner’s initial refusal to register Applicant’s trademark under Section 2(d) of the Trademark Act on the grounds of likelihood of confusion with U.S. Registration Nos. 3,118,732 and 3,118,733. All other issues or

requirements raised by the Examiner in the first Office Action issued on December 16, 2009, were either withdrawn by the Examiner or complied with by the Applicant and entered on the record in the final Office Action. No new issues or requirements were raised by the Examiner in the final Office Action.

Applicant filed a Request for Reconsideration on June 29, 2010, which was denied by the Examiner on July 20, 2010. In the denial, the Examiner maintained the refusal to register Applicant's trademark on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act with U.S. Registration Nos. 3,118,732 and 3,118,733.

Applicant timely filed a Notice of Appeal on August 2, 2010. Applicant appeals the Examiner's refusal to register Applicant's trademark for use with writing of texts in Class 041 on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act with U.S. Registration Nos. 3,118,732 and 3,118,733.

#### **STATEMENT OF THE ISSUES**

There is one issue pending in the application:

Is the Examiner's refusal to register Applicant's trademark BEREAN COMMUNICATIONS & Design on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act with Registrant's trademarks BEREAN CHURCH OF GOD INTERNATIONAL (3,118,732), and THE BEREAN CHURCH OF GOD INTERNATIONAL & Design (3,118,733) factually and legally supported?

#### **RECITATION OF THE FACTS**

Applicant's mark is BEREAN COMMUNICATIONS & Design for use in conjunction with writing texts in Class 041. Applicant's mark as submitted with the application is:



Both of the registered marks cited by the Examiner in support of the refusal to register are owned by Berean Church of God International Limited, a Jamaican not-for-profit corporation. Information regarding each of the cited, registered marks is set forth below.

U.S. Registration 3,118,732 is for BEREAN CHURCH OF GOD INTERNATIONAL (word mark) for use in conjunction with providing newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics, in Class 041; and for use in conjunction with evangelistic and ministerial services; establishment of the religious life of churches; providing information via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics, in Class 045. Registrant's mark as shown on the registration is:

### **BEREAN CHURCH OF GOD INTERNATIONAL**

U.S. Registration 3,118,733 is for THE BEREAN CHURCH OF GOD INTERNATIONAL & Design for use in conjunction with providing newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics, in Class 041; and for use in conjunction with evangelistic and ministerial services; establishment of the religious life of churches; providing information via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics, in Class 045. Registrant's mark as shown on the registration is:



The Examiner issued and maintained a refusal to register Applicant's trademark, BEREAN COMMUNICATIONS & Design, on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act with Registrant's trademarks BEREAN CHURCH OF GOD INTERNATIONAL and THE BEREAN CHURCH OF GOD INTERNATIONAL & Design. The Examiner's position in support

of the refusal to register is: (1) the marks are similar in their appearance, sound, meaning or connotation, and commercial impression; (2) the goods and/or services are highly related, and (3) the trade channels of the goods and/or services are similar.

## **ARGUMENT**

Applicant refutes the Examiner's position and asserts that Applicant's mark and Registrant's marks: (1) are not similar in their appearance, sound, meaning or connotation, and commercial impression; (2) are not used with highly related goods and/or services; and (3) do not have similar trade channels of the goods and/or services. Therefore, Applicant respectfully submits that there is no likelihood of confusion between Applicant's mark and Registrant's marks and requests that the Trademark Trial and Appeal Board reverse the refusal to register and remand Applicant's trademark application to the Examiner for approval for registration.

### **I. The Marks Are Not Similar in Their Appearance, Sound, Meaning or Connotation, and Commercial Impression**

#### **A. The Term BEREAN Is Descriptive**

Although third-party trademark registrations are to be given little weight in evaluating whether there is a likelihood of confusion [*AMF Incorporated v. American Leisure Products, Inc.*, 474 F.2d 1403, 1406 (Fed. Cir. 1973)], evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection [*Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005)], and third-party usage can demonstrate the ordinary dictionary meaning of a term or the meaning of a term to those in the trade [*Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669 (Fed. Cir. 1984)].

During prosecution, the Examiner and the Applicant both provided third-party evidence that the term BEREAN is descriptive. In the first Office Action the Examiner required that Applicant disclaim the term BEREAN on the basis that BEREAN is descriptive and refers to a type or following of Christianity. The Examiner cited as evidence in support thereof a Wikipedia entry for Bereans. Applicant made the required disclaimer in its Response to the first Office Action during prosecution and by doing so, as held

by *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1988), Applicant has conceded that the term BEREAN is descriptive as applied to a type or following of Christianity. See also *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985) (A disclaimer of a part of a composite mark is a concession that that part is descriptive.).

In addition to the disclaimer, Applicant provided in its Request for Reconsideration further third-party evidence that the term BEREAN is descriptive. This third-party evidence included Application Serial No. 77/776,052 for THE BEREAN APPROACH, in which the US Trademark Office also required the term BEREAN to be disclaimed, on the basis that the term is descriptive of the subject matter of the services, namely, religious instruction based on Berean religious principles. In support thereof, the US Trademark Office cited as evidence a Wikipedia entry for Bereans. The required disclaimer also was made in this third-party application. See attached Exhibit D, page 8.<sup>[1]</sup>

As additional support that the term BEREAN is descriptive, Applicant provided third-party evidence that on the rolls of the US Trademark Office there are nine live applications or registrations of five different owners which incorporate the descriptive term BEREAN. See Exhibit A to Request for Reconsideration and attached Exhibit E<sup>[1]</sup>. The descriptive term BEREAN is used not only with religious connotation, but also is used in conjunction with secular goods and services. For example, the mark BEREAN GROUP INTERNATIONAL, INC. & Design, Registration 3,243,370, is used in conjunction with IT staffing services. See Exhibit C to Request for Reconsideration.

As further support that the term BEREAN is descriptive, Applicant provided evidence that even Registrant conceded, in the course of prosecuting its trademark applications, that the term BEREAN is descriptive. On its prosecution records (See attached Exhibit F<sup>[1]</sup>, page 6, paragraphs 2 and 3; and attached Exhibit G<sup>[1]</sup>, page 6, paragraphs 2 and 3), Registrant stated:

“[I]t must be noted that the term BEREAN is highly suggestive in the Christian community, and therefore not an entirely distinctive word. The name “Berean” refers to a group of Christians described in the New Testament as being of “noble character”:

*Now the Bereans were of more noble character than the Thessalonians, for they received the message with great eagerness and examined the Scriptures every day to see if what Paul said was true. Acts 17:11.”*

The Examiner refused to consider this evidence of descriptiveness from Registrant’s prosecution records on the grounds that during *ex parte* prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registrations. The Examiner further stated that the validity of the registrations cannot be ignored “regardless of the fact that applicant has evidence that the wording is used in connection with a specific Christian denomination.” See final Office Action, section titled *Applicant’s Arguments*, paragraphs 2 and 3.

The Examiner also stated that no disclaimer of the term BEREAN was made by Registrant and, therefore, the term BEREAN is not descriptive. See Request for Reconsideration Denied, issued July 20, 2010, paragraph 3. However, the question is whether, at the time the issue of likelihood of confusion is being resolved, the public considers certain words to be descriptive, even though no disclaimer was made when the mark was registered. *In re National Data Corp.*, 224 USPQ 749, 751-752; 753 F.2d 1056 (Fed. Cir. 1985).

The Examiner’s refusal to consider the evidence and classifying it as a collateral attack by Applicant on Registrant’s registrations is in error. The registration affords prima facie rights in the mark *as a whole* (emphasis in original), not in any component; thus, a showing of descriptiveness of a *part* (emphasis in original) of a mark does not constitute an attack on the registration. *In re National Data Corp.*, 224 USPQ 749, 752; 753 F.2d 1056 (Fed. Cir. 1985). Applicant is entitled to show that the term BEREAN in Registrant’s marks is descriptive and the proof was improperly disregarded by the Examiner on the ground that the registration cannot be attacked in an *ex parte* decision.

Applicant is not making a collateral attack on the validity of Registrant’s registrations, but rather is presenting Registrant’s prosecution record as further evidence that the term BEREAN is descriptive, as recognized by third parties, including Registrant, in the Christian community. The evidence of third-party

use, including use by Registrant, of BEREAN as a descriptive term is properly provided by Applicant and must be considered as evidence that demonstrates the meaning of a term to those in the trade [*Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669 (Fed. Cir. 1984)], namely, in this particular instance, the Christian community.

Applicant's assertion that BEREAN is a descriptive term is supported by the evidence, namely, recognition in the Christian community and by the actions of the US Trademark Office, which includes: (1) the Examiner's statement that the term BEREAN is descriptive and must be disclaimed (See first Office Action, *Requirement: Disclaimer of Descriptive Wording* section, paragraph 1); (2) Applicant's disclaimer; (3) disclaimer by another applicant; and (4) Registrant's prosecution records. Therefore, the term BEREAN is descriptive.

**B. Descriptive Terms Are Non-Exclusive**

All competitors have a right to use descriptive terms. Descriptive designations are regarded as being in the "public domain" only in the sense that all sellers must be free to truthfully use descriptive designations. *Minnesota Mining & Mfg. CO. v. Johnson & Johnson*, 454 F.2d 1179, 172 USPQ 491 (CCPA 1972). That is, others are entitled to compete fairly by describing their goods and services in order to inform consumers. The First Circuit held in *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 87 USPQ2d 1385, 531 F.3d 1 (1<sup>st</sup> Cir. 2008), that "competitors unable to use a common term that describes or designates their product are at a significant disadvantage communicating to potential customers the nature and characteristics of the product." Additionally, the common name of a religion cannot be appropriated by one party from the public domain and somehow gain an exclusive right to its use and the right to prevent others from using it. *Christian Science Bd. of Directors of First Church of Christ, Scientist v. Evans*, 2 USPQ2d 1093, 105 N.J. 297, 520 A.2d 1347 (N.J. 1987).

For any trademark user wishing to convey to its consumers the relation of its goods and services to a particular religious affinity or doctrine, the only practical and viable way to do so is to use a term which states what that religious affinity or doctrine is: Berean, Baptist, Catholic, Jewish, etc. Accordingly,

it is inescapable to these trademark users that their marks incorporate the same descriptive term.

Trademark law permits multiple users to use the same descriptive terms, including descriptive terms for religious affinities or doctrines, in their respective marks. Therefore, Registrant's use of the descriptive term BEREAN is non-exclusive and may be used by others, including Applicant, in their trademarks.

### **C. Descriptive Terms Do Not Confuse Consumers**

In support of the refusal to register, the Examiner has placed great weight on a single, descriptive word component of Applicant's and Registrant's marks, the term BEREAN. The Examiner's position is that the "dominant (first, non-design) portion of applicant's mark is identical to the dominant (first, non-descriptive, non-design) portion of registrant's marks." See second Office Action, *Comparison of Marks* section, paragraph 6.

