

From: Lapter, Alain

Sent: 11/22/2013 11:24:48 AM

To: TTAB EFiling

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Subject: U.S. TRADEMARK APPLICATION NO. 85667426 - AMERICA SECOND TO NONE - N/A - Request for Reconsideration Denied - Return to TTAB

Attachment Information:

Count: 2

Files: secondto.jpg, 85667426.doc

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

U.S. APPLICATION SERIAL NO. 85667426

MARK: AMERICA SECOND TO NONE



CORRESPONDENT ADDRESS:

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GENERAL TRADEMARK INFORMATION:

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

APPLICANT: Monfredo, Vincent

CORRESPONDENT'S REFERENCE/DOCKET NO:

N/A

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REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 11/22/2013

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. §2.64(b); TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated May 9, 2013 are maintained and continue to be final. See TMEP §§715.03(a)(2)(B), (a)(2)(E), 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.

Similar to Applicant's response to the initial office action, Applicant continues to argue that the marks create a different commercial impression because its mark incorporates a design element. As the examiner has previously explained, however, consumers are more likely to recall marks by the literal elements, as compared to the design elements incorporated in the mark. For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); see *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Furthermore, the word portions of the marks are nearly identical in appearance, sound, connotation, and commercial impression; therefore, the addition of a design element does not obviate the similarity of the marks in this case. See *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii).

To further this point, the examining attorney has attached a copy of a search of the PTO database reviewing live applications and registrations in Class 25 that incorporate the wording Second to None, or some other variation. The search returned 6 hits, of which two belong to Applicant, this application and App. Ser. No. 85307627. Another hit is for the cited registration. Of the other three, one is for the mark SECOND II NONE which is used in connection with membership in a motorcycle club (Reg. No. 4145828)

and a registration for the mark CHICKIE BROWN NULLI SECUNDUS with Design (Reg. No. 4380833), as well as a recently filed application, Ser. No. 86059122.

This evidence again shows that Applicant's wording for a mark in Class 25 are actually quite distinctive, rather than diluted. This further establishes the strength of the mark, the similar commercial impressions created by the marks at issue and, thus, the likelihood of confusion among consumers.

It should again be noted that Applicant makes no arguments regarding the similarity of the goods, i.e. clothing, that is associated with the marks. This factor also weighs in the examining attorney's favor.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §715.03, (a)(2)(B), (a)(2)(E), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP §715.03(a)(2)(B), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal. *See* TMEP §715.04(a).

/Alain J. Lapter/

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#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	21	0	21	20	0:02	("second to none" "second two none" "second 2 none" "2nd to none" "2nd two none" "2nd 2 none")[bi,ti] not dead[ld]
02	12	0	12	12	0:01	1 and "025"[cc]
03	6	0	6	6	0:01	1 and ("025" a b 200)[ic]
04	1780	N/A	0	0	0:01	(*second* "2nd")[bi,ti] not dead[ld]
05	49149	N/A	0	0	0:02	("two" "too" "to" "2")[bi,ti] not dead[ld]
06	136	N/A	0	0	0:01	"none"[bi,ti] not dead[ld]
07	21	0	21	20	0:01	4 and 5 and 6
08	6	0	6	6	0:01	7 and ("025" a b 200)[ic]

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