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Sent: 9/3/2015 9:34:40 AM

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Subject: U.S. TRADEMARK APPLICATION NO. 85702202 - BRAND MATTERS - 740250018 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 5

Attachment Information:

Count: 13

Files: tradeshow-1.jpg, tradeshow-2.jpg, tradeshow-3.jpg, cyproress-1.jpg, cyproress-2.jpg, cyproress-3.jpg, asi-1.jpg, asi-2.jpg, duplicate name 75105 asi-1.jpg, duplicate name 75105 asi-2.jpg, asi-3.jpg, adv-1.jpg, 85702202.doc

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

U.S. APPLICATION SERIAL NO. 85702202

MARK: BRAND MATTERS



CORRESPONDENT ADDRESS:

CHRISTOPHER KELLY

WILEY REIN LLP

1776 K ST NW

WASHINGTON, DC 20006-2304

GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: Consumer Electronics Association

CORRESPONDENT'S REFERENCE/DOCKET NO:

740250018

CORRESPONDENT E-MAIL ADDRESS:

ckelly@wileyrein.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 9/3/2015

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 refusal made final in the Office action dated 10/02/2014 is maintained and

continues to be final: *the Section 2(d) likelihood of confusion refusal*. 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.

In its Request for Remand, applicant has instructed the examining attorney to delete applicant's services in International Class 041 in their entirety from the application and to proceed with the services in International Class 035 only, in an attempt to overcome the refusal.

This is insufficient as the Section 2(d) likelihood of confusion was not limited to applicant's services in International Class 041 only. Rather the refusal pertained to both of the Classes that were specified in the application at the time the Final refusal was issued. Specifically, the remaining services in International Class 035, *"organizing, promoting and conducting a tradeshow in the electronics industry featuring information and exhibits of particular interest to the marketing and advertising community; business networking opportunities to members of the marketing and advertising community and consumer electronics industry; providing consumer product and services information of interest to the marketing and advertising community in the field of consumer electronics technology"* are highly related to registrant's services and the marks are virtually identical.

As discussed in the Final Office Action, applicant's mark and registrant's marks contain the identical and only terms "BRAND MATTERS". The only difference is that registrant's mark depicts the terms as unitary "BRANDMATTERS", and applicant depicts the mark as two separate terms "BRAND MATTERS". However, this slight difference in spelling is insufficient to alter the highly similar commercial impression between these marks. In this case, the applicant's mark and registrant's mark are essentially identical and applicant's mark does not create a distinct commercial impression because it contains the same common wording as the registered mark, and there is no other wording to distinguish it from the registered mark.

Further, the services are highly related and overlapping. Applicant's services comprise *"organizing, promoting and conducting a tradeshow in the electronics industry featuring information and exhibits of particular interest to the marketing and advertising community; business networking opportunities to members of the marketing and advertising community and consumer electronics industry; providing*

consumer product and services information of interest to the marketing and advertising community in the field of consumer electronics technology". The registrant provides "WORKSHOPS, LECTURES, SEMINARS AND CONSULTING SERVICES IN THE FIELDS OF STRATEGIC PLANNING, MARKETING, CUSTOMER RESEARCH AND EQUITY MEASUREMENTS".

As discussed in the previous Office actions, the registrant's identification of services is broadly drafted and its educational services providing workshops and seminars, and its broadly worded "consulting" in the fields of "strategic planning", "marketing" and "customer research" are not limited to a particular field of marketing services or field of users. Thus, registrant's services could include the applicant's field of marketing with respect to consumer electronics and/or provision of tradeshow. Further, the attached additional excerpts from third party websites shows numerous instances of tradeshow, business networking and educational training in the field of marketing provided together. For example, marketing associations provide conferences or tradeshow which include educational classes/seminars on marketing and also feature business networking opportunities. As well, tradeshow may also feature educational components about marketing. Thus, these types of services are encountered together under similar circumstances such that offering these services under confusingly similar marks would lead to the mistaken belief that they come from, or are in some way associated with, the same source. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984); TMEP §1207.01(a)(i).