Applicant does not dispute that the first word in both Applicant's and Registrant's marks is the term BEREAN (excluding the article 'The' as the actual first word in U.S. Registration No. 3,118,733). The Examiner cites *In re National Data Corp.*, 224 USPQ 749, 753 F.2d 1056 (Fed. Cir. 1985) in support of her assertion that in comparing the marks in their entireties, nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression and that greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. The Examiner's assertion of and reliance on a descriptive term as a dominant element of the marks is in error and not supportable.

The Examiner's conclusion that Applicant's and Registrant's marks are confusingly similar rests solely on the descriptive term BEREAN which forms a part of both Applicant's and Registrant's marks. However, the Examiner may not compare only the common, descriptive term BEREAN in each mark and end the analysis, but rather must examine the entire mark. It is improper for the Examiner to assume that Applicant's mark is confusingly similar to Registrant's marks simply because Applicant's mark contains the same descriptive term BEREAN.

First, Applicant refutes the Examiner's assertion that the term BEREAN is non-descriptive. As established by Applicant on the prosecution record and herein, the term BEREAN is a descriptive term.

Second, Applicant refutes the Examiner's assertion that the term BEREAN is dominant. The entirety of the opinion of *In re National Data Corp.*, 224 USPQ 749, 753 F.2d 1056 (Fed. Cir. 1985) must be considered, in which the Federal Circuit also held that a descriptive or generic portion of a composite mark is to be given less weight on the rationale that the public will look to other portions of the marks and will not be confused unless the other portions are similar.

“The precedential decisions which have stated that a descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion reflect the reality of the market place. Where consumers are faced with various usages of descriptive words, our experience tells us that we and other consumers distinguish between these usages. Some usages will be recognized as ordinary descriptive speech. Where a descriptive term forms part of two or more marks for related products, as in some of the cited cases, the decisions recognize that the purchasing public has become conditioned to this frequent marketing situation and will not be diverted from selecting what is wanted *unless the overall combinations have other commonality* (emphasis added). In a sense, the public can be said to rely more on the non-descriptive portion of each mark.” *In re National Data Corp.*, 224 USPQ 749, 752; 753 F.2d 1056 (Fed. Cir. 1985).

Therefore, descriptive terms are not dominant and are to be given less weight in a comparison of the marks in their entireties for a likelihood of confusion analysis.

In considering the mark as a whole, the Trademark Board may weigh the individual components of the mark to determine the overall impression of the descriptiveness of the mark and its various components. *In re Oppedahl & Larson LLP*, 71 USPQ2d 1370, 373 F.3d 1171 (Fed. Cir. 2004). However, a disclaimer of descriptive terms indicates that those terms are less significant and the other parts of the mark are the dominant parts that will impact most strongly on the ordinary buyer. *In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 105 F.3d 1405 (Fed. Cir. 1997). Third party registrations are probative to

determine a common, weak significance of a part of a composite mark. Such registrations show that the Trademark Office, by registering several marks with such a common segment, recognizes that portions of such composite marks other than the common segment are sufficient to distinguish the marks as a whole and to make confusion unlikely. That is, the presence of such a descriptive weak segment in conflicting composite marks is not per se sufficient to make confusion likely. *Spraying Systems Co. v. Delavan, Inc.*, 19 USPQ2d 1121, 762 F. Supp. 772 (N.D. Ill. 1991); *aff'd*, 24 USPQ2d 1181, 975 F.2d 387 (7<sup>th</sup> Cir. 1992).

If a senior user has not obtained secondary meaning in a non-inherently distinctive mark, then another's use of that mark cannot result in buyer confusion, for buyers do not associate the mark only with the senior user. *Custom Vehicles, Inc. v. Forest River, Inc.*, 81 USPQ2d 1753, 476 F.3d 481 (7<sup>th</sup> Cir. 2007). Registrant has not obtained secondary meaning in the descriptive term BEREAN and, by its own admission on its prosecution record, does not see any likelihood of confusion of its mark with other marks that incorporate the descriptive term BEREAN. On its prosecution records (See Exhibit F, page 6, paragraph 5 and Exhibit G, page 6, last paragraph), Registrant stated:

“[T]he term BEREAN is relatively common and weak in the Christian community so that even minor differences in the marks are sufficient to distinguish them when they are compared in their entirety, not by their individual components.”

If Registrant, as the party potentially to be harmed by Applicant's mark, sees no likelihood of confusion among marks, including its own, incorporating the descriptive term BEREAN, then the Examiner's refusal on the grounds of a likelihood of confusion between Applicant's mark and Registrant's marks cannot be supported merely because both marks have a descriptive term in common.

**D. A Mark with a Weak Portion Has a Narrow Scope of Protection**

It is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as “weak” marks, and the scope of protection extended

to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods. *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975). Moreover, it is well settled that when a mark, or a portion of a mark, is inherently weak, it is entitled to a narrow scope of protection. In other words, when a business adopts a mark incorporating a descriptive term, it assumes the risk that competitors may also use that descriptive term. *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1857 (TTAB 2008).

Because marks, including any suggestive portions thereof, must be considered in their entireties, the mere presence of a common, highly suggestive portion is usually insufficient to support a finding of likelihood of confusion. *Tektronix, Inc. v. Daktronics, Inc.*, 189 USPQ 693, 534 F.2d 915, 916 (CCPA 1976). It is both logical and obvious that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence is with a weak mark there is not the possibility of confusion. *Sure-Fit Products Company v. Saltzson Drapery Company*, 117 USPQ 295, 297 (CCPA 1958).

Registrant's marks contain a portion that is inherently weak, that is the descriptive term BEREAN. As such, Registrant's marks are entitled to a narrow scope of protection. The mere presence of the common, descriptive term BEREAN in Applicant's and Registrant's marks is insufficient to support a finding of likelihood of confusion between the marks. The scope of protection to be extended to Registrant's marks should be limited to the substantially identical notation and aside from the single common term BEREAN, Applicant's mark is completely non-identical to Registrant's marks. Accordingly, Applicant's mark in its entirety does not come close to Registrant's marks in their entireties, and, therefore, Applicant does not violate Registrant's rights and there is no possibility of confusion between their marks.

**E. The Marks Are Different in Appearance, Sound, Meaning or Connotation, and Overall Commercial Impression**

As stated above, the Examiner's determination of a likelihood of confusion between Applicant's mark and Registrant's marks was weighted heavily on the basis of one descriptive term which the marks had in common: BEREAN. To place great emphasis on a descriptive term as being dispositive of a likelihood of confusion is in direct contradiction of the established case law as cited above.

Applicant's mark and Registrant's mark are different in sound. Registrant's marks consist of five terms with 11 syllables (Registration No. 3,118,732) and six terms with 12 syllables (Registration No. 3,118,733) respectively, namely:

BEREAN CHURCH OF GOD INTERNATIONAL

and

THE BEREAN CHURCH OF GOD INTERNATIONAL.

In contrast, Applicant's mark consists of two terms with eight syllables:

BEREAN COMMUNICATIONS.

Applicant's mark and Registrant's marks are dissimilar in sound. When one speaks the marks aloud, it is readily apparent that, aside from the one common descriptive term BEREAN, the marks sound completely different.

As shown above and stated previously, aside from the one common descriptive term BEREAN, Applicant's mark and Registrant's marks are different in appearance, not only as word marks (two words versus five and six words, respectively), but also notably so as word and design marks. When the design component is taken into consideration in comparing the marks in their entireties, it is readily apparent that Applicant's mark is in color, rectilinear in overall shape, dominated by a graphic element consisting of a large black rectangular block having a red cross within a white starburst superimposed on the right side thereof, and shows the words 'berean communication' in gold, lowercase lettering underneath the graphic element, wherein the red cross graphic element also serves as the letter 't' in the word 'communication.'

In sharp contrast, Registrant's word and design mark is black and white, circular in overall shape, dominated by a graphic of a globe with a bible superimposed thereon, which in turn has a cross superimposed thereon, and the words 'THE BEREAN CHURCH OF GOD INTERNATIONAL' in uppercase lettering and clockwise encircling the graphic element.

It is a well-settled principle of trademark law that in determining likelihood of confusion, the marks must be considered in their entirety. *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563, 476 F.2d 1357, 1361 (CCPA 1973). It is the overall commercial impression of the marks that must be compared, not individual components. The Federal Circuit has stated, "It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion." *Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 USPQ 272, 492 F.2d 1399 (Fed. Cir. 1974); *In re National Data Corp.*, 224 USPQ 749, 753 F.2d 1056 (Fed. Cir. 1985). Rather than consider similarities between component parts of the marks in determining similarity, one must evaluate the impression that each mark in its entirety is likely to have on the purchaser exercising attention usually given by purchasers of such products. *Duluth News-Tribune, Inc. v. Mesabi Publishing Company*, 38 USPQ2d 1937, 84 F.3d 1093 (8<sup>th</sup> Cir. 1996).

Applicant's mark and Registrant's marks are different in meaning or connotation. It is readily apparent that Applicant's mark has only one descriptive term, BEREAN, in common with the Registrant's marks. Further, the remaining term in Applicant's mark, COMMUNICATIONS, has no commonality of meaning with the other primary terms of Registrant's marks, namely, CHURCH, GOD, and INTERNATIONAL. When Applicant's and Registrant's marks are regarded as a whole, they are not similar in appearance, sound, meaning or connotation, and overall commercial impression, but rather give distinct and separate impressions and, therefore, consumers are highly unlikely to be confused.

Consumers would perceive and be impressed that Applicant's mark is related to some sort of means of communication and that Registrant's marks are related to a church. A means of communication and a church are different terms with disparate, unrelated connotations. Two marks, when viewed in their

entireties, that are dissimilar in terms of connotation and overall commercial impression outweighs any similarity that results from the presence of a common descriptive term. *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1858 (TTAB 2008) (SPORTSMAN'S WAREHOUSE is not confusingly similar to BASS PRO SHOPS SPORTSMAN'S WAREHOUSE). This is the exact situation at hand, aside from the common, descriptive term BEREAN in each of the marks, Applicant's and Registrant's marks are not similar in appearance, sound, meaning or connotation, and overall commercial impression, and, thus, there is no likelihood of confusion.

## **II. The Goods and/or Services Are Not Highly Related**

The Examiner acknowledges that Registrant doesn't provide the same services as Applicant. Rather the Examiner speculates that Registrant may expand into the same services as Applicant, because third parties use in conjunction with their trademarks a combination of services which are the same as or similar to the services of Applicant and Registrant.

