

Request for Reconsideration after Final Action

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Input Field	Entered
SERIAL NUMBER	86487685
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION	
MARK FILE NAME	http://tmng-al.uspto.gov/resting2/api/img/86487685/large
LITERAL ELEMENT	TIP
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
ARGUMENT(S)	
Please see the actual argument text attached within the Evidence section.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_6492798-20160414204459022311 . TIP _ Design Request for Reconsideration.pdf
CONVERTED PDF FILE(S) (14 pages)	\\TICRS\EXPORT16\IMAGEOUT16\864\876\86487685\xml8\RFR0002.JPG
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DESCRIPTION OF EVIDENCE FILE	Applicant's argument text attached within the Evidence section
SIGNATURE SECTION	
RESPONSE SIGNATURE	/mja/
SIGNATORY'S NAME	Merilee J. Arevalo

SIGNATORY'S POSITION	Associate Attorney, Stevens & Lee, NJ & PA Bar Member
SIGNATORY'S PHONE NUMBER	609.987.7047
DATE SIGNED	04/14/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu Apr 14 20:51:15 EDT 2016
TEAS STAMP	USPTO/RFR-XX.X.XX.XX-2016 0414205115970570-86487685 -550ad107940dc1889494c422 66b135ff9222ae0e67c39defa e6cd492e9c8d417fb-N/A-N/A -20160414204459022311

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Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86487685** TIP (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/86487685/large>) has been amended as follows:

ARGUMENT(S)

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

Please see the actual argument text attached within the Evidence section.

EVIDENCE

Evidence in the nature of Applicant's argument text attached within the Evidence section has been attached.

Original PDF file:

[evi_6492798-20160414204459022311 . TIP _ Design Request for Reconsideration.pdf](#)

Converted PDF file(s) (14 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

[Evidence-9](#)

[Evidence-10](#)

[Evidence-11](#)

[Evidence-12](#)

[Evidence-13](#)

[Evidence-14](#)

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /mja/ Date: 04/14/2016

Signatory's Name: Merilee J. Arevalo

Signatory's Position: Associate Attorney, Stevens & Lee, NJ & PA Bar Member

Signatory's Phone Number: 609.987.7047

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 owner's/holder'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 owner/holder in this matter: (1) the owner/holder 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 owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder'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: 86487685

Internet Transmission Date: Thu Apr 14 20:51:15 EDT 2016

TEAS Stamp: USPTO/RFR-XX.X.XX.XX-2016041420511597057

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Serial No. 86/487,685
Attorney Ref. No. 107594-00002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: MSSL, Inc.
SERIAL NO.: 86/487,685
FILING DATE: December 22, 2014
TRADEMARK: TIP & Design
CLASS: 41
ATTENTION: James W. Stein
Law Office 107

RESPONSE TO FINAL OFFICE ACTION DATED OCTOBER 14, 2015

In a Final Office Action dated October 14, 2015, the Examining Attorney maintained a refusal to register Applicant's TIP & Design application under Trademark Act Section 2(d), 15 U.S.C. §1052(d). The Examining Attorney previously made a determination that the TIP & Design mark is allegedly likely to be confused with U.S. Registration No. 4,555,868 for TIP. Applicant submits the following response in support of registration.

I. No Likelihood of Confusion

Applicant respectfully requests the Examining Attorney to reconsider this refusal and to approve its application for publication. For the reasons set forth in Applicant's previous response dated September 21, 2015 and the additional arguments below, Applicant's TIP & Design mark is sufficiently dissimilar from the cited registration as to preclude a likelihood of confusion.

As the Examiner is well aware, the multi-factor test for determining likelihood of confusion was set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). When considering a likelihood of confusion, the relevant trademarks must be considered in their entireties to determine the appropriate weight to be given to each *DuPont* factor. *Id.* Furthermore, it is important to consider the *commercial realities* that exist when determining whether the relevant consumers for Applicant's

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services are likely to be confused into believing those services emanate from the same source as Registrant's services. As the Federal Circuit observed:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 21 U.S.P.Q.2d 1388, 1391 (Fed. Cir. 1992).

When commercial realities are properly considered under the circumstances present here, the following *DuPont* factors are most relevant: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity of the goods or services as described in the application and registration; and (3) the similarity or dissimilarity of established, likely-to-continue trade channels.