See for example:

ASI Show:

<http://www.asishow.com/About/index.html>

ASI Education:

<http://www.asicentral.com/asp/open/education/certificationprogram.aspx?id=cp>

Advertising club of New York:

<http://www.theadvertisingclub.org/content/iab-ad-club-networking-social>

<http://www.theadvertisingclub.org/events>

<http://www.theadvertisingclub.org/professional-development>

American Marketing Association:

<https://www.ama.org/events-training/Training/Pages/Events%20Training.aspx?k=%20ContentType:%22AMATrainingPage%22>

<https://www.ama.org/search/pages/results.aspx?k=conferences>

DC Ad Club:

<http://www.dcadclub.com/about>

<http://www.dcadclub.com/program-events>

MediaPost:

<http://www.mediapost.com/omma-sxsw/>

<http://www.mediapost.com/omma-sxsw/specialevents/>

<http://www.mediapost.com/mastersofmediaselling/>

Puget Sound AMA:

<http://www.psama.org/events/in-the-know-networking/>

<http://www.psama.org/events/other-local-events/>

CES:

<http://www.psama.org/about-us/>

<http://www.cesweb.org/Conference/What-to-Expect>

<http://www.cesweb.org/Events-Programs/Advertising-Marketing>

Further, a plain reading of the services specified in the registration does not include any limitation or reference to registrant's services being provided only to "businesses and not to advertising and marketing professionals". Neither does a plain reading of registrant's services denote any limitation that registrant's services are only directed to "brand owners" or show that the respective services are directed to different classes of purchases through different trade channels as applicant contends.

Therefore, as the marks are virtually identical and as the services are closely related, potential purchasers could thus reasonably assume, due to the overall similarities in sound, appearance, connotation, and commercial impression of the respective marks, that applicant's services provided under the "BRAND MATTERS" mark constitute a new or additional service line from the same source as the registrant's services provided under the "BRANDMATTERS" mark with which they are acquainted or familiar, and that applicant's mark is merely a variation of the registrant's mark. *See, e.g., SMS, Inc. v. Byn-Mar Inc.* 228 USPQ 219, 220 (TTAB 1985) (applicant's marks ALSO ANDREA and ANDREA SPORT were "likely to evoke an association by consumers with opposer's preexisting mark [ANDREA SIMONE] for its established line of clothing.").

Therefore, the Final Section 2(d) likelihood of confusion refusal is continued and maintained.

As 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).

CLASS DELETED

As requested in applicant's Request for Remand, the application is amended to delete International Class 041 in its entirety from the application. *The application will proceed with the services in International Class 035 only.* TMEP §§1402.01, 1402.01(e).

/Lee-Anne Berns/

Examining Attorney

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Trade Show Marketing Training

1 [View](#)

It may be hard to believe, but many exhibitors spend a tremendous amount of money on the designing, building, and transporting their booths to trade shows, as well as related marketing materials. More importantly, they do little or no pre-show training for their booth staff that is essential to yield the full sales potential an event offers. Some experts suggest at least a full day of hands-on training with the tradeshow display booth staff be incorporated into the schedule. The purpose of our Trade Show Marketing seminar is to ensure the booth staff is able to fully capitalize on the investment of the organization.

This seminar is ideally conducted over a full day for the participants to practice what is taught. The information can be presented in several hours; however, opportunities for the participants to practice the skills taught would be limited.

Course Outline

This seminar will cover the following topics:

- Challenges facing exhibitors at a show and how to overcome them
- How to sell to prospects at trade shows
- What information to provide to the prospects
- What results to expect from a trade show
- How to determine the trade show's return on investment
- How to communicate your products/services price vs. value

Seminar Tips:

Schedule This Training

For groups of 3 or more participants

Cypress Media Group presents this seminar as an on-site offering at your work location or at an off-site location of your choice. We can customize this training program to suit your precise training needs.

For economic reasons, this seminar is only offered to groups of roughly three or more people with the same training needs. If you have a group with similar training needs, please call us at 770-640-9918 or [E-mail](#) to discuss your interest.

