

From: Dubois, Michelle

Sent: 2/4/2016 10:15:23 AM

To: TTAB E Filing

CC:

Subject: U.S. TRADEMARK APPLICATION NO. 79144900 - CREAMIE - N/A - Request for Reconsideration Denied - Return to TTAB

\*\*\*\*\*

Attachment Information:

Count: 1

Files: 79144900.doc

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO.** 79144900

**MARK:** CREAMIE



**CORRESPONDENT ADDRESS:**

LEW HANSEN

SHERIDAN ROSS PC

1560 BROADWAY SUITE 1200

DENVER, CO 80202

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/trademarks/index.jsp>

**APPLICANT:** Jens Poulsen Holding ApS

**CORRESPONDENT'S REFERENCE/DOCKET NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**REQUEST FOR RECONSIDERATION DENIED**

**ISSUE/MAILING DATE:**

**INTERNATIONAL REGISTRATION NO. 1062519**

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. See 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The following requirement(s) and/or refusal(s) made final in the Office action dated 7/6/15 are maintained and continue to be final: Section 2(d) refusal with respect to U.S. Registration Nos. 3783660, 3857391 and 4635759. See TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

If applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); see 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); see TMEP §§715.03, 715.03(a)(ii)(B), (c).

Applicant's additional arguments are addressed as follows:

Please note that with respect to applicant's and registrant's goods and/or services, the question of likelihood of confusion is determined based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. See *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Absent restrictions in an application and/or registration, the identified goods and/or services are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all goods and/or services of the type described. See *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identifications set forth in the application and registrations have no restrictions as to channels of trade or classes of purchasers. Therefore, it is presumed that these goods and/or services travel in all normal channels of trade, and are available to the same class of purchasers.

Applicant cites *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 2015 U.S. LEXIS 2119, for the argument that "evidence of actual use and channels of trade should, when available, supersede mere assumptions." It is submitted that the *B&B Hardware* decision does not stand for this proposition. The case dealt with whether issue preclusion applies to Trademark Trial and Appeal Board decisions. It held: "So long as the other ordinary elements of issue preclusion are met, when the usages adjudicated by the TTAB are

materially the same as those before the district court, issue preclusion should apply.” *Id.* at \*\*\*35. The decision did not discuss or rule regarding the propriety of relying on identifications in registration applications when determining the scope of channels of trade.

Applicant argues that the owners of cited registrations 3783660 and 3857391 have abandoned their trademarks due to nonuse. However, a trademark or service mark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant’s exclusive right to use the mark in commerce in connection with the specified goods and/or services. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Thus, evidence and arguments that constitute a collateral attack on a cited registration, such as information or statements regarding a registrant’s nonuse of its mark, are not relevant during ex parte prosecution. See *In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv). Such evidence and arguments may, however, be pertinent to a formal proceeding before the Trademark Trial and Appeal Board to cancel the cited registration.

Applicant again cites to *B&B Hardware* to argue that actual evidence of use (in this situation, non-use) should be considered. For the reasons noted above, it is submitted that this decision did not discuss and should not alter the current practice of considering a current registration to be valid during ex parte prosecution. If applicant wishes to attack a current registration, that registrant should have the opportunity to respond in a separate proceeding. As stated above, applicant could consider a cancellation proceeding before the Trademark Trial and Appeal Board for this purpose.

/Michelle E. Dubois/

Trademark Attorney

Law Office 107

(571) 272-5887

michelle.dubois@uspto.gov