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Subject: U.S. TRADEMARK APPLICATION NO. 86251550 - GENERATIONS SENIOR LIVING - IPA T15US - Request for Reconsideration Denied - Return to TTAB - Message 1 of 4

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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. 86251550

MARK: GENERATIONS SENIOR LIVING



CORRESPONDENT ADDRESS:

THOMAS L. LOCKHART

VARNUM, RIDDERING, SCHMIDT & HOWLETT LLP

PO BOX 352

GRAND RAPIDS, MI 49501-0352

GENERAL TRADEMARK INFORMATION:

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

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APPLICANT: IPA Holding, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO:

IPA T15US

CORRESPONDENT E-MAIL ADDRESS:

trademarks@varnumlaw.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 7/12/2015

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 December 05, 2014, are maintained and continue to be final: the refusal under Trademark Act Section 2(d) for a likelihood of

confusion with the marks in U.S. Registration Nos. 2847258, 3052038, and 3146205. 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 provide any 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.

Specifically, as to the similarity and nature of the services, applicant has amended the identification to delete the Class 37 services - "real estate development." As a result, applicant asserts that no likelihood of confusion exists between the present application and U.S. Registration No. 3146205 because the instant application will proceed only with "leasing of apartments; management of apartments" in Class 36, while registrant's service involve "real estate development" in Class 37. However, as previously noted, the services of the parties need not be identical or even competitive to find a likelihood of confusion. See TMEP and case citations in the previous Office actions. Moreover, the attached evidence to the previous Office actions, incorporated herein by reference, showed that both parties' services commonly emanate from a single source under the same mark.

In addition, the attached Internet evidence to the instant Office action further establishes that the same entity commonly provides the relevant services and markets the services under the same mark. The attached evidence also shows that the relevant services are provided through the same trade channels and used by the same classes of consumers in the same fields of use. Therefore, applicant's and registrants' services are considered related for likelihood of confusion purposes. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-04 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1268-69, 1271-72 (TTAB 2009).

Bear Real Estate Group

<http://www.bearpropertymanagement.com/>

<http://www.beardevelopment.com/>

Ellicott Development

<http://www.ellicottdevelopment.com/about-us/>

<http://www.ellicottdevelopment.com/residential/>

Skysong

<http://skysongcenter.com/skysong-apartments/>

<http://skysongapartments.maac.com/>

Mill Creek Residential

http://www.millcreekplaces.com/find_an_apartment

http://www.millcreekplaces.com/what_we_do

Aimco

<http://www.aimco.com/apartments/search?state=21&city=7583&bedrooms=79>

<http://www.aimco.com/about-us/our-business/redevelopment>

Evidence obtained from the Internet may be used to support a determination under Section 2(d) that services are related. *See, e.g., In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1371 (TTAB 2009); *In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007).

The trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a representative sample of third-party marks registered for use in connection with the same or similar services as those of applicant and registrants in this case. This evidence shows that the services listed therein, namely, leasing of apartments; management of apartments; real estate development; real estate brokerage; real estate leasing and property management, are of a kind that may emanate from a single source under a single mark. *See In re Anderson*, 101 USPQ2d 1912, 1919 (TTAB 2012); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). *Please also see third-party registrations attached to the previous Office action, dated May 09, 2014, and incorporated here by reference.*

Turning to the respective marks, applicant submitted new evidence "demonstrating that the prior submitted registrations [U.S. Registrations Nos. 2969073 and 3869895] are actually in use in the marketplace" in order to refute the trademark examining attorney's argument that "evidence of

weakness or dilution consisting solely of third-party registrations, such as those submitted by applicant in this case, is generally entitled to little weight in determining the strength of a mark because such registrations do not establish that the registered marks identified therein are in actual use in the marketplace or that consumers are accustomed to seeing them.”

However, applicant’s argument and evidence is unpersuasive. As previously noted, the marks in U.S. Registration Nos. 2969073 (NEXT GENERATION REALTY FLAT FEE BROKER) and 3869895 (NEW GENERATION REALTY) begin with the wording “NEXT” or “NEW” which is different from the initial wording “GENERATION[S]” in applicant’s and registrants’ marks. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F. 3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered” when making purchasing decisions). Moreover, the “NEXT” and “NEW” elements appear to be non-descriptive terms, and thus create a different commercial impression, unlike the additional, descriptive wording “SENIOR LIVING COMMUNITIES,” “MANAGEMENT,” “REALTY” and “HOMES” in applicant’s and registrants’ marks.

In addition, the Court of Appeals for the Federal Circuit and the Trademark Trial and Appeal Board have recognized that marks deemed “weak” or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. TMEP §1207.01(b)(ix); *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1401, 182 USPQ 108, 109 (C.C.P.A. 1974) (likelihood of confusion is “to be avoided, as much between ‘weak’ marks as between ‘strong’ marks, or as between a ‘weak’ and ‘strong mark’)); *In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) (“even weak marks are entitled to protection against registration of similar marks”). This protection extends to marks registered on the Supplemental Register. TMEP §1207.01(b)(ix); *see, e.g., In re Clorox Co.*, 578 F.2d 305, 307-08, 198 USPQ 337, 340 (C.C.P.A. 1978); *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975).

Applicant has submitted a list of third-party registrations featuring the wording “NEW” and “NEXT.” However, the mere submission of a list of registrations or a copy of a private company search report does not make such registrations part of the record. *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); TBMP §1208.02; TMEP §710.03.

To make third party registrations part of the record, an applicant must submit copies of the registrations, or the complete electronic equivalent from the USPTO’s automated systems, prior to appeal. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372-73 (TTAB 2006); *In re Ruffin Gaming*, 66 USPQ2d,

1924, 1925 n.3 (TTAB 2002); TBMP §1208.02; TMEP §710.03. Therefore, the trademark examining attorney has not considered the third-party registrations as they are not part of the record.

Considering all of the above, the applied-for mark is refused registration under Trademark Act Section 2(d), and the request for reconsideration is denied.

If 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).

If no appeal has been filed and time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to (1) comply with and/or overcome any outstanding final requirement(s) and/or refusal(s), and/or (2) file a notice of appeal to the Board. TMEP §715.03(a)(ii)(B); *see* 37 C.F.R. §2.63(b)(1)-(3). The filing of a request for reconsideration does not stay or extend the time for filing an appeal. 37 C.F.R. §2.63(b)(3); *see* TMEP §§715.03, 715.03(a)(ii)(B), (c).

/Miroslav Novakovic/

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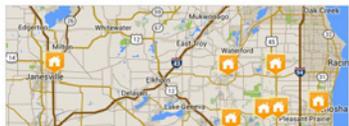
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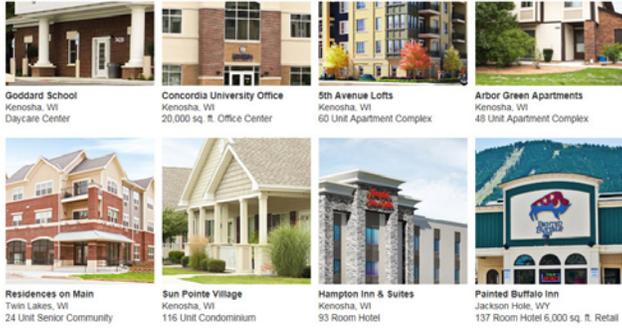
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