

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85962104
LAW OFFICE ASSIGNED	LAW OFFICE 111
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><u>Request for Reconsideration after Final Action</u></p> <p>Mark: CREATE Filing Date: June 17, 2013 Applicant: ISBE Brand Owner, LLC Application Serial Number: 85/962,104 Examining Attorney: Geoffrey Fosdick Law Office: 111</p> <p>To the Commissioner for Trademarks:</p> <p>Applicant respectfully submits this request for reconsideration in response to the final office action electronically mailed on December 12, 2014, by examining attorney, Geoffrey Fosdick, of Law Office 111. Applicant is simultaneously filing a notice of appeal in conjunction with this request for reconsideration.</p> <p style="text-align: center;">LIKELIHOOD OF CONFUSION</p> <p>The examining attorney issued a final refusal of registration of the Application for the mark CREATE for use with “after-hours night club services; arranging, organizing, conducting, and hosting social entertainment events; social club services, namely, arranging, organizing, and hosting social events, get-togethers, and parties for club members; night clubs.” The refusal is based on an alleged likelihood of confusion under 15 U.S.C. §1052(d) with U.S. Registration No. 4440549 for the mark CREATE for use with “contract food services; restaurant and catering services” in Class 43 by Compass Group USA, Inc.</p> <p>In response to the initial office action, Applicant argued that its mark CREATE is distinguishable from the prior registered mark because (i) the marks have distinct connotations and commercial impressions, (ii) the services claimed under the marks are not related, and (iii) the relevant purchasers of the services offered under the marks are sufficiently different.</p>	

In his final office action, the examining attorney rejected these arguments, stating that the marks are identical and the services are highly related. In support of his argument, the examining attorney points to Applicant's website as offering catering services. Although the CREATE nightclub allows for catered events at its location, Applicant does not provide those services under the CREATE brand and is not claiming protection with respect to those services. The catering services referenced on Applicant's website are expressly offered under other brands, such as SBE Catering, CLEO, Katsuya by Starck, The Bazaar by Jose Andres, to name a few. See <http://sbe.com/events/culinary-catering/>.

Applicant respectfully disagrees with the examining attorney's conclusions and Applicant requests that the examining attorney reconsider his refusal.

First, Applicant's use of CREATE connotes the artist expression of the acts that perform at its nightclub, while the prior registered mark relates to the creation of a unique food experience. The emphasis of each mark is vastly different: on the one hand, a purely entertainment experience; on the other, a food and dining concept.

Second, the services offered under each mark are expressly limited so as to not be confusing. Applicant has applied for registration in Class 41, for entertainment services. Applicant removed all references to food and drink that were initially included in its services description so as to alleviate any concern with respect to potential confusion with restaurant and catering services. Applicant is not offering services for providing food and drink, it is offering services for entertainment. Similarly, Compass Group USA, Inc. has also narrowed its claimed services by registering for "contract food services; restaurant and catering services," with a clear emphasis on the contract food services niche of Class 43. Each mark has requested protection for only the services claimed in its application or registration, and the likelihood of confusion analysis does not require an expansion of the scope of that protection.

Finally, the relevant purchasers of the services offered under each mark are sufficiently different so as to avoid a likelihood of confusion. Applicant's CREATE brand will be seen by nightclub goers and artists, people expressly looking for an entertainment experience. In contrast, the prior registered mark will be seen by decision-makers at organization that are choosing to install a contract food service location and those individuals seeking a lunch option in a cafeteria setting. It is highly unlikely that customers would confront each mark in a setting that would result in confusion; a reasonable customer viewing each mark would not assume that a contract food service offering lunch also runs a Los Angeles dance music nightclub.

Applicant respectfully requests that the examining attorney reconsider and withdraw his refusal and permit the mark CREATE to proceed to publication.