For fewer than 3 participants

We do not offer this course as an open enrollment public offering for individuals. If you have fewer than three participants who are interested in this course, the next will be the

A trade show elevator speech must be rehearsed so all booth staff can consistently, effectively, and effortlessly deliver the same message to every booth visitor in thirty seconds or less. An effective trade show "elevator speech" includes the following:

- Describes the features and benefits of the product/service
- Explains how the product/service helps and serves its users
- Highlights why it is better than its competitor's product/service

20 Tips for Trade Shows

Pre-show Marketing

- Allocate a percentage of your trade show budget for pre-show marketing to attendees.
- Send a pre-show postal mailing and/or e-mail promising something exclusive to show attendees who visit your booth.
- Include the show name and booth number as part of your phone voice mail message 60-90 days before a show.
- Include the show name and booth number as part of your signature on e-mails 60-90 days before a show.

Staff Training

- Provide your booth staff with proper training to represent your product/service.
- Develop written talking points for booth staff to rehearse so they can deliver a uniform message to trade show attendees.
- Share your trade show goals and objectives with your booth staff so they know your expectations and help you achieve them.

During the Show

- Staff your booth with people who are good listeners, not just good talkers.
- Introduce yourself and say, "I'm (name) with (company) and we (10 words or less description)."
- Explain how your product/service helps and serves its users.
- Highlight why your product/service is better than that of your competitors.
- Describe both the features and benefits of your product/service.
- Use wireless laptops and cell phones to follow up on HOT trade show leads DURING the show instead of after the show.
- Deliver your booth presentation in seven minutes or less.
- Attend trade shows with the goal of meeting as many people as possible and staying in touch via social media.
- Understand that not everyone at a trade show is a prospect.

In this course, the cost will be the same as for a larger group.

Please call us at 770-640-9918 or [E-mail](#) to discuss your interest.

Related Training

- [Trade Show Marketing Training](#)

About the Instructor

Tim Berkesch is the Director of Sales for [Vector Displays](#).

His perspective was formed by the following experiences:

- Attending and exhibiting at trade shows and conferences
- Training sales and booth personnel how to get the most out of their trade show experiences
- Consulting to organizations on how to select booth spaces and sizes, design, booth properties, and handle the logistics of the complete trade show experience.

He can be reached by e-mail at Tim@VectorDisplays.com

[Follow Tim on Twitter](#)

Connect to him on [LinkedIn](#)

General Trade Show Participation Advice

- Focus on shows that generate leads you can close within a year of the show.
- Aim for at least 50 square feet of open space for each booth staffer.
- Complete your show paperwork correctly, and submit it before the advanced rate deadline to save money.
- Bring small boxes of literature directly to the show site—shipping them in advance will result in hefty material handling/drayage charges.

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Trade Show Marketing

Cypress Media Group partners with companies worldwide to provide trade show displays, trade show exhibits, trade show booths, and trade show marketing services to clients. Our team can provide both trade show purchase and trade show rental programs. We can also provide trade show exhibit design and fabrication services. In addition, we can provide installation and dismantling services, trade show shipping services, and trade show exhibit storage.

In addition, our trade show marketing team can also provide banner stands, graphics and literature, graphic design services, custom shipping crates, video production services, and other related trade show marketing services.

Trade Show FAQs

Q: What should I consider when planning to purchase or rent a trade show display?

A: Cypress Media Group recommends that you ask yourself the following questions to plan the design, purchase, rental, and construction of trade show exhibits:

Contact Us

Make Cypress Media Group your Trade Show partner today.

To discuss your trade show marketing, [Email](#) or call our offices at 770-640-9918 for more information about trade show displays, trade show exhibits, or trade show booths.

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 How to Find Out What Really Matters To Your Buyers [Infographic] [buff.ly/1cQc8t5](#) RT [@mamabodie](#) [#sales](#)

- What is my budget range for this project and what costs does this budget cover?
- How many times or how often do we plan to use this trade show booth?
- What components will the interior of this trade show exhibit contain?
- What is the profile of our target customer at the shows we will attend?
- What specific goals do we have for the shows we plan to attend?
- What are the three strongest impressions we want our trade show booth to create for attendees at shows?
- What are the three impressions we do NOT want our trade show booth to create at shows?
- What factors should our trade show exhibit builders consider so they can provide us with the best options and the best price?