Despite how third parties use their marks and how Registrant may, but does not, use its marks, the reality is that Registrant's marks and Applicant's mark are dissimilar in the services offered therewith. Registrant's marks are used with ministerial services and the provision of newsletters that are specifically targeted to its own membership and which concern internal communications on its own behalf. Registrant's newsletter specimen submitted with its applications makes this distinction clear. See Exhibit B to Request for Reconsideration. In stark contrast, Applicant's services are the writing of texts which is an external service directed to third parties. These are completely different services and modes of communication which are directed toward completely disparate channels of trade—internal membership versus the external marketplace.

Indeed, Registrant's position on its prosecution record supports its mark as indicative of church services. Registrant argued in support of its registrations by describing its services as "those of a church and church network: evangelism, ministry, assistance in establishment of new churches, and the provision of church-related information on the web" and that the descriptive terms in its mark—CHURCH OF

GOD INTERNATIONAL—help the consumer to see immediately that Registrant’s mark is used to identify church services. Registrant also argued that its consumers go to churches “to receive spiritual ministry—to worship, pray, listen to sermons, and receive spiritual guidance.” Registrant further argued that its services are provided through churches which “are nonprofit entities generally located on their own properties” and that churches “do not advertise, but attract members primarily through word of mouth based on the quality of the preaching, the services and outreach programs, and the benefits of membership.” See Exhibit F, page 2, last paragraph; page 5, paragraph 4; page 3, paragraph 1; page 2, paragraph 2; and Exhibit G, page 2, last paragraph; page 5, paragraph 4; page 3, paragraph 1; page 2, paragraph 2. Applicant asserts that Registrant’s newsletter registered in Class 045 is exemplary only of Registrant’s provision of church services and church-related information on the web and is not at all related to Applicant’s services of writing texts.

### **III. The Trade Channels of the Goods and/or Services Are Not Similar**

As stated above in Section II, Registrant’s marks and Applicant’s mark are dissimilar in channels of trade—Registrant’s internal membership versus the external marketplace to which Applicant offers its services. The fact that these separate channels of trade both appeal to those of a particular religious affinity does not make the channels of trade similar.

Choice of religious affiliation by an individual is not undertaken lightly and, therefore, consumers of religiously affiliated goods and services may be considered sophisticated purchasers. Consumers do not think that any and all goods and services identified by a mark which incorporates a descriptive term such as BEREAN all originate from the same source. Accordingly, consumers will not be confused into thinking that any and all goods or services, whether same or similar, bearing a mark incorporating the descriptive term BEREAN, and which travel in the separate channels of trade originate from the same source. Therefore, consumers will not confuse Applicant’s mark with Registrant’s marks.

## SUMMARY

Applicant asserts that: (1) its mark and Registrant's marks are dissimilar in appearance, sound, meaning or connotation, and commercial impression; (2) their respective goods and services are dissimilar; and (3) their respective channels of trade are separate and dissimilar. The dissimilarity of Applicant's and Registrant's marks is a single dispositive factor and sufficient basis on which to conclude that Applicant's mark is not likely to be confused with Registrant's marks. Applicant's and Registrant's dissimilarities of services and trade channels are additional, cumulative factors which further support a conclusion that Applicant's mark is not likely to be confused with Registrant's marks.

As held in *Odom's Tennessee Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343 (Fed. Cir. 2010), a single *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks. Therefore, even if all other relevant *DuPont* factors are considered in favor of the senior user, the dissimilarity of the marks is sufficient basis to conclude that no confusion is likely.

Therefore, Applicant respectfully submits that there is no likelihood of confusion between Applicant's mark and Registrant's marks. Having rebutted the refusal to register on the grounds of likelihood of confusion, Applicant requests that the Trademark Trial and Appeal Board reverse the refusal to register and remand Applicant's trademark application to the Examiner for approval for registration.

Respectfully submitted this 1<sup>st</sup> day of October 2010,

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## FOOTNOTE

[1] Applicant provided during prosecution a listing, but did not submit copies, of the referenced applications and registrations in its Response to the first Office Action. Copies of the referenced applications and registrations are submitted with Applicant's Appeal Brief as Exhibit E.

Applicant also referenced during prosecution, but did not submit copies of, the third-party trademark application documentation referenced in its Response to first Office Action (Exhibit D) and Request for Reconsideration (Exhibit F and Exhibit G). Copies of the referenced third-party trademark application documentation are submitted with Applicant's Appeal Brief as Exhibit D, Exhibit F and Exhibit G. During prosecution, Applicant erroneously identified Exhibit F and Exhibit G as being dated June 23, 2004, and now corrects and notes that Exhibit F and Exhibit G were in fact dated August 3, 2005.

The Examiner did not object to the listing of the referenced applications and registrations or the referenced third-party trademark application documentation during prosecution and did not advise Applicant that the listing or referenced documentation alone was insufficient at a point when Applicant could have corrected the error. Additionally, the Examiner did discuss the listing in the final Office Action and the referenced documentation in the Request for Reconsideration Denied.

Accordingly, the copies of the referenced applications and registrations and the third-party trademark application documentation are timely submitted herewith as Exhibit D, Exhibit E, Exhibit F and Exhibit G and are to be deemed to have been stipulated into the record. *In re Hayes*, 62 USPQ2d 1443, 1445 n.3 (TTAB 2002); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 n.6 (TTAB 1999); *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998); TBMP §1207.03 (Evidence Considered Due to Actions of Nonoffering Party); TBMP §1208.02 (Third-party Registrations).

## INDEX OF CASES

- AMF Incorporated v. American Leisure Products, Inc.*, 474 F.2d 1403 (Fed. Cir. 1973)
- Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844 (TTAB 2008)
- Boston Duck Tours, LP v. Super Duck Tours, LLC*, 87 USPQ2d 1385, 531 F.3d 1 (1<sup>st</sup> Cir. 2008)
- Christian Science Bd. of Directors of First Church of Christ, Scientist v. Evans*, 2 USPQ2d 1093, 105 N.J. 297, 520 A.2d 1347 (N.J. 1987)
- Custom Vehicles, Inc. v. Forest River, Inc.*, 81 USPQ2d 1753, 476 F.3d 481 (7<sup>th</sup> Cir. 2007)
- Duluth News-Tribune, Inc. v. Mesabi Publishing Company*, 38 USPQ2d 1937, 84 F.3d 1093 (8<sup>th</sup> Cir. 1996)
- In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985)
- In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511 (TTAB 2001)
- In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 105 F.3d 1405 (Fed. Cir. 1997)
- In re Dos Padres Inc.*, 49 USPQ2d 1860 (TTAB 1998)
- In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563, 476 F.2d 1357 (CCPA 1973)
- In re Hayes*, 62 USPQ2d 1443 (TTAB 2002)
- In re Hunke & Jochheim*, 185 USPQ 188 (TTAB 1975)
- In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1988)
- In re National Data Corp.*, 224 USPQ 749, 753 F.2d 1056 (Fed. Cir. 1985)
- In re Oppedahl & Larson LLP*, 71 USPQ2d 1370, 373 F.3d 1171 (Fed. Cir. 2004)
- In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537 (TTAB 1998)
- In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999)
- Massey Junior College, Inc. v. Fashion Institute of Technology*, 181 USPQ 272, 492 F.2d 1399 (Fed. Cir. 1974)

*Minnesota Mining & Mfg. CO. v. Johnson & Johnson*, 454 F.2d 1179, 172 USPQ 491 (CCPA 1972)

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*Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669 (Fed. Cir. 1984)

*Spraying Systems Co. v. Delavan, Inc.*, 19 USPQ2d 1121, 762 F. Supp. 772 (N.D. Ill. 1991); *aff'd*, 24 USPQ2d 1181, 975 F.2d 387 (7<sup>th</sup> Cir. 1992)

*Sure-Fit Products Company v. Saltzson Drapery Company*, 117 USPQ 295 (CCPA 1958)

*Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976)



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# The Berean Approach

**Word Mark** THE BEREAN APPROACH  
**Goods and Services** IC 041. US 100 101 107. G & S: Providing on-line religious instruction promoting Christian and family values; Religious instruction services  
**Standard Characters Claimed**  
**Mark Drawing Code** (4) STANDARD CHARACTER MARK  
**Serial Number** 77776052  
**Filing Date** July 7, 2009  
**Current Filing Basis** 1B  
**Original Filing Basis** 1B  
**Owner** (APPLICANT) Byron A. Crenshaw Sr. DBA The Berean Approach INDIVIDUAL UNITED STATES 3610 Woodhaven Court Woodbridge VIRGINIA 22192  
**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEREAN" APART FROM THE MARK AS SHOWN  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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**To:** Byron A. Crenshaw Sr. ([bacshaw@msn.com](mailto:bacshaw@msn.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77776052 - THE BEREAN APPROACH - N/A  
**Sent:** 4/24/2010 9:07:55 PM  
**Sent As:** ECOM115@USPTO.GOV  
**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/776052

**MARK:** THE BEREAN APPROACH

**\*77776052\***

**CORRESPONDENT ADDRESS:**

BYRON A. CRENSHAW SR.  
3610 WOODHAVEN CT  
WOODBIDGE, VA 22192-6405

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** Byron A. Crenshaw Sr.

**CORRESPONDENT'S REFERENCE/DOCKET**

**NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

[bacshaw@msn.com](mailto:bacshaw@msn.com)

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE:** 4/24/2010

**THIS IS A FINAL ACTION.**

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. For a complete

list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. Responding by telephone to authorize an examiner's amendment will not incur this additional fee.

This letter responds to the applicant's communication filed on March 31, 2010. The applicant's disclaimer is accepted and made of record.

Registration was refused under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the mark for which registration is sought so resembles the mark shown in U.S. Registration No. 1020732 as to be likely, when used on the identified goods/services, to cause confusion, or to cause mistake, or to deceive.

The applicant failed to provide any arguments or evidence to dispute the refusal under Section 2(d). For the reasons below, the refusal under Section 2(d) is maintained and made FINAL.

#### Section 2(d) Refusal – Likelihood of Confusion

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Applicant seeks to register the proposed mark BEREAN APPROACH. The cited registration is for the mark BEREAN. These marks are quite similar because they share the term BEREAN and they create confusingly similar commercial impressions.

The marks are compared in their entireties under a Trademark Act Section 2(d) analysis. *See* TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a

likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); see TMEP §1207.01(b)(viii), (c)(ii).

In the present case, both of the marks are dominated by the term BEREAN. The applicant provided a disclaimer of the term BEREAN because the term appears to describe religious instruction based on Berean principles. Please see evidence attached to the Office Action of October 8, 2009, concerning the meaning of the term BEREAN. The cited registration does not include a disclaimer and was registered on the Principal Register over thirty-five years ago without a claim of acquired distinctiveness under Section 2(f). The term appears to be commonly used to refer to type of religious principal. However, today's apparent descriptive nature of the term does not diminish the trademark holder's right to broad protection of the term. Furthermore, a disclaimer does not remove the disclaimed portion from the mark for the purposes of this analysis. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214 (TTAB 2001); *In re MCI Commc'ns Corp.*, 21 USPQ2d 1534 (Comm'r Pats. 1991); see TMEP §1207.01(b)(viii), (c)(ii). Purchasers are not aware of disclaimers that reside only in the records of the Office.

