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Filing date: **03/20/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85813593
Applicant	Summit Entertainment, LLC
Applied for Mark	INSURGENT
Correspondence Address	JILL M PIETRINI SHEPPARD MULLIN RICHTER & HAMPTON LLP 1901 AVENUE OF THE STARS , STE 1600 LOS ANGELES, CA 90067-6055 UNITED STATES
Submission	Applicants Request for Remand and Amendment
Attachments	Request for Remand - INSURGENT in Class 9.pdf(81093 bytes)
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Signature	/Jill M. Pietrini/
Date	03/20/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Summit Entertainment, LLC	Examining Attorney Mark Sparacino
Serial No: 85/813,593	Law Office: 103
Filed: January 1, 2013	APPLICANT'S REQUEST TO REMAND APPLICATION TO THE EXAMINING ATTORNEY
Class: 9	
Mark: INSURGENT	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

Applicant Summit Entertainment, LLC (“Applicant”) hereby requests that the Trademark Trial and Appeal Board (“the Board”) remand the application to the Examining Attorney for consideration of Applicant’s request to divide the application, TBMP § 1205.02, and amendment of the application, TBMP § 1209.04, and that the Board suspend the appeal pending its decision. Applicant has good cause for its request as shown below.

REMARKS

A. Applicant is Allowed to Divide The Application

Section 1205.02 of the TBMP states: “An applicant may submit a request to divide the application to divide out goods or services within a class, or entire classes prior to, with, or after the filing of a notice of appeal. An applicant may wish to submit such a request in a situation where a refusal to register or requirement applies only to certain classes in a multi-class application or to certain goods or services within a class in either a single-class or multi-class application.” *Id.*; *see also* TMEP §1110.03 (“An applicant may file a request to divide at any time between the filing of the application and the date the examining attorney approves the mark

for publication; or during an opposition, concurrent use, or interference proceeding, upon motion granted by the Trademark Trial and Appeal Board.”).

The Examining Attorney has refused registration of Applicant’s mark under Section 2(d) of the Lanham Act only with respect to “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; video games, namely, video game cartridges, discs and software (“Refused Goods”). Applicant’s mark has not been refused registration with respect to the remaining goods in the application (“Approved Goods”). Applicant wishes to divide its application to divide the Approved goods into a child application which proceeds to publication and the Refused Goods in the present parent application for amendment and further examination by the Examining Attorney, and for appeal if necessary. Applicant’s Request to Divide is attached hereto as **Exhibit A.**

Applicant requests that the Board remand the application to the Examining Attorney to arrange for processing of the Request to Divide.

B. Applicant Has Good Cause for Requesting that the Board Remand its Application to the Examining Attorney to Consider an Amendment

Remand in an *ex parte* appeal is a matter of discretion with the Board, and the Board may refuse to remand for consideration of an amendment filed more than six months after the date of the action from which the appeal was taken, if, for example, an amendment is filed in bad faith, or would serve no useful purpose. TRADEMARK TRIAL AND APPEAL BOARD OF PROCEDURE (“TBMP”) §1205.01.

Good cause may be found when the amendment is an attempt to comply with a requirement or when the amendment will obviate a ground for refusal. *Id.* Good cause will depend, in part, on the stage of the appeal at the time the amendment is filed, including the reason given for the delay. *Id.*, citing e.g., *In re Thomas White International Ltd*, 106 USPQ.2d 1158, 1160 n.2 (TTAB 2013) (“at this late juncture applicant would not be able to show good cause” for a proposed amendment made in its appeal brief to expand the goods to cover related

services after applicant previously deleted services from the application); *In re Big Pig Inc.*, 81 USPQ.2d 1436, 1437-38 (TTAB 2006) (applicant's request for remand after filing of reply brief denied; because proposed claim of ownership of a registration was irrelevant, and clarification of the nature of its typed drawing was unnecessary, applicant failed to show good cause).

Applicant wishes to amend its application to amend the identification of goods in the parent application to add the restriction, "all relating to motion pictures and entertainment concerning motion pictures". The amendment sought by Applicant is attached hereto as **Exhibit B**. The sole ground upon which the application was refused registration with respect to the Refused Goods was the Examining Attorney's finding that the Applicant's mark is likely to cause confusion, to cause mistake, or to deceive with a prior registration. Applicant does not concur with the refusal, however the amendment serves to further distinguish Applicant's goods from the prior registrant's goods or goods and eliminate any purported likelihood of confusion with the prior registered mark. Upon entry of this amendment, Applicant will hopefully obviate the lone ground for refusal and the application should be positioned for approval for publication. Thus, the amendment would serve a useful purpose.