Applicant respectfully submits that an analysis of these factors demonstrates that no likelihood of confusion exists between Applicant's mark and the cited registration for at least the following reasons: (1) the subject mark and the registered mark are distinct in sight and overall commercial impression; (2) Applicant and Registrant offer different services, which share only a general nexus to the very broad field of the sport of soccer; and (3) the Parties' respective services and associated products are sold in completely different trade channels, to completely different purchasers.

A. The Service Marks are Different in Sight and Overall Commercial Impression

Applicant's TIP & Design and the cited registration differ in visual appearance and overall commercial impression. When comparing the Parties' respective marks, the Examining Attorney must consider them in their entireties and not focus on one common element. *See Keebler Co. v. Murray Bakery Products*, 9 USPQ2d 1736 (Fed. Cir. 1989) (no likelihood of confusion between PECAN SANDIES and PECAN SHORTIES for cookies). Indeed, the entirety of a mark is so important that even where two marks share an identical common term, the addition of even a single word, or a difference of one word is sufficient to eliminate a likelihood of confusion. *Conde Nast Publ., Inc. v. Miss Quality, Inc.*, 184

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U.S.P.Q. 422, 425 (C.C.P.A. 1975) (COUNTRY VOGUE dissimilar to VOGUE); *In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364, 365 (T.T.A.B. 1974) (MMI MENSWEAR registered over MEN'S WEAR); *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) (no likelihood of confusion between VARGA GIRL and VARGAS for calendars). Finally, the context within which the respective marks are used further establishes that the marks have distinct meanings that serve to distinguish the marks. *In re Nationwide Industries, Inc.*, 6 U.S.P.Q.2d 1882 (T.T.A.B. 1988) (it is appropriate to view the marks' meanings in the context in which they are used, such as the goods and services with which they are used, when determining the meaning of the respective marks).

The fact that two marks may share common or similar elements should not be determinative. *See Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.2d 1373 (Fed. Cir. 1998); *King's Candy Co. v. Eunice King's Candy Kitchen*, 496 F.2d 1400, 182 USPQ 108 (C.C.P.A. 1974). A "likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark." *In re Nat'l Data Corp.*, 753 F.2d at 1058. The Court of Appeals for the Federal Circuit has cautioned, however, that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K+EFF (stylized) for dietary potassium supplement). The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction. *See, e.g., Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (reversing TTAB's holding that SPICE TREE with tree design, for garlic powder and minced onion, and SPICE ISLANDS with and without tree design, for seasoning herbs and spices, is not likely to cause confusion); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282 (TTAB 2009) (holding VOLTA for vodka infused with caffeine, and TERZA VOLTA and vine shoot design for wines, not likely to cause

confusion). When design marks are presented, both the words and pictorial symbols must be compared in their entireties. *Columbian Steel Tank Co. v. Union Tank & Supply Co.*, 277 F.2d 192 (C.C.P.A. 1960).



Viewed in their entireties, Applicant's mark and the cited registration are different. Applicant's mark is comprised of both a distinctive design elements and stylized font, neither of which appears in Registrant's mark. Moreover, Applicant's drawing is specifically limited to the colors red, orange, blue, gray, and white and will consistently appear in that color scheme. These additional elements combine with the textual element of the mark to create a unique visual appearance which results in an overall commercial impression wholly dissimilar from the cited registration. Further Applicant's TIP & Design is a highly stylized depiction of the acronym – Talent Identification Program. See Exhibit A. Registrant's TIP mark represents the acronym – Technical Improvement Program. See Exhibit B. Applicant's acronym mark and Registrant's acronym mark are used by their respective owners in conjunction with the long form of each mark.

The foregoing differences in appearance and overall commercial impression are more than enough to distinguish Applicant's TIP & Design from the cited registration and prevent confusion. In addition to the differences between the Parties' marks, consumers engaged in business with Applicant or Registrant will easily distinguish one mark from the other due to differences between the services offered under the Parties' respective marks and contexts in which those offerings are encountered.

B. The Service Marks Cover Distinct Services for Entirely Different Purposes.

Applicant's and Registrant's marks cover different services for distinct purposes. The only commonality is that both Parties' services may be categorized in the extremely broad field of the sport of soccer. However, a likelihood of confusion does not exist between two marks merely because the

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respective goods or services are sold within the same broad field or market. *See e.g., Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q. 1388 (Fed. Cir. 992) (finding no likelihood of confusion between E.D.S. and EDS for goods and services marketed in the same medical field, and sometimes to the same companies); *Homeowner's Group, Inc. v. Home Marketing Specialists, Inc.*, 18 U.S.P.Q.2d 1587, 1594 (6th Cir. 1991) (no likelihood of confusion between marketing and advertising support services for real estate brokers under HMS and providing real estate brokerage services under HMS HOME MARKETING SPECIALISTS); *In re Mars, Inc.*, 741 F.2d 395, 22 U.S.P.Q. 938 (Fed. Cir. 1984) (use of CANYON for candy bars not likely to cause confusion with registered mark CANYON for fresh citrus fruit).