The applicant's mark uses the additional term APPROACH. The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); *In re Cosvetic Labs., Inc.*, 202 USPQ 842 (TTAB 1979) (HEAD START and HEAD START COSVETIC); TMEP §1207.01(b)(iii).

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); see, e.g., *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Applicant seeks to register its mark for Providing on-line religious instruction promoting Christian and family values; Religious instruction services." Registrant's services are "retail store services featuring the sale of books, religious merchandise and church supplies." These services are closely related because the applicant may utilize the registrant's religious materials for it religious instruction services.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or

services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

In view of all of the foregoing, the refusal pursuant to Trademark Act Section 2(d) is repeated and made FINAL.

#### Proper Response to a Final Action

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Curtis W. French/  
Trademark Attorney  
Law Office 115  
United States Trademark Office  
571-272-9472

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person

signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

**To:** Byron A. Crenshaw Sr. ([bacshaw@msn.com](mailto:bacshaw@msn.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77776052 - THE BEREAN APPROACH - N/A  
**Sent:** 4/24/2010 9:07:59 PM  
**Sent As:** ECOM115@USPTO.GOV  
**Attachments:**

## **IMPORTANT NOTICE REGARDING YOUR TRADEMARK APPLICATION**

Your trademark application (Serial No. 77776052) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office (“USPTO”) has written a letter (an “Office action”) on **4/24/2010** to which you must respond (*unless the Office letter specifically states that no response is required*). Please follow these steps:

1. **Read** the Office letter by clicking on this **link** [http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77776052&doc\\_type=OOA&](http://tmportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77776052&doc_type=OOA&) OR go to <http://tmportal.uspto.gov/external/portal/tow> and enter your serial number to access the Office letter. If you have difficulty accessing the Office letter, contact [TDR@uspto.gov](mailto:TDR@uspto.gov).

**PLEASE NOTE:** The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

2. **Contact** the examining attorney who reviewed your application if you have any questions about the content of the Office letter (contact information appears at the end thereof).

3. **Respond** within 6 months, calculated from **4/24/2010** (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System (TEAS) [Response to Office Action form](#). If you have difficulty using TEAS, contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

### **ALERT:**

Failure to file any required response by the applicable deadline will result in the [ABANDONMENT](#) (loss) of your application.

Do NOT hit “Reply” to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses.

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	77776052
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 115
<b>MARK SECTION (no change)</b>	
<b>ADDITIONAL STATEMENTS SECTION</b>	
<b>DISCLAIMER</b>	No claim is made to the exclusive right to use BEREAN apart from the mark as shown.
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/Byron A. Crenshaw/
<b>SIGNATORY'S NAME</b>	Byron A. Crenshaw
<b>SIGNATORY'S POSITION</b>	Owner
<b>DATE SIGNED</b>	03/31/2010
<b>AUTHORIZED SIGNATORY</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Wed Mar 31 09:15:00 EDT 2010
<b>TEAS STAMP</b>	USPTO/ROA-148.129.71.52-2 0100331091500132693-77776 052-460839510b98be9209638 35f3151f3b67fe-N/A-N/A-20 100331085502198987

## Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **77776052** has been amended as follows:

**ADDITIONAL STATEMENTS**

**Disclaimer**

No claim is made to the exclusive right to use BEREAN apart from the mark as shown.

**SIGNATURE(S)**

**Response Signature**

Signature: /Byron A. Crenshaw/ Date: 03/31/2010

Signatory's Name: Byron A. Crenshaw

Signatory's Position: Owner

The signatory has confirmed that he/she is not represented by either an authorized attorney or Canadian attorney/agent, and that he/she is either (1) the applicant or (2) a person(s) with legal authority to bind the applicant; and if an authorized U.S. attorney or Canadian attorney/agent previously represented him/her in this matter, either he/she has filed a signed revocation of power of attorney with the USPTO or the USPTO has granted the request of his/her prior representative to withdraw.

Serial Number: 77776052

Internet Transmission Date: Wed Mar 31 09:15:00 EDT 2010

TEAS Stamp: USPTO/ROA-148.129.71.52-2010033109150013

2693-77776052-460839510b98be920963835f31

51f3b67fe-N/A-N/A-20100331085502198987

**To:** Byron A. Crenshaw Sr. ([bacshaw@msn.com](mailto:bacshaw@msn.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77776052 - THE BEREAN APPROACH - N/A  
**Sent:** 10/8/2009 2:14:21 PM  
**Sent As:** ECOM115@USPTO.GOV  
**Attachments:** Attachment - 1  
Attachment - 2  
Attachment - 3

## UNITED STATES PATENT AND TRADEMARK OFFICE

**SERIAL NO:** 77/776052

**MARK:** THE BEREAN APPROACH

**\*77776052\***

**CORRESPONDENT ADDRESS:**

BYRON A. CRENSHAW SR.  
3610 WOODHAVEN CT  
WOODBIDGE, VA 22192-6405

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** Byron A. Crenshaw Sr.

**CORRESPONDENT'S REFERENCE/DOCKET**

**NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

[bacshaw@msn.com](mailto:bacshaw@msn.com)

### OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE: 10/8/2009**

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE:  
Applicants who filed their application online using the reduced-fee TEAS Plus application must submit

certain documents electronically. In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and maintain a valid e-mail address. 37 C.F.R. §§2.23(a), (b); TMEP §§819, 819.02(a), (b). Failure to do so will incur an additional fee of \$50 per class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04.

Therefore, applicant must submit the following documents using the Trademark Electronic Application System (TEAS) at <http://www.uspto.gov/teas/index.html>: (1) responses to Office actions; (2) preliminary amendments; (3) changes of correspondence address; (4) changes of owner's address; (5) appointments and revocations of power of attorney; (6) appointments and revocations of domestic representative; (7) amendments to allege use; (8) statements of use; (9) requests for extension of time to file a statement of use; and (10) requests to delete a Trademark Act Section 1(b) basis. If applicant files any of these documents on paper instead of via TEAS, then applicant must also submit the \$50 per class fee. 37 C.F.R. §§2.6(a)(1)(iv), 2.23(a)(1); TMEP §§819.02(b), 819.04. Telephone responses that result in the issuance of an examiner's amendment will not incur this additional fee.

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

#### Section 2(d) Refusal – Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 1020732. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Applicant seeks to register the proposed mark BEREAN APPROACH. The cited registration is for the mark BEREAN. These marks are quite similar because they share the term BEREAN and they create confusingly similar commercial impressions.

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Applicant seeks to register its mark for "Providing on-line religious instruction promoting Christian and family values; Religious instruction services." Registrant's services are "retail store services featuring the sale of books, religious merchandise and church supplies." These services are closely related because the applicant may utilize the registrant's religious materials for its religious instruction services.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant must respond to the requirement(s) set forth below.

#### Disclaimer

Applicant must insert a disclaimer of BEREAN in the application because the term is descriptive of the subject matter of the applicant's services, namely, religious instruction based on Berean religious principles. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). Please see attached definition of the term BEREAN.

The following is the accepted standard format for a disclaimer:

**No claim is made to the exclusive right to use "BEREAN" apart from the mark as shown.**

TMEP §1213.08(a)(i).

If applicant has questions about its application or this Office action, please contact the assigned trademark examining attorney at the telephone number below.

/Curtis W. French/  
Trademark Attorney  
Law Office 115  
United States Trademark Office  
571-272-9472

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

Print: Oct 2, 2009

73015488

**TYPED DRAWING**

**Serial Number**

73015488

**Status**

REGISTERED AND RENEWED

**Word Mark**

BEREAN

**Standard Character Mark**

No

**Registration Number**

1020732

**Date Registered**

1975/09/16

**Type of Mark**

SERVICE MARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(1) TYPED DRAWING

**Owner**

STANDEX INTERNATIONAL CORPORATION CORPORATION DELAWARE 6 MANOR PARKWAY  
SALEM NEW HAMPSHIRE 03079

**Goods/Services**

Class Status -- ACTIVE. IC 042. US 101. G & S: RETAIL STORE  
SERVICES FEATURING THE SALE OF BOOKS, RELIGIOUS MERCHANDISE AND CHURCH  
SUPPLIES. First Use: 1962/00/00. First Use In Commerce: 1967/00/00.

**Filing Date**

1974/03/11

**Examining Attorney**

UNKNOWN

**Attorney of Record**

MATTHEW H. JACOBS



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## Bereans

From Wikipedia, the free encyclopedia  
(Redirected from [Berean](#))

**Bereans** were the inhabitants of the ancient city of Berea, also known in the [Bible](#) as Bereoa and now known as [Veria](#).

### Contents [hide]

- 1 Biblical context
- 2 Historical context
- 3 References
- 4 External links

### Biblical context [edit]

According to the [Book of Acts](#), Chapter 17 verse 11, [Paul of Tarsus](#) and [Silas](#) preached at [Berea](#), and the inhabitants "... received the word with all readiness of mind, and searched the scriptures daily, whether those things were so.<sup>[1]</sup>", and many of them believed.

### Historical context [edit]

Many churches and ministries, predominantly [evangelical Protestant](#) in the [USA](#), that have an emphasis on the [primacy of scripture](#), have adopted the name Berean in allusion to this account. The Catholic Diocese of Lincoln describes one particular affiliation, the Berean Church, as comprising about 60 independent U.S. congregations of similar beliefs with features in common with [Baptists](#), [Methodists](#) and [Presbyterians](#). Their central emphasis on scriptural authority, *sola scriptura*, puts their beliefs in particular conflict with [Roman Catholicism](#) as well as [Eastern Orthodoxy](#).

Historically, the **Bereans** (also called Bereoans, Barclayans or Barclayites) were a Protestant sect following former Scottish [Presbyterian](#) minister [John Barclay](#) (1734-1798). Founded in [Edinburgh](#) in 1773, the Berean Church followed a modified form of [Calvinism](#). It had congregations in [Scotland](#), [London](#) and [Bristol](#), but mainly merged with the [Congregationalists](#) after Barclay's death.

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Some groups among the [Bible Student movement](#) also adopted the name, such as the *Berean Bible Students* and the *Berean Bible Institute*.