Applicant has not yet filed its appeal brief, the Examining Attorney has not filed his brief, and the Board has not affirmed the Examining Attorney's finding of a refusal to register. Thus, the request to amend the application is not made in bad faith.

C. Conclusion

For these reasons, Applicant respectfully requests that the Board remand the application to the Examining Attorney for processing of the request to divide and for consideration of Applicant's amendment of the application.

Respectfully submitted,

Dated: March 20, 2015

/Jill M. Pietrini/
Jill M. Pietrini
SHEPPARD MULLIN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, California 90067-6017
(310) 228-3700

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 20th day of March, 2015.

/LaTrina A. Martin/

LaTrina A. Martin

SMRH:436766242.1

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Examining Attorney
Summit Entertainment, LLC	Mark Sparacino
Serial No: 85/813,593	Law Office: 103
Filed: January 1, 2013	REQUEST TO DIVIDE
Class: 9	
Mark: INSURGENT	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

Applicant Summit Entertainment, LLC hereby requests that this application be divided into two applications by retaining the following goods in Class 9 in the parent application:

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; video games, namely, video game cartridges, discs and software

and making the following goods the subject of a new application in Class 9:

Backpacks adapted for holding computers; cameras; camcorders; cell phones; blank USB flash drives; flash drives containing prerecorded content relating to motion pictures, television programs, and literary works; decorative charms for cell phones; decorative magnets; decorative switch plate covers; digital media, namely, downloadable audio files featuring films, music and entertainment; digital photo frames; digital trading cards in the nature of multimedia software recorded on magnetic media featuring films, music and entertainment; downloadable computer wallpaper and screen saver software; downloadable files containing images relating to motion pictures, television programs,

music and documentaries; downloadable electronic publications in the nature of songbooks, tablature, and sheet music; downloadable software that provides access to movie and entertainment-related content and allows users to socialize and interact with other users; downloadable television programs and documentaries featuring drama, comedy, horror, romance, and variety provided via a global computer network or video-on-demand service; downloadable widget program for use in authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, playing, storing and organizing text, data, images, audio files and video files; electric door bells; electronic diaries; eyeglasses and eyeglass cases; GPS navigation devices; graduated rulers; headphones and earphones; laptop computers; magnetically encoded debit or credit cards; motion picture films in the fields of drama and romance; mouse pads; musical sound recordings; neon signs; personal digital assistants; portable media players. pre-recorded DVDs, videotapes, and other audiovisual recordings featuring motion pictures, music, television programs, and documentaries; cases, covers or sleeves for electronic apparatus, namely, cameras, camcorders, cell phones, portable media players, PDAs, tablet computers, laptops, e-book readers, GPS devices, and computer accessories and peripherals; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cameras, camcorders, cell phones, portable media players, PDAs, tablet computers, laptops, e-book readers, GPS devices, and computer accessories and peripherals; sunglasses and sunglass cases; tablet computers; and tape measures

The new application will be based on 15 U.S.C. §1051(b).

Please charge the \$100 Request to Divide filing fee and the \$375 new separate application filing fee to the deposit account for Applicant's counsel, Deposit Account No. 50-5691.

Respectfully submitted,

Dated: March 20, 2015

/Jill M. Pietrini/
Jill M. Pietrini
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/LaTrina A. Martin/

LaTrina A. Martin

SMRH:436766293.1

EXHIBIT B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Summit Entertainment, LLC

Serial No: 85/813,593

Filed: January 1, 2013

Class: 9

Mark: INSURGENT

Examining Attorney

Mark Sparacino

Law Office: 103

AMENDMENT OF APPLICATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

Applicant Summit Entertainment, LLC (“Applicant”) hereby requests that the following amendment be entered:

AMENDMENT

1. Amend the application by amending the goods in the application as follows:

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; video games, namely, video game cartridges, discs and software, **all relating to motion pictures and entertainment concerning motion pictures**

Respectfully submitted,

Dated: March 20, 2015

/Jill M. Pietrini/

Jill M. Pietrini
SHEPPARD MULLIN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
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/LaTrina A. Martin/

LaTrina A. Martin

SMRH:436766312.1