Similarly, the services at issue in the instant matter are sufficiently different to allow Applicant's services to coexist in relation to soccer-related services without any likelihood of confusion, especially since the Parties' respective services are marketed in different geographies to different customers, who are likely to exercise great care in purchasing decisions.

Applicant is a non-profit organization with operations based primarily in the Middle Atlantic States. Applicant provides a wide range of sport tournaments, events and programs dedicated to the progression of youth players through their sport career. *See Exhibit C.* The service offerings under the TIP & Design mark include organizing soccer sporting events to allow extraordinary student athletes to showcase their talent in a college placement program and expose them to college and university recruiters and coaches. *See Exhibit A.* By contrast, Registrant is soccer club based in Wisconsin. The services offered under the relevant mark consist of a rigorous physical training schedule. *See Exhibit B.* These differences between the respective services, the purposes for which they are used, and the manner in which they are focused warrant a finding of no likelihood of confusion.

C. The Service Marks are Marketed in Distinct Channels of Trade to Completely Different Customers.

A close examination of the relevant marketing channels for the trademarks at issue reveals that the channels are distinct, and consequently, there is no likelihood of confusion among relevant consumers. It is well settled that differences among the channels of trade through which goods or services are marketed must be considered when determining whether a likelihood of confusion exists between two marks. *DuPont*, 476 F.2d 1357. Where there is no overlap of customers or purchasers, there can be no likelihood of confusion. *Electronic Data Systems*, 21 U.S.P.Q.2d at 1390-91; *Astra Pharmaceutical*, 220 U.S.P.Q. at 790-91. Moreover, if the relevant services are not marketed in such a way that they would be encountered by the same consumers in situations that would create a misconception that the services originate from the same source, confusion is not likely – even if the marks are identical. See e.g. *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener held not confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field).

In the instant matter, the chances that the Parties' marks and respective services would be encountered by the same purchasers are slim. Applicant's services are targeted to consumers who are student athletes interested in showcasing their talent to college recruiters in live sports competition. Those student athletes are very likely to be located in the same geographic area where Applicant is based, namely in New Jersey, Pennsylvania, New York, and Maryland. In contrast, Registrant's services are likely targeted to consumers who are looking to improve their technical skills by utilizing a series of targeted exercises, and those consumers are also likely to be located in the same geographic area where Registrant is located, namely in Wisconsin. Thus, not only are Applicant's and Registrant's services quite dissimilar, but they would rarely, if ever, enter the same channels of trade. These exceptional

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differences indicate a higher standard for the likelihood of confusion analysis when considering Applicant's TIP & Design mark and Registrant's TIP mark.

The commercial realities described herein require consumers of the services at issue in the instant matter to be highly informed, careful, and deliberate in their purchasing decisions. The persons involved in the purchase of these services cannot afford to make snap or impulse decisions. In short, the conditions of sale, when comparing Applicant's and Registrant's offerings in this case, negate a likelihood of confusion.

In sum, Applicant and Registrant market distinct services under very different marks to different customers for different purposes through distinct marketing channels, and those facts negate any likelihood of confusion. Therefore, in light of the foregoing, Applicant respectfully submits that Applicant's TIP & Design trademark is sufficiently dissimilar from Registrant's mark that there is no realistic likelihood of confusion.

II. Notice of Appeal to the Trademark Trial and Appeal Board

Applicant is filing a Notice of Appeal to the Trademark Trial and Appeal Board in conjunction with this Request for Reconsideration.

III. Conclusion

As the concerns of the Examining Attorney have been properly addressed, Applicant hereby requests that the Examiner withdraw the Section 2(d) refusal and approve its application for publication.

Dated: April 14, 2016

Respectfully submitted,

MSSL, Inc.

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Attorney Ref. No. 107594-00002

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Attorneys for Applicant

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Attorney Ref. No. 107594-00002

Exhibit A



Talent Identification Program (TIP)

Purpose of TIP

To support U.S. Soccer's Youth National Team programs by identifying the most promising young players within EDP & MAPS providing meaningful developmental opportunities that would better prepare these players for selection into U.S. Soccer Training Centers and U14 National Development program.