A new Protestant Christian group began in the 1850s in the United States under the tutelage of Dr. John Thomas. The name "Christadelphian" was chosen as it is believed that those who believe and obey the Commandments of Christ and the Bible as the inspired word of God, are "Brethren in Christ". The original group split, with one group continuing with the name "The Christadelphians" and the second group adding the word "Berean" to become the "Berean Christadelphians". The word "Berean" was chosen to reflect the words in Acts 17, "These (Berea) were more noble than those in Thessalonica in that they received the word with all readiness of mind and searched the scriptures daily whether those things were so." Christadelphians, and Berean Christadelphians believe in the promises given to Abraham, Isaac, and David concerning the Kingdom of God. They deny the Doctrine of the Trinity, a central tenet of orthodox Christianity, and this refusal to recognize the triune nature of God has resulted in a major impasse between the Christadelphians/Berean Christadelphians and the Protestant, Catholic, and Eastern Orthodox Churches.

## References

[edit]

- ↑ Acts 17:11 King James Bible

*This article incorporates text from the public domain [Easton's Bible Dictionary](#), originally published in 1897.*

- "Bereans" and "John Barclay" in Livingstone, E. A., ed. (2006). *The Concise Oxford Dictionary of the Christian Church*. London: Oxford University Press. ISBN 019861442X.

## External links

[edit]

- The Berean Chronicles
- Berea, *Easton's 1897 Bible Dictionary*
- Bereans, *The Columbia Encyclopedia*, Sixth Edition. 2001.
- Catholic Answers article: "Why the Bereans rejected *sola scriptura*"

Categories: Protestantism



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**To:** Byron A. Crenshaw Sr. ([bacshaw@msn.com](mailto:bacshaw@msn.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77776052 - THE BEREAN APPROACH - N/A  
**Sent:** 10/8/2009 2:14:27 PM  
**Sent As:** ECOM115@USPTO.GOV  
**Attachments:**

## **IMPORTANT NOTICE REGARDING YOUR TRADEMARK APPLICATION**

Your trademark application (Serial No. 77776052) has been reviewed. The examining attorney assigned by the United States Patent and Trademark Office (“USPTO”) has written a letter (an “Office action”) on **10/8/2009** to which you must respond (*unless the Office letter specifically states that no response is required*). Please follow these steps:

1. **Read** the Office letter by clicking on this **link** [http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77776052&doc\\_type=OOA&](http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77776052&doc_type=OOA&) OR go to <http://tportal.uspto.gov/external/portal/tow> and enter your serial number to access the Office letter. If you have difficulty accessing the Office letter, contact [TDR@uspto.gov](mailto:TDR@uspto.gov).

**PLEASE NOTE:** The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

2. **Contact** the examining attorney who reviewed your application if you have any questions about the content of the Office letter (contact information appears at the end thereof).

3. **Respond** within 6 months, calculated from **10/8/2009** (*or sooner if specified in the Office letter*), using the Trademark Electronic Application System (TEAS) [Response to Office Action form](#). If you have difficulty using TEAS, contact [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

### **ALERT:**

Failure to file any required response by the applicable deadline will result in the **ABANDONMENT** (loss) of your application.

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**Word Mark** BEREAN COMMUNICATION  
**Goods and Services** IC 041. US 100 101 107. G & S: Writing of texts. FIRST USE: 20050101. FIRST USE IN COMMERCE: 20090902  
**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS  
**Design Search Code** 01.01.05 - Stars - one or more stars with seven or more points  
 24.13.01 - Cross, Latin (shorter horizontal lines); Latin cross (shorter horizontal lines)  
 26.11.21 - Rectangles that are completely or partially shaded  
 27.03.05 - Objects forming letters or numerals  
**Serial Number** 77826338  
**Filing Date** September 15, 2009  
**Current Filing Basis** 1A;1B  
**Original Filing Basis** 1A  
**Owner** (APPLICANT) Macor, Janet E. INDIVIDUAL CANADA 1265 Friendship Lane West Colorado Springs COLORADO 80904  
**Attorney of Record** Brenda L. Speer  
**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEREAN" OR "COMMUNICATION" APART FROM THE MARK AS SHOWN  
**Description of Mark** The color(s) red, gold, black and white. is/are claimed as a feature of the mark. The mark consists of the wording "BEREAN COMMUNICATION" in gold on a white background with the "T" in "COMMUNICATION" as a stylized red cross within a white star which is within a black rectangle.  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL

**Live/Dead  
Indicator**      **LIVE**

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# The Berean Approach

<b>Word Mark</b>	THE <b>BEREAN</b> APPROACH
<b>Goods and Services</b>	IC 041. US 100 101 107. G & S: Providing on-line religious instruction promoting Christian and family values; Religious instruction services
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	77776052
<b>Filing Date</b>	July 7, 2009
<b>Current Filing Basis</b>	1B
<b>Original Filing Basis</b>	1B
<b>Owner</b>	(APPLICANT) Byron A. Crenshaw Sr. DBA The Berean Approach INDIVIDUAL UNITED STATES 3610 Woodhaven Court Woodbridge VIRGINIA 22192
<b>Disclaimer</b>	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEREAN" APART FROM THE MARK AS SHOWN
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE

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# BEREAN GROUP INTERNATIONAL, INC.

<b>Word Mark</b>	BEREAN GROUP INTERNATIONAL, INC.
<b>Goods and Services</b>	IC 035. US 100 101 102. G & S: IT STAFFING SERVICES. FIRST USE: 20000926. FIRST USE IN COMMERCE: 20000926
<b>Mark Drawing Code</b>	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
<b>Design Search Code</b>	26.01.16 - Circles touching or intersecting 26.01.20 - Circles within a circle 26.01.21 - Circles that are totally or partially shaded. 26.05.09 - Triangles made of geometric figures, objects, humans, plants or animals 26.05.28 - Miscellaneous designs with overall triangular shape; Triangular shape (miscellaneous overall shape) 26.17.13 - Letters or words underlined and/or overlined by one or more strokes or lines; Overlined words or letters; Underlined words or letters
<b>Serial Number</b>	76661664
<b>Filing Date</b>	June 12, 2006
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	March 6, 2007
<b>Registration Number</b>	3243370
<b>Registration Date</b>	May 22, 2007
<b>Owner</b>	(REGISTRANT) BEREAN GROUP INTERNATIONAL, INCORPORATED CORPORATION FLORIDA 1851 NORTHWEST 125TH AVE., STE. 100 PEMBROKE PINES FLORIDA 33028

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GROUP INTERNATIONAL, INC." APART FROM THE MARK AS SHOWN

**Description of Mark** The color(s) gray and black is/are claimed as a feature of the mark. The color black appears in the wording BEREAN GROUP INTERNATIONAL, INCORPORATED and in the design the color grey.

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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**Word Mark** THE BEREAN CHURCH OF GOD INTERNATIONAL

**Goods and Services** IC 041. US 100 101 107. G & S: Providing newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics. FIRST USE: 20021000. FIRST USE IN COMMERCE: 20021000

IC 045. US 100 101. G & S: Evangelistic and ministerial services; establishment of the religious life of churches; providing information via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics. FIRST USE: 19950701. FIRST USE IN COMMERCE: 19950800

**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search Code** 01.07.01 - Globes with outlines of continents  
 20.05.05 - Bibles (open); Books that are open; Cook books (open); Encyclopedias (open)  
 24.13.01 - Cross, Latin (shorter horizontal lines); Latin cross (shorter horizontal lines)  
 26.01.08 - Circles having letters or numerals as a border; Circles having punctuation as a border; Letters, numerals or punctuation forming or bordering the perimeter of a circle

**Serial Number** 76598717

**Filing Date** June 23, 2004

**Current Filing Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** May 2, 2006

**Registration Number** 3118733

**Registration Date** July 25, 2006

**Owner** (REGISTRANT) BEREAN CHURCH OF GOD INTERNATIONAL LIMITED NOT-FOR-PROFIT CORPORATION JAMAICA 22 South Road Kencot, Kingston 10 JAMAICA

**Attorney of Record** Nancy Oliver LeSourd

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE CHURCH OF GOD INTERNATIONAL APART FROM THE MARK AS SHOWN

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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**Word Mark** THE BEREAN CHURCH OF GOD INTERNATIONAL

**Goods and Services** IC 038. US 100 101 104. G & S: Providing online forums for transmission of messages among computer users in the fields of Christianity, religion, theology, spirituality, and ethics. FIRST USE: 19991100. FIRST USE IN COMMERCE: 19991100

**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search Code** 01.07.01 - Globes with outlines of continents  
 20.05.05 - Bibles (open); Books that are open; Cook books (open); Encyclopedias (open)  
 24.13.01 - Cross, Latin (shorter horizontal lines); Latin cross (shorter horizontal lines)  
 26.01.08 - Circles having letters or numerals as a border; Circles having punctuation as a border; Letters, numerals or punctuation forming or bordering the perimeter of a circle

**Serial Number** 76598716

**Filing Date** June 23, 2004

**Current Filing Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** November 1, 2005

**Registration Number** 3047765

**Registration Date** January 24, 2006

**Owner** (REGISTRANT) BEREAN CHURCH OF GOD INTERNATIONAL LIMITED NOT-FOR-PROFIT CORPORATION JAMAICA 22 South Road Kencot, Kingston 10 JAMAICA

**Attorney of Record** Nancy Oliver LeSourd

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE CHURCH OF GOD INTERNATIONAL APART FROM THE MARK AS SHOWN  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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# BEREAN CHURCH OF GOD INTERNATIONAL

**Word Mark** BEREAN CHURCH OF GOD INTERNATIONAL

**Goods and Services** IC 041. US 100 101 107. G & S: Providing newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics. FIRST USE: 20021000. FIRST USE IN COMMERCE: 20021000

IC 045. US 100 101. G & S: Evangelistic and ministerial services; establishment of the religious life of churches; providing information via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics. FIRST USE: 19950700. FIRST USE IN COMMERCE: 19950800

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 76598714

**Filing Date** June 23, 2004

**Current Filing Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** May 2, 2006

**Registration Number** 3118732

**Registration Date** July 25, 2006

**Owner** (REGISTRANT) BEREAN CHURCH OF GOD INTERNATIONAL LIMITED NOT-FOR-PROFIT CORPORATION  
JAMAICA 22 South Road Kencot, Kingston 10 JAMAICA

**Attorney of Record** Nancy Oliver LeSourd

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE CHURCH OF GOD INTERNATIONAL APART FROM THE MARK AS SHOWN

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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# BEREAN CHURCH OF GOD INTERNATIONAL

<b>Word Mark</b>	BEREAN CHURCH OF GOD INTERNATIONAL
<b>Goods and Services</b>	IC 038. US 100 101 104. G & S: Providing online forums for transmission of messages among computer users in the fields of Christianity, religion, theology, spirituality, and ethics. FIRST USE: 19991100. FIRST USE IN COMMERCE: 19991100
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	76598713
<b>Filing Date</b>	June 23, 2004
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	November 1, 2005
<b>Registration Number</b>	3047764
<b>Registration Date</b>	January 24, 2006
<b>Owner</b>	(REGISTRANT) BEREAN CHURCH OF GOD INTERNATIONAL LIMITED NOT-FOR-PROFIT CORPORATION JAMAICA 22 South Road Kencot, Kingston 10 JAMAICA
<b>Attorney of Record</b>	Nancy Oliver LeSourd
<b>Disclaimer</b>	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE CHURCH OF GOD INTERNATIONAL APART FROM THE MARK AS SHOWN
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE

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# BEREAN CHURCH OF GOD

**Word Mark** BEREAN CHURCH OF GOD

**Goods and Services** IC 045. US 100 101. G & S: Evangelistic and ministerial services; establishment of the religious life of churches; providing information via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics. FIRST USE: 19690300. FIRST USE IN COMMERCE: 19720400

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 76598711

**Filing Date** June 23, 2004

**Current Filing Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** May 2, 2006

**Registration Number** 3118731

**Registration Date** July 25, 2006

**Owner** (REGISTRANT) BEREAN CHURCH OF GOD INTERNATIONAL LIMITED NOT-FOR-PROFIT CORPORATION JAMAICA 22 South Road Kencot, Kingston 10 JAMAICA

**Attorney of Record** Nancy Oliver LeSourd

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE CHURCH OF GOD APART FROM THE MARK AS SHOWN

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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Typed Drawing

**Word Mark** BEREAN  
**Goods and Services** IC 042. US 101. G & S: RETAIL STORE SERVICES FEATURING THE SALE OF BOOKS, RELIGIOUS MERCHANDISE AND CHURCH SUPPLIES. FIRST USE: 19620000. FIRST USE IN COMMERCE: 19670000  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 73015488  
**Filing Date** March 11, 1974  
**Current Filing Basis** 1A  
**Original Filing Basis** 1A  
**Registration Number** 1020732  
**Registration Date** September 16, 1975  
**Owner** (REGISTRANT) STANDEX INTERNATIONAL CORPORATION DBA STANDARD PUBLISHING COMPANY CORPORATION OHIO ELM SQUARE ANDOVER MASSACHUSETTS 01810  
(LAST LISTED OWNER) BEREAN CHRISTIAN STORES ENDEAVOR, LLC LIMITED LIABILITY COMPANY CALIFORNIA 9415 MERIDIAN WAY WEST CHESTER OHIO 45069  
**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** MATTHEW H. JACOBS  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20050624.  
**Renewal** 2ND RENEWAL 20050624  
**Live/Dead Indicator** LIVE

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† OF COUNSEL - MCLEAN  
‡ OF COUNSEL - LEESBURG

August 3, 2005

Commissioner for Trademarks  
U.S. Patent & Trademark Office  
Trademark Assistance Center  
AE00C55, Madison East  
600 Dulany Street  
Alexandria, VA 22314

- VIA COURIER -

Re: (1728-009) **BEREAN CHURCH OF GOD INTERNATIONAL™**  
Class 45 (Serial No. 76/598,714)  
Office Action Response  
Law Office 105; Leigh Caroline Case, Examining Attorney

Dear Sir or Madam:

Enclosed please find the response of the Berean Church of God International to the Office Action issued February 4, 2005 by the U.S. Patent & Trademark Office for the above-referenced mark. Please direct any questions to the undersigned.

Respectfully submitted,  
**BEREAN CHURCH OF GOD INTERNATIONAL**

By: *Nancy LeSourd*  
Nancy Oliver LeSourd  
Kenneth E. Liu  
*Attorneys for Applicant*

Enclosure: Response to Office Action

cc: Rev. Carlton Miller

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08-03-2005

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**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

_____ )		
In re Application of	)	
Applicant: Berean Church of God International	)	Law Office: 105
Serial No.: 76/598,714	)	
Class: 45	)	Examining Attorney:
Date Filed: 6/23/04	)	Leigh Caroline Case
Mark: <b>BEREAN CHURCH OF GOD</b>	)	
<b>INTERNATIONAL</b>	)	
_____ )	)	

Commissioner for Trademarks  
AE00C55, Madison East  
600 Dulany Street  
Alexandria, VA 22314

**RESPONSE TO OFFICE ACTION**

The Examining Attorney has found Applicant's mark BEREAN CHURCH OF GOD INTERNATIONAL to be confusingly similar to Standex International Corporation's ("Standex") prior registered mark BEREAN. For the reasons presented below, Applicant respectfully disagrees that its mark poses a likelihood of confusion with the cited mark.

**1. No Likelihood of Confusion.**

**1.1. The parties' services are highly dissimilar.**

Applicant's services are highly dissimilar from those of the prior cited mark, and therefore are not likely to be confused. Standex's mark (Reg. No. 1,020,732) is registered for:

*Retail store services featuring the sale of books, religious merchandise and church supplies, in Class 42.*

Applicant's mark, on the other hand, is sought to be registered for:

*Evangelistic and ministerial services and establishment of churches; providing information and newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics, in Class 45.*

It is apparent on its face that, apart from the religious subject matter, the two services are virtually unrelated and dissimilar. The registrant's services are the sale of merchandise in a retail store setting. Applicant's services are those of a church and church network: evangelism, ministry, assistance in establishment of new churches, and the provision of church-related information on the web. Clearly, the average consumer would not be confused between these typical church activities

and the services of a retail store. Consumers go to retail stores to purchase goods. Consumers do not go to churches to purchase goods but to receive spiritual ministry—to worship, pray, listen to sermons, and receive spiritual guidance. These are clearly distinct and separate services.<sup>1</sup>

1.2 The parties' channels of trade are highly dissimilar.

Clearly consumers will not encounter the respective marks in the same context because the respective channels of trade are also distinct and dissimilar, and consumers are unlikely to impute a common source to such services. The Examining Attorney contends, without explanation, that Applicant's and registrant's services are likely to be encountered by the same purchasers in the same channel of trade. In fact, however, the parties' channels of trade are not the same at all.<sup>2</sup> By definition, retail store services are available only in retail stores. As the registrant's mark is registered solely for retail store services, its registration only serves to protect its mark for retail store services. In contrast, Applicant's services are provided through churches. Retail stores and churches conduct their activities through two distinct channels of trade that have virtually nothing in common.<sup>3</sup> Retail stores are money-making ventures that are generally located in commercial areas such as strip malls and shopping plazas, together with other retail establishments. Churches are nonprofit entities generally located on their own properties separate from retail establishments. Retail stores attract customers through advertisements of their products. Churches typically do not advertise but attract members primarily through word of mouth based on the quality of the preaching, the services and outreach programs, and the benefits of membership.

Even if some consumers may be aware of both Applicant's churches and the registrant's retail stores by virtue of the religious subject matter of the registrant's goods, this does not mean that such consumers would be confused by the two or assume that they originate from the same source. *See, e.g., Electronic Design & Sales Inc. v. Electronic Data Systems Corp.* 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (goods sold in same field not sufficient to demonstrate likelihood of confusion); *Astra Pharmaceutical Prods. v. Beckman Instruments*, 220 USPQ 786, 790 (1st Cir. 1983) (same). The average consumer would readily see that retail stores serve completely different functions and purposes than churches. Retail stores do not conduct church services, and churches do not operate retail stores. Consumers who see the registrant's mark in conjunction with the registrant's stores are not likely to be confused with Applicant's mark used in conjunction with its churches.

The Trademark Trial and Appeal Board has cautioned that in comparing marks, one is not to be "concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis

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<sup>1</sup> Even if the Examiner were to argue that some churches may incidentally sell some religious goods, Applicant is not seeking to register its marks for such services.

<sup>2</sup> Of course, it is not even appropriate to use the terms "purchasers," "consumers," and "channels of trade" with respect to Applicant's services. These are commercial terms that are wholly inappropriate to the context of the nonprofit mission of a church. However, Applicant will use these terms for the purpose of this response for the sake of simplicity.

<sup>3</sup> The Examining Attorney may contend that both parties have websites. However, this alone does not mean that they share the same channel of trade. The primary purpose of a website of a retail store is to advertise the store and promote and sell its goods. In contrast, the primary purpose of Applicant's website is to further the ministry and teachings of the church. The average consumer can readily distinguish these disparate activities.

situations but with the practicalities of the commercial world, with which trademark laws deal.” *United Foods Inc. v. United Air Lines Inc.*, 41 U.S.P.Q.2d 1653, 1663 (T.T.A.B. 1985). While it may be possible to envision a theoretical basis for likelihood of confusion between the parties’ marks as used with their respective services, the Examiner must consider the real world likelihood. Even if the parties’ marks have similarities, in the real world, consumers are highly unlikely to confuse marks used for services so different as sale of retail goods and church ministry, and in channels of trade so different as retail stores and churches.

In *United Foods Inc.*, the Board found no likelihood of confusion between use of the identical mark “United Express”, even though the parties’ services both involved some transportation of freight, where the cancellation petitioner transported freight in large trucks, and the respondent did so by plane. The Board found persuasive that the petitioner’s main competitors were major truck lines, not airlines, and that passenger planes necessarily have only limited space for freight. The instant case is analogous to the *United Foods* situation in that both parties’ services involve religion. However, in this case the parties’s respective services are far less related than were the services in *United Foods*. In that case, the parties’ services involved literally the same services—transportation of freight. The difference was simply a matter of degree to which the services were provided. In this case, the parties do not even provide any of the same services. Rather, the services are in completely different sectors of the marketplace—the registrant’s are in the for-profit retail commercial world, while Applicant’s are in the nonprofit spiritual world. This significant difference in sector is alone enough to preclude a likelihood of confusion between the marks.

### 1.3 Applicant’s mark, when viewed in its entirety, is distinct from the prior cited mark.

The fact that the parties’ services are distinct means that the differences between the marks are to be weighed more heavily. The degree of similarity of the marks needed to prove likelihood of confusion will vary with the difference in the goods and services of the parties. *See* McCarthy, J. Thomas, *McCarthy on Trademarks and Unfair Competition*, (Thomson West, 4th ed. 2003) § 23:20.1. Given the significant differences between the services of the marks, as discussed above, the additional terms in Applicant’s mark are sufficient to distinguish it from the registrant’s mark.