Q: How do you suggest that exhibitors contact trade show attendees before, during, and after the show to engage in effective trade show marketing?

A: The following are some of the pre-show activities that we use in our trade show marketing program to attract traffic to our clients' trade show exhibits:

- E-mail announcements to customers and prospects of upcoming presence at a show and trade show booth number location
- Mail announcements to customers and prospects of upcoming presence at a show and trade show booth number location
- Invitations to claim a useful, business-related gift at the trade show booth
- Announcements of show and trade show booth presence on client's Web site
- Company personnel mentioning the trade show and trade show booth in telephone conversations with clients and prospects
- Announcements mentioning the trade show and trade show booth in company mailings and with invoices
- Messages that are part of voicemail on the clients' employees' phones

The following activities are some of the trade show marketing we do during trade shows:

- Encouraging prospects to follow our clients on social networks like LinkedIn, Twitter, and Facebook
- Posting messages on LinkedIn, Twitter, and Facebook connecting with the prospects
- Calling and/or e-mailing prospects even before the show ends from smartphones and

 #Tradeshows are the most cost-effective way to reach the most prospects at one time from one place. [bizbash/1f6etLJ](#) RT [@EmileBarta](#)

 7 Effective Ways to Increase Participation at Your #Events [po.st/eVhY](#) via [@EventMB](#) [#eventprofs](#)

 10 Ways to Show Love to Your Event Attendees [po.st/ANZuJ](#) via [@EventMB](#) RT [@gracenote](#) [#eventprofs](#)

 9 Ways to Encourage Exhibitors to Go Green [bizbash/1FEU83PRT](#) [@BizBash](#) [#tradeshows](#) [#eventprofs](#)

Trade Show Display Gallery



wireless laptops

After the trade show, we use the following trade show marketing activities to follow up with prospects:

- Calling and/or e-mailing prospects again
- Contacting the prospects periodically over the next several months with a combination of telephone, e-mail, fax, mail, and messages on social networking sites

We recommend documenting all activities in a manual or automated sales force automation or customer relationship management database.

Q: I notice that your company is headquartered in Atlanta. Do you really do business worldwide?

A. Although we are located in Atlanta, we do provide services to clients worldwide through our relationships with specialty partners around the world. There are some remote areas we do not service for various economic or political reasons. However, since we are Atlanta-based, we can often offer additional price discounts to those organizations who are exhibiting at a show, event, or exhibition in Atlanta and the southeastern United States.

Q: What payment options do you provide?

A. Cypress Media Group accepts checks, money orders, cashiers checks, Visa, MasterCard, and American Express cards and electronic fund transfers to our accounts.

Q: Can you recommend other trade show marketing resources?

A. Yes. Listed below are other trade show marketing resources that might help you.

- Offer [trade show marketing training](#) to those who staff your trade show exhibit booth.
- Read an article entitled: [Six Ways to Move Trade Show Attendees from the Aisles into your Booth](#)



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- Break Into These Five Hot Apparel Markets**
Partner With Your Apparel Suppliers: Key Marketing and Sales Perks
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- 30 Sales Ideas in 60 Minutes: Quick Tips to Boost Business Now!**
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Making You Money: What ASI is all about.

Promotional products, also known as ad specialties, make up a \$20.5 billion dollars industry and are used by virtually every business in America. Why? Items like mugs, pens and t-shirts are memorable and provide a better cost per impression for advertisers than almost every major marketing effort like prime time TV, magazines and radio.

With so many businesses buying ad specialties there is a huge opportunity for professionals looking to make great money running a promotional products distributorship. It's easy and inexpensive to get started and you can work from home.

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- Work at home - for yourself - not by yourself
- Make money selling ad specialties
- Partner with a long-tested industry leader
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