

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85745925
LAW OFFICE ASSIGNED	LAW OFFICE 111
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant submits this response to the Office Action dated August 5, 2013 (the "Office Action"). In the Office Action, the Examining Attorney finally refused the Application based on likelihood of confusion under Section 2(d), and citing Registration No. 3,331,995 for the mark MAN CARD for "cards not magnetically encoded for use in a business transaction" in International Class 16 (the "Cited Mark"), owned by Dean Eric Schaefer (the "Registrant").</p> <p>Applicant respectfully requests reconsideration of the present application in view of the following remarks. Should the Examining Attorney determine to deny Applicant's Request for Reconsideration, Applicant requests that the further action in this matter be suspended pursuant to TMEP § 716.02(e) and § 716.06.</p>	
<u>REMARKS</u>	
<u>I. Consumers Will Not Be Deceived as to the Source of Applicant's Gift Cards</u>	
<p>In its response to the Examining Attorney's initial Office Action, Applicant argued, which it reiterates herein, that it is <i>unlikely</i> that a potential consumer would be confused or mistaken about the provenance of Applicant's magnetically encoded gift cards, which are redeemable for credit exclusively at Applicant's THE HOME DEPOT retail stores, and the source of the Registrant's non-magnetically encoded cards, which are registered for use in undefined "business transactions" and <u>would not be accepted or available at</u> Applicant's retail stores. <i>See</i> 15 U.S.C. § 1052(d); <i>Paula Payne Prods. Co. v. Johnson's Pub'g Co.</i>, 473 F.2d 901, 902, 177 USPQ 76, 77 (C.C.P.A. 1973) ("[T]he question is not whether people will confuse the marks, but rather whether the marks will confuse people into believing</p>	

that the goods they identify emanate from the same source.”). As support for this assertion, Applicant again argues as follows:

A. *Applicant’s Gift Cards Are Sold Exclusively at Home Depot*

Applicant’s MAN CARD cards are not available anywhere other than Applicant’s THE HOME DEPOT retail stores, in association with Applicant’s famous THE HOME DEPOT trademark. As Applicant has previously argued, this makes confusion between the goods offered under Applicant’s Mark and those offered under the Cited Mark unlikely – these goods “are not ...marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source.” TMEP § 1207.01(a)(i). These goods are offered instead to a discrete and separate group of consumers in a distinct channel of trade. *See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713 (Fed. Cir. 1992) (holding E.D.S. for computer services and EDS for battery chargers as not likely to cause confusion, based on fact that different discrete groups of individuals were purchasing goods sold under each respective mark, even though there was some overlap in those markets).

B. *Applicant’s Gift Cards are Sold to More Discriminating Purchasers*

Where the conditions of purchase suggest that purchasers use care in selecting goods or services, such circumstances can show that a likelihood of confusion is minimized. TMEP §1207.01(d)(vii). Especially given the fact that Applicant’s gift cards bearing Applicant’s Mark are sold exclusively in conjunction with its THE HOME DEPOT retail stores, it is extremely unlikely that consumers purchasing Registrant’s goods would mistake such goods for gift cards exclusively authorized by Home Depot stores and bearing Applicant’s Mark. Specifically, as Applicant has noted:

- (1) a consumer purchasing a gift card is likely to carefully inspect the card to verify its source and the location where the card is redeemable;
- (2) consumers wishing to give someone else a gift card for store credit are unlikely to surrender money in exchange for such a card without clearly knowing where it can be redeemed; and
- (3) consumers seeking out gift cards from a particular retail store are likely already familiar with that store’s goods and services.

This suggests that the relevant consumers purchasing Applicant’s gift cards have, at the very least, level of sophistication that would prevent them from mistaking Registrant’s goods for Applicant’s The

Home Depot-authorized gift cards bearing Applicant's Mark.

C. Applicant's Magnetically Encoded Cards are Different from "Business Transaction" Cards

Among the *du Pont* factors, the relatedness of the goods or services in question is among the most relevant for determining likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). As courts have noted,

"even when two products or services fall within the same general field, it does not mean that the two products or services are sufficiently similar to create a likelihood of confusion." *Harlem Wizards Entm't Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1095 (D.N.J. 1997).