Not only are the services and channels of trade of the parties substantially distinct, the marks are also easily distinguishable. It is a well settled principle of trademark law that in determining likelihood of confusion, the marks must be considered in their entireties. It is the overall commercial impression of the marks that must be compared, not individual components. The Federal Circuit has stated that “It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.” *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A.); *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985). Similarly, in *Duluth News-Tribune, Inc., v. Mesabi Publishing Company*, 84 F.3d 1093, 38 U.S.P.Q.2d 1937 (8th Cir. 1996), the newspaper name DULUTH NEWS-TRIBUNE was held not likely to be confused with a competing newspaper SATURDAY DAILY NEWS & TRIBUNE. There, the court did not find a likelihood of confusion between the two marks even though the marks shared identical words in common and were used by direct competitors. *Id.* at 1097. Rather than consider similarities between *component parts* of the marks in determining similarity, one must evaluate the impression that each

mark *in its entirety* is likely to have on the purchaser exercising attention usually given by purchasers of such products. *Id.*

Furthermore, a disclaimer does not remove the disclaimed words from the mark or from consideration in determining whether marks are confusingly similar. *In re Buty-Wave Products Co., Inc.* 198 U.S.P.Q. 104 (T.T.A.B. 1978). A disclaimer disclaims only any exclusive rights in words per se, and cannot be ignored in determining the confusingly similarity of the marks. Even where the distinguishing words in a mark are weak and disclaimed, they are still capable of distinguish the mark from another mark containing an identical term. In *United Foods Inc. v. J.R. Simplot Co.*, 4 U.S.P.Q.2d 1172 (TTAB 1987), the Board found no likelihood of confusion between the applicant's mark QUICK N' CRISPY and the opposer's marks QUICK 'N CHEESY, QUICK 'N BUTTERY, and QUICK 'N SAUCY for related food products, *notwithstanding the fact that the sole distinguishing portions of the marks* (CRISPY, CHEESY, BUTTERY, and SAUCY) *were all disclaimed.*

Similarly, although the Examining Attorney has requested that the terms CHURCH OF GOD INTERNATIONAL in Applicant's mark be disclaimed, the terms are still significant in distinguishing Applicant's mark from the registrant's mark. In light of the principles discussed above, it is improper to disregard the terms CHURCH OF GOD INTERNATIONAL when comparing the two marks. One may not simply compare the common term BEREAN in each mark and end the analysis. The Examining Attorney must examine the commercial impression of the entire mark BEREAN CHURCH OF GOD INTERNATIONAL. Despite the fact that they are disclaimed, the words help the consumer to readily know the difference between the services identified by the respective marks.

In fact, in this case it is precisely because the words are descriptive that they so clearly help to distinguish the marks. As discussed in the previous section, the services and channels of trade of the parties are substantially different. The words in Applicant's mark CHURCH OF GOD INTERNATIONAL helps the consumer to see immediately that Applicant's mark is used to identify church services. With the descriptive words CHURCH OF GOD INTERNATIONAL added to the term BEREAN, no reasonable person seeing Applicant's mark would think that Applicant's services were retail store services. This case is similar to that in *We Media, Inc. v. General Electric Co.*, 218 F.Supp.2d 463 (S.D.N.Y. 2002), in which the court found no likelihood of confusion between two marks containing the *identical dominant word* (WE versus WE MEDIA), where the only distinguish term is the weak term MEDIA. Although the two marks in the instant case are the same, the additional words in Applicant's mark sufficiently distinguish it from the registrant's mark, particularly when viewed in conjunction with the respective services and channels of trade.

Also, under the "overall impression" analysis, there is no rule that confusion is automatically likely if a junior user has a mark that contains in part the whole of another's mark. *See, e.g., Colgate-Palmolive Co. v. Cater-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD held not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR held not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1975) (TIC TAC held not confusingly similar to TIC TAC TOE). Thus, it is improper for the Examining Attorney to assume that Applicant's mark is confusingly similar to the registrant's mark simply because Applicant's mark contains the same

word BEREAN. Again, a proper analysis must examine the entire commercial impression of the marks, not a simple comparison of the common terms. In this case, the overall impression of the two marks are readily distinguishable and not likely to cause confusion.

Furthermore, it must be noted that the term BEREAN is highly suggestive in the Christian community, and therefore not an entirely distinctive word. The name "Berean" refers to a group of Christians described in the New Testament as being of "noble character":

*Now the Bereans were of more noble character than the Thessalonians, for they received the message with great eagerness and examined the Scriptures every day to see if what Paul said was true. Acts 17:11.*

(See attached printout from the New International Version, available at [www.biblegateway.com](http://www.biblegateway.com).) Because of the positive connotation of the name Berean, it is commonly used within the Christian community. A search of the word in Google results in 465,000 hits. The fact that the word is commonly used with the relevant sector of the consuming public means that it is a relatively weak term, and only entitled to a small scope of protection. Therefore, the additional words CHURCH OF GOD are more than sufficient to distinguish the two marks.

In sum, Applicant's mark BEREAN CHURCH OF GOD INTERNATIONAL is clearly distinguishable from the registrant's BEREAN mark because the services and channels of trade are substantially different, and the marks are readily distinguishable with the additional words CHURCH OF GOD INTERNATIONAL. This is particularly true because the term BEREAN is relatively common and weak in the Christian community so that even minor differences in the marks are sufficient to distinguish them when they are compared in their entirety, not by their individual components. For all of the foregoing reasons, Applicant submits that there is no likelihood of confusion between Applicant's mark and the prior cited mark, and Applicant's mark should be permitted to be registered.

## **2. Disclaimer.**

Per the Examining Attorney's request, Applicant disclaims the words CHURCH OF GOD INTERNATIONAL from the mark as follows:

*Without waiver of common law rights, no claim is made to the exclusive right to use CHURCH OF GOD INTERNATIONAL apart from the mark as shown.*

## **3. Amendment of identification.**

Per the Examining Attorney's request, Applicant amends its description of services to read as follows:

*Providing technical assistance in the establishment of the business operations of churches (Class 35);*

*Providing newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics (Class 41);*

*Evangelistic and ministerial services; establishment of the religious life of churches; providing information via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics (Class 45).*

**REMARKS**

For the foregoing reasons, it is submitted that the present application is in condition for publication, and such action is requested.

Respectfully submitted,  
**BEREAN CHURCH OF GOD INTERNATIONAL**

By Counsel 

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*Attorneys for Applicant*

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## Passage results

### Acts 17:11 (New International Version)

#### New International Version (NIV)

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<sup>11</sup>Now the Bereans were of more noble character than the Thessalonians, for they received the message with great eagerness and examined the Scriptures every day to see if what Paul said was true.

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August 3, 2005

Commissioner for Trademarks  
U.S. Patent & Trademark Office  
Trademark Assistance Center  
AE00C55, Madison East  
600 Dulany Street  
Alexandria, VA 22314

- VIA COURIER -

Re: (1728-009) **BEREAN CHURCH OF GOD INTERNATIONAL & Design™**  
Class 45 (Serial No. 76/598,717)  
Office Action Response  
Law Office 105; Leigh Caroline Case, Examining Attorney

Dear Sir or Madam:

Enclosed please find the response of the Berean Church of God International to the Office Action issued February 4, 2005 by the U.S. Patent & Trademark Office for the above-referenced mark. Please direct any questions to the undersigned.

Respectfully submitted,  
**BEREAN CHURCH OF GOD INTERNATIONAL**

By: *Nancy LeSourd*  
Nancy Oliver LeSourd  
Kenneth E. Liu  
*Attorneys for Applicant*

Enclosure: Response to Office Action

cc: Rev. Carlton Miller

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08-03-2005

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #77

**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

_____ )	
In re Application of )	
Applicant: Berean Church of God International )	Law Office: 105
Serial No.: 76/598,717 )	
Class: 45 )	Examining Attorney:
Date Filed: 6/23/04 )	Leigh Caroline Case
Mark: <b>BEREAN CHURCH OF GOD</b> )	
<b>INTERNATIONAL &amp; Design</b> )	
_____ )	

Commissioner for Trademarks  
AE00C55, Madison East  
600 Dulany Street  
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**RESPONSE TO OFFICE ACTION**

The Examining Attorney has found Applicant's mark BEREAN CHURCH OF GOD INTERNATIONAL & Design to be confusingly similar to Standex International Corporation's ("Standex") prior registered mark BEREAN. For the reasons presented below, Applicant respectfully disagrees that its mark poses a likelihood of confusion with the cited mark.

**1. No Likelihood of Confusion.**

1.1. The parties' services are highly dissimilar.

Applicant's services are highly dissimilar from those of the prior cited mark, and therefore are not likely to be confused. Standex's mark (Reg. No. 1,020,732) is registered for:

*Retail store services featuring the sale of books, religious merchandise and church supplies, in Class 42.*

Applicant's mark, on the other hand, is sought to be registered for:

*Evangelistic and ministerial services and establishment of churches; providing information and newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics, in Class 45.*

It is apparent on its face that, apart from the religious subject matter, the two services are virtually unrelated and dissimilar. The registrant's services are the sale of merchandise in a retail store setting. Applicant's services are those of a church and church network: evangelism, ministry, assistance in establishment of new churches, and the provision of church-related information on the web. Clearly, the average consumer would not be confused between these typical church activities

and the services of a retail store. Consumers go to retail stores to purchase goods. Consumers do not go to churches to purchase goods but to receive spiritual ministry—to worship, pray, listen to sermons, and receive spiritual guidance. These are clearly distinct and separate services.<sup>1</sup>

1.2 The parties' channels of trade are highly dissimilar.

Clearly consumers will not encounter the respective marks in the same context because the respective channels of trade are also distinct and dissimilar, and consumers are unlikely to impute a common source to such services. The Examining Attorney contends, without explanation, that Applicant's and registrant's services are likely to be encountered by the same purchasers in the same channel of trade. In fact, however, the parties' channels of trade are not the same at all.<sup>2</sup> By definition, retail store services are available only in retail stores. As the registrant's mark is registered solely for retail store services, its registration only serves to protect its mark for retail store services. In contrast, Applicant's services are provided through churches. Retail stores and churches conduct their activities through two distinct channels of trade that have virtually nothing in common.<sup>3</sup> Retail stores are money-making ventures that are generally located in commercial areas such as strip malls and shopping plazas, together with other retail establishments. Churches are nonprofit entities generally located on their own properties separate from retail establishments. Retail stores attract customers through advertisements of their products. Churches typically do not advertise but attract members primarily through word of mouth based on the quality of the preaching, the services and outreach programs, and the benefits of membership.

Even if some consumers may be aware of both Applicant's churches and the registrant's retail stores by virtue of the religious subject matter of the registrant's goods, this does not mean that such consumers would be confused by the two or assume that they originate from the same source. *See, e.g., Electronic Design & Sales Inc. v. Electronic Data Systems Corp.* 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992) (goods sold in same field not sufficient to demonstrate likelihood of confusion); *Astra Pharmaceutical Prods. v. Beckman Instruments*, 220 USPQ 786, 790 (1st Cir. 1983) (same). The average consumer would readily see that retail stores serve completely different functions and purposes than churches. Retail stores do not conduct church services, and churches do not operate retail stores. Consumers who see the registrant's mark in conjunction with the registrant's stores are not likely to be confused with Applicant's mark used in conjunction with its churches.