DATED this 10th day of June, 2015

Respectfully submitted,

Robert C. Cumbow/

Robert C. Cumbow

Katherine Robinson

Attorney for Applicant

Miller Nash Graham & Dunn llp
Pier 70
2801 Alaskan Way, Suite 300
Seattle, WA 98121
trademark@millernash.com
(206) 777-7468 Phone
(206) 622-7485 Fax

SIGNATURE SECTION

RESPONSE SIGNATURE	/Katherine Robinson/
SIGNATORY'S NAME	Katherine Robinson
SIGNATORY'S POSITION	Attorney for Applicant
SIGNATORY'S PHONE NUMBER	206-777-7548
DATE SIGNED	06/12/2015
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Fri Jun 12 12:54:11 EDT 2015
TEAS STAMP	USPTO/RFR-65.122.120.42-2 0150612125411365223-85962 104-53079ead36d9de7e64061 7995fd63b590397be1d71e38e b4a71a7380939a9013-N/A-N/ A-20150611191901999710

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

Application serial no. **85962104** has been amended as follows:

ARGUMENT(S)

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

Request for Reconsideration after Final Action

Mark: CREATE

Filing Date: June 17, 2013

Applicant: ISBE Brand Owner, LLC
Application Serial Number: 85/962,104
Examining Attorney: Geoffrey Fosdick
Law Office: 111

To the Commissioner for Trademarks:

Applicant respectfully submits this request for reconsideration in response to the final office action electronically mailed on December 12, 2014, by examining attorney, Geoffrey Fosdick, of Law Office 111. Applicant is simultaneously filing a notice of appeal in conjunction with this request for reconsideration.

LIKELIHOOD OF CONFUSION

The examining attorney issued a final refusal of registration of the Application for the mark CREATE for use with “after-hours night club services; arranging, organizing, conducting, and hosting social entertainment events; social club services, namely, arranging, organizing, and hosting social events, get-togethers, and parties for club members; night clubs.” The refusal is based on an alleged likelihood of confusion under 15 U.S.C. §1052(d) with U.S. Registration No. 4440549 for the mark CREATE for use with “contract food services; restaurant and catering services” in Class 43 by Compass Group USA, Inc.

In response to the initial office action, Applicant argued that its mark CREATE is distinguishable from the prior registered mark because (i) the marks have distinct connotations and commercial impressions, (ii) the services claimed under the marks are not related, and (iii) the relevant purchasers of the services offered under the marks are sufficiently different.

In his final office action, the examining attorney rejected these arguments, stating that the marks are identical and the services are highly related. In support of his argument, the examining attorney points to Applicant’s website as offering catering services. Although the CREATE nightclub allows for catered events at its location, Applicant does not provide those services under the CREATE brand and is not claiming protection with respect to those services. The catering services referenced on Applicant’s website are expressly offered under other brands, such as SBE Catering, CLEO, Katsuya by Starck, The Bazaar by Jose Andres, to name a few. See <http://sbe.com/events/culinary-catering/>.

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USA, Inc. has also narrowed its claimed services by registering for “contract food services; restaurant and catering services,” with a clear emphasis on the contract food services niche of Class 43. Each mark has requested protection for only the services claimed in its application or registration, and the likelihood of confusion analysis does not require an expansion of the scope of that protection.

Finally, the relevant purchasers of the services offered under each mark are sufficiently different so as to avoid a likelihood of confusion. Applicant’s CREATE brand will be seen by nightclub goers and artists, people expressly looking for an entertainment experience. In contrast, the prior registered mark will be seen by decision-makers at organization that are choosing to install a contract food service location and those individuals seeking a lunch option in a cafeteria setting. It is highly unlikely that customers would confront each mark in a setting that would result in confusion; a reasonable customer viewing each mark would not assume that a contract food service offering lunch also runs a Los Angeles dance music nightclub.

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DATED this 10th day of June, 2015

Respectfully submitted,

Robert C. Cumbow/
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Katherine Robinson
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Miller Nash Graham & Dunn llp
Pier 70
2801 Alaskan Way, Suite 300
Seattle, WA 98121
trademark@millernash.com
(206) 777-7468 Phone
(206) 622-7485 Fax

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Katherine Robinson/ Date: 06/12/2015

Signatory's Name: Katherine Robinson

Signatory's Position: Attorney for Applicant

Signatory's Phone Number: 206-777-7548

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: 85962104

Internet Transmission Date: Fri Jun 12 12:54:11 EDT 2015

TEAS Stamp: USPTO/RFR-65.122.120.42-2015061212541136

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