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Subject: U.S. TRADEMARK APPLICATION NO. 85813593 - INSURGENT - 22HF-165423 - Request for
Reconsideration Denied - Return to TTAB

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

U.S. APPLICATION SERIAL NO. 85813593 MARK: INSURGENT	
CORRESPONDENT ADDRESS: JILL M PIETRINI SHEPPARD MULLIN RICHTER & HAMPTON LLP 1901 AVENUE OF THE STARS STE 1600 LOS ANGELES, CA 90067-6055	GENERAL TRADEMARK INFORMATION: http://www.uspto.gov/trademarks/index.jsp
APPLICANT: Summit Entertainment, LLC	
CORRESPONDENT'S REFERENCE/DOCKET NO: 22HF-165423 CORRESPONDENT E-MAIL ADDRESS:	

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

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 06/06/2014 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.

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).

REFUSAL TO REGISTER ON THE GROUND OF LIKELIHOOD OF CONFUSION IS MAINTAINED AND CONTINUED

The refusal to register on the ground of likelihood of confusion for "computer games, namely, computer game cartridges, cassettes, tapes, discs, programs and software" "downloadable widget program for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing electronic games" "electronic games downloadable via the internet and mobile devices" and "video games, namely, video game cartridges, discs and software" is maintained and continued.

Applicant appears to contend that there is no likelihood of confusion on the ground that applicant's mark is famous and consumers would not confuse applicant's famous mark INSURGENT with registrant's INSURGENCY. However, even if applicant's mark is famous, the Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods and/or services, but it also protects against "reverse confusion," that is, the junior user is the source of the senior user's goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Fisons Horticulture, Inc. v. Vigoro Indust., Inc.*, 30 F.3d 466, 474-75, 31 USPQ2d 1592, 1597-98 (3d Cir. 1994); *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 490-91, 6 USPQ2d 1187, 1190-91 (2d Cir. 1988).

Applicant points out in its response of 05/07/2014, that “a well-known or famous mark is entitled to a broader scope of protection than one which is relatively unknown.” Famous marks are afforded a broad scope of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). See TMEP Section 1207.01(d)(ix). Applicant submits statements and evidence to support the apparent claim that applicant’s mark is a famous mark. This evidence in fact supports the refusal to register, as it is likely that there will be “reverse confusion” between the cited mark and applicant’s mark because applicant’s mark is famous.

Also see *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741, 1750 (TTAB 2006) (“As the fame of a mark increases, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines.”); see also *Nike, Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011) (finding applicant’s mark JUST JESU IT, and opposer’s mark JUST DO IT similar for likelihood of confusion purposes “despite the potential differences in meaning, given the fame of opposer’s mark and the similarity of appearance, pronunciation and overall commercial impressions”).

Applicant contends that the respective marks have different commercial impressions on the ground that applicant’s mark is associated with a book and movie, while applicant’s mark is associated with a warfare computer game. Applicant also contends that the respective goods and services are marketed in different trade channels for these same reasons.

However, the respective identifications of goods and services do not reflect any of these limitations. Despite applicant’s apparent argument to the contrary, it is well settled 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 identification set forth in the application and registration has no restrictions as to nature, type, 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 also contends that the respective purchasers are sophisticated, but provides no evidence for this assertion. Even if this assertion is true, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see, e.g., Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011).

/Mark Sparacino/

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