Here, the differences between the goods offered by Applicant and the goods offered by Registrant under their respective MAN CARD marks are clear. Unlike the goods offered under the Cited Mark, Applicant's gift cards are magnetically encoded, a feature that indicates to consumers that such cards are redeemable at Applicant's retail stores. At the very least, the lack of such a feature on the Registrant's goods would make a purchasing consumer differentiate between the two types of cards, avoiding any possibility of confusion between them.

Moreover, the various cards cited to by the Examining Attorney and illustrated in the attachments to the Office Action are *clearly marketed as gift cards* to consumers. Unlike Registrant's non-magnetic coded "business transaction" cards, these examples are clearly identified and labeled as being redeemable at particular locations for particular goods and services, much like Applicant's The Home Depot-authorized gift cards bearing Applicant's Mark.

Applicant once again emphasizes that the Registrant has specified that its cards offered under the Cited Mark are to be used for "business transactions," which are unrelated to the gift cards that Applicant offers under Applicant's Mark, and which are solely for use in connection with the purchase of Applicant's products and services.

D. Registrant's Specimen and Third-Party Uses Show that Registrant's Intended Use is Different from Applicant's

Nothing suggests that the Registrant uses the Cited Mark in conjunction with gift cards. Instead, the specimen submitted in support of the Cited Mark suggests that, if the Registrant in fact uses its mark at all, it offers cards intended to serve as a symbol of one's manhood. Applicant once again highlights the fact that, as raised in Applicant's previous response, many third parties offer "man cards" as gimmicky

signifiers of masculinity. The Registrant's submitted specimen, which prominently displays the Mars symbol (â™), is evidence that this is the intended use of the Cited Mark.

REQUEST FOR SUSPENSION

Applicant notes that the Registrant has not timely filed the Section 8 Affidavit within six (6) years of registration of the Cited Mark, and is currently in the mandatory 6-month "grace" period to file these documents. In the event that the Examining Attorney finds Applicant's above arguments unpersuasive, Applicant requests that the further action in this matter be suspended pursuant to TMEP § 716.02(e) and § 716.06, quoted below:

"If the examining attorney is ready to issue a denial of a request for reconsideration of a final refusal of registration under § 2(d), and the cited registration is in the grace period for filing a §8 or §71 affidavit or §9 renewal application, the examining attorney must suspend action." TMEP § 716.02(e).

"If the examining attorney determines that action on an application should be suspended after issuance of a final refusal, the examining attorney must issue a suspension notice." TMEP § 716.06 (citing applicant's filing of a petition to cancel or a timely "insurance" extension request as examples of such circumstances).

NOTICE OF APPEAL

Applicant notes that a Notice of Appeal including the required filing fee has been filed in conjunction with this Request for Reconsideration.

CONCLUSION

Based on the foregoing, Applicant hereby submits that the application is in condition for publication. No filing fees are believed due with this correspondence. In the event additional fees are required in connection with this Application, please charge all necessary fees to Deposit Account No. 50-1212, Reference HOMR.T0207/11206621/RJG.

The Examining Attorney is requested to contact the undersigned if a telephone conference might be of assistance.

SIGNATURE SECTION

RESPONSE SIGNATURE

/Justin Haddock/

SIGNATORY'S NAME

Justin Haddock

SIGNATORY'S POSITION

Attorney of Record, Texas Bar Member

SIGNATORY'S PHONE NUMBER	512.536.3024
DATE SIGNED	02/05/2014
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Feb 05 15:02:44 EST 2014
TEAS STAMP	USPTO/RFR-209.163.161.178 -20140205150244617456-857 45925-500bf3e9223f77e1daa 903651f633e06e598d9bbb2f4 66bd4864675675d792e88-N/A -N/A-20140205144822456978

PTO Form 1930 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 05/31/2014)

Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85745925** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

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REMARKS

I. Consumers Will Not Be Deceived as to the Source of Applicant's Gift Cards

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The Examining Attorney is requested to contact the undersigned if a telephone conference might be of assistance.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Justin Haddock/ Date: 02/05/2014

Signatory's Name: Justin Haddock

Signatory's Position: Attorney of Record, Texas Bar Member

Signatory's Phone Number: 512.536.3024

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85745925

Internet Transmission Date: Wed Feb 05 15:02:44 EST 2014

TEAS Stamp: USPTO/RFR-209.163.161.178-20140205150244

617456-85745925-500bf3e9223f77e1daa90365

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