The Trademark Trial and Appeal Board has cautioned that in comparing marks, one is not to be "concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which trademark laws deal."

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<sup>1</sup> Even if the Examiner were to argue that some churches may incidentally sell some religious goods, Applicant is not seeking to register its marks for such services.

<sup>2</sup> Of course, it is not even appropriate to use the terms "purchasers," "consumers," and "channels of trade" with respect to Applicant's services. These are commercial terms that are wholly inappropriate to the context of the nonprofit mission of a church. However, Applicant will use these terms for the purpose of this response for the sake of simplicity.

<sup>3</sup> The Examining Attorney may contend that both parties have websites. However, this alone does not mean that they share the same channel of trade. The primary purpose of a website of a retail store is to advertise the store and promote and sell its goods. In contrast, the primary purpose of Applicant's website is to further the ministry and teachings of the church. The average consumer can readily distinguish these disparate activities.

*United Foods Inc. v. United Air Lines Inc.*, 41 U.S.P.Q.2d 1653, 1663 (T.T.A.B. 1985). While it may be possible to envision a theoretical basis for likelihood of confusion between the parties' marks as used with their respective services, the Examiner must consider the real world likelihood. Even if the parties' marks have similarities, in the real world, consumers are highly unlikely to confuse marks used for services so different as sale of retail goods and church ministry, and in channels of trade so different as retail stores and churches.

In *United Foods Inc.*, the Board found no likelihood of confusion between use of the identical mark "United Express", even though the parties' services both involved some transportation of freight, where the cancellation petitioner transported freight in large trucks, and the respondent did so by plane. The Board found persuasive that the petitioner's main competitors were major truck lines, not airlines, and that passenger planes necessarily have only limited space for freight. The instant case is analogous to the *United Foods* situation in that both parties' services involve religion. However, in this case the parties's respective services are far less related than were the services in *United Foods*. In that case, the parties' services involved literally the same services—transportation of freight. The difference was simply a matter of degree to which the services were provided. In this case, the parties do not even provide any of the same services. Rather, the services are in completely different sectors of the marketplace—the registrant's are in the for-profit retail commercial world, while Applicant's are in the nonprofit spiritual world. This significant difference in sector is alone enough to preclude a likelihood of confusion between the marks.

### 1.3 Applicant's mark, when viewed in its entirety, is distinct from the prior cited mark.

The fact that the parties' services are distinct means that the differences between the marks are to be weighed more heavily. The degree of similarity of the marks needed to prove likelihood of confusion will vary with the difference in the goods and services of the parties. See McCarthy, J. Thomas, *McCarthy on Trademarks and Unfair Competition*, (Thomson West, 4th ed. 2003) § 23:20.1. Given the significant differences between the services of the marks, as discussed above, the additional terms in Applicant's mark are sufficient to distinguish it from the registrant's mark.

Not only are the services and channels of trade of the parties substantially distinct, the marks are also easily distinguishable. It is a well settled principle of trademark law that in determining likelihood of confusion, the marks must be considered in their entireties. It is the overall commercial impression of the marks that must be compared, not individual components. In this case, not only are the additional words in Applicant's mark sufficient to distinguish it from the registrant's mark, but Applicant's mark contains an easily distinguishable design.

#### 1.3.1 The additional words CHURCH OF GOD INTERNATIONAL render the mark easily distinguishable from the registrant's mark when view in their entireties.

The Federal Circuit has stated that "It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion." *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 U.S.P.Q. 272, 273 (C.C.P.A.); *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985). Similarly, in *Duluth News-Tribune, Inc., v. Mesabi Publishing Company*, 84 F.3d 1093, 38 U.S.P.Q.2d 1937 (8th Cir. 1996), the newspaper name DULUTH NEWS-TRIBUNE was

held not likely to be confused with a competing newspaper SATURDAY DAILY NEWS & TRIBUNE. There, the court did not find a likelihood of confusion between the two marks even though the marks shared identical words in common and were used by direct competitors. *Id.* at 1097. Rather than consider similarities between *component parts* of the marks in determining similarity, one must evaluate the impression that each mark *in its entirety* is likely to have on the purchaser exercising attention usually given by purchasers of such products. *Id.*

Furthermore, a disclaimer does not remove the disclaimed words from the mark or from consideration in determining whether marks are confusingly similar. *In re Buty-Wave Products Co., Inc.* 198 U.S.P.Q. 104 (T.T.A.B. 1978). A disclaimer disclaims only any exclusive rights in words *per se*, and cannot be ignored in determining the confusingly similarity of the marks. Even where the distinguishing words in a mark are weak and disclaimed, they are still capable of distinguish the mark from another mark containing an identical term. In *United Foods Inc. v. J.R. Simplot Co.*, 4 U.S.P.Q.2d 1172 (TTAB 1987), the Board found no likelihood of confusion between the applicant's mark QUICK 'N' CRISPY and the opposer's marks QUICK 'N' CHEESY, QUICK 'N' BUTTERY, and QUICK 'N' SAUCY for related food products, *notwithstanding the fact that the sole distinguishing portions of the marks* (CRISPY, CHEESY, BUTTERY, and SAUCY) *were all disclaimed.*

Similarly, although the Examining Attorney has requested that the terms CHURCH OF GOD INTERNATIONAL in Applicant's mark be disclaimed, the terms are still significant in distinguishing Applicant's mark from the registrant's mark. In light of the principles discussed above, it is improper to disregard the terms CHURCH OF GOD INTERNATIONAL when comparing the two marks. One may not simply compare the common term BEREAN in each mark and end the analysis. The Examining Attorney must examine the commercial impression of the entire mark BEREAN CHURCH OF GOD INTERNATIONAL & Design. Despite the fact that the words CHURCH OF GOD INTERNATIONAL are disclaimed, the words help the consumer to readily know the difference between the services identified by the respective marks.

In fact, in this case it is precisely because the words are descriptive that they so clearly help to distinguish the marks. As discussed in the previous section, the services and channels of trade of the parties are substantially different. The words in Applicant's mark CHURCH OF GOD INTERNATIONAL helps the consumer to see immediately that Applicant's mark is used to identify church services. With the descriptive words CHURCH OF GOD INTERNATIONAL added to the term BEREAN, no reasonable person seeing Applicant's mark would think that Applicant's services were retail store services. This case is similar to that in *We Media, Inc. v. General Electric Co.*, 218 F.Supp.2d 463 (S.D.N.Y. 2002), in which the court found no likelihood of confusion between two marks containing the *identical dominant word* (WE versus WE MEDIA), where the only distinguish term is the weak term MEDIA. Although the two marks in the instant case are the same, the additional words in Applicant's mark sufficiently distinguish it from the registrant's mark, particularly when viewed in conjunction with the respective services and channels of trade.

Also, under the "overall impression" analysis, there is no rule that confusion is automatically likely if a junior user has a mark that contains in part the whole of another's mark. *See, e.g., Colgate-Palmolive Co. v. Cater-Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD held not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107,

174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR held not confusingly similar to ALL); *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1975) (TIC TAC held not confusingly similar to TIC TAC TOE). Thus, it is improper for the Examining Attorney to assume that Applicant's mark is confusingly similar to the registrant's mark simply because Applicant's mark contains the same word BEREAN. Again, a proper analysis must examine the entire commercial impression of the marks, not a simple comparison of the common terms. In this case, the overall impression of the two marks are readily distinguishable and not likely to cause confusion.

Furthermore, it must be noted that the term BEREAN is highly suggestive in the Christian community, and therefore not an entirely distinctive word. The name "Berean" refers to a group of Christians described in the New Testament as being of "noble character":

*Now the Bereans were of more noble character than the Thessalonians, for they received the message with great eagerness and examined the Scriptures every day to see if what Paul said was true. Acts 17:11.*

(See attached printout from the New International Version, available at [www.biblegateway.com](http://www.biblegateway.com).) Because of the positive connotation of the name Berean, it is commonly used within the Christian community. A search of the word in Google results in 465,000 hits. The fact that the word is commonly used with the relevant sector of the consuming public means that it is a relatively weak term, and only entitled to a small scope of protection. Therefore, the additional words CHURCH OF GOD are more than sufficient to distinguish the two marks.

**1.3.2. The design elements in Applicant's mark further render the mark distinguishable from the registrant's mark.**

Where a mark is a composite one including a design and a word, then which of the two features dominates the mark is usually controlling in determining likelihood of confusion. *In re Strathmore Products, Inc.*, 171 U.S.P.Q. 766, 767 (T.T.A.B. 1971). In Applicant's mark, the design elements clearly comprise the dominant portion of the mark. The cross, Bible, and globe design visually dominates as the central feature of the mark. The word BEREAN is but one small portion of the overall mark. The fact that the words are wrapped around the outer edge of the design portion further diminishes the significance of the words relative to the design. Although in this case, the additional words CHURCH OF GOD INTERNATIONAL are more than sufficient to distinguish Applicant's mark from the prior registrant's mark, the fact that the design elements are dominant render the entire mark undoubtedly distinguishable from the registrant's mark.

In sum, Applicant's mark BEREAN CHURCH OF GOD INTERNATIONAL & Design is clearly distinguishable from the registrant's BEREAN word mark because the services and channels of trade are substantially different. This is particularly true because the term BEREAN is relatively common and weak in the Christian community so that even minor differences in the marks are sufficient to distinguish them when they are compared in their entirety, not by their individual components. Furthermore, the marks are readily distinguishable with the additional words CHURCH OF GOD INTERNATIONAL and the large, dominant design elements of a cross, Bible, and globe. For all of the foregoing reasons, Applicant submits that there is no likelihood of confusion between

Applicant's mark and the prior cited mark, and Applicant's mark should be permitted to be registered.

**2. Disclaimer.**

Per the Examining Attorney's request, Applicant disclaims the words CHURCH OF GOD INTERNATIONAL from the mark as follows:

*Without waiver of common law rights, no claim is made to the exclusive right to use CHURCH OF GOD INTERNATIONAL apart from the mark as shown.*

**3. Amendment of identification.**

Per the Examining Attorney's request, Applicant amends its description of services to read as follows:

*Providing technical assistance in the establishment of the business operations of churches (Class 35);*

*Providing newsletters via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics (Class 41);*

*Evangelistic and ministerial services; establishment of the religious life of churches; providing information via a global computer network in the fields of Christianity, religion, theology, spirituality, and ethics (Class 45).*

**REMARKS**

For the foregoing reasons, it is submitted that the present application is in condition for publication, and such action is requested.

Respectfully submitted,  
**BEREAN CHURCH OF GOD INTERNATIONAL**

  
By Counsel

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## Passage results

### Acts 17:11 (New International Version)

#### New International Version (NIV)

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<sup>11</sup>Now the Bereans were of more noble character than the Thessalonians, for they received the message with great eagerness and examined the Scriptures every day to see if what Paul said was true.

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