TIP 5 PLAYER DEVELOPMENT PROGRESSION

- 1. Development Days:** Directors of Coaching of EDP & MAPS Clubs recommend their most promising players between 1999 – 2003 to attend local Development Days.
- 2. TIP Training Centers.** TIP Training Centers operate year round in New York, New Jersey, Pennsylvania & Maryland. Players attend five Training Center sessions per year. Players are also observed in their clubs competitive games and training.
- 3. Regional Formation Centers :** Players from TIP Training Centers are invited to attend our Regional Formation Centers 2-3 day residential programs.
- 4. TIP Select Squads:** Select Squads will be selected to showcase their talent in developmental fixtures with U.S and International youth academies of professional clubs.
- 5. Talent Integration :** TIP Players are then recommended to U.S. Soccer for participation in Market Training Centers and U14 National Development Program.

For more information on EDP TIP Program contact Tony Williams TIP Technical Director Tony@mssl.org

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Exhibit B



Technical Improvement Program (TIP)

2013 Week One (9.23.13)

TIP Activity One: Figure-8s with the Ball

Set-Up: 3 cones in a line, approximately 2 yards between each cone

Instructions: Player dribbles through the cones in a figure-8 design using the surfaces below.

- Right Foot Only (*Approximately 15 Touches Per Rep*)
- Left Foot Only (*Approximately 15 Touches Per Rep*)
- Outside of Either Foot Only (*Approximately 15 Touches Per Rep*)
- Inside of Either Foot Only (*Approximately 15 Touches Per Rep*)

TIP Activity Two: Cuts with the Ball

Set-Up: 3 cones in a line, approximately 2 yards between each cone

Instructions: Player dribbles out to each cone and back, using an inside-cut to change direction at cone 2 and 3, and an outside cut to change direction at cone 1. The cut should be done with a feint and change of speed.

- Right Foot Only (*Approximately 10 Touches Per Rep*)
- Left Foot Only (*Approximately 10 Touches Per Rep*)

TIP Activity Three: Lateral Movement with the Ball

Set-Up: 2 cones 2 yards apart

Instructions: Player starts between the cones, and moves laterally between the two cones with the following patterns (outside right push, inside right cut, outside left push, inside left cut).

- Outside Right Push, Inside Right Cut, Outside Left Push, Inside Left Cut (*4 Touches Per Rep*)
- Right Sole Drag, Left Sole Stop, Left Sole Drag, Right Sole Stop (*4 Per Rep Touches*)

TIP Activity Four: Striking a Driven Ball

Set-Up: Small goal, wall or net required

Instructions: Player strikes the ball with the instep (driven ball) from approximately 3-4 yards from a wall, goal or net.

- Right Instep
- Left Instep

The TIP Weekly Goal is 2,000 touches between the four activities. Keep track of your touches on each exercise per week, and bring your signed TIP Worksheet to training each Monday if you have met the goal. While 2,000 touches is the goal, feel free to do more and set your own goals higher!!!

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Exhibit C

EDP Soccer

About EDP

Vision, Mission & Values

VISION

Provide the best developmental pathway in support of each player's journey

MISSION

We enable soccer players to reach their full potential on and off the field, with an emphasis on going to college, by providing a full range of the highest quality soccer-related experiences and empowering each player to select the pathway best suited to their goals.

We work closely with member clubs to develop a positive, fair, and competitive environment based on cooperation and communication. We continually strive to be an extraordinary place to work and develop as professionals.

VALUES

Trust: Striving to make the right decisions at the right times for the right reasons

Loyalty: Earning and valuing mutual commitments among coaches, parents, players and staff

Quality: Everything is done well

Respect: Everyone is treated with dignity

Fair play: Honoring the rules of the game and the game itself

Access: All players deserve opportunities for development

Adaptability: Always supporting the customer, even as their needs shift

MSSL is a 501 c3 not-for profit organization whose mission is providing player development opportunities to advance soccer in the USA.

We have a wide range of sport tournaments, events and programs dedicated to the progression of youth players through their sport career. Our mission is to help players develop and to provide the opportunities for help them to succeed. Designed for all competitive levels, our programs are held at premier outdoor facilities and state-of-the-art indoor complexes.

MSSL Foundation - Soccer For All

Soccer for All's mission is to foster a commitment to young people that will promote pro-social friendships, strong interpersonal skills, and assert a sense of hope for the future through soccer.

Soccer For All provides a safe and secure environment. Play is hosted at schools, soccer clubs, and other local venues at times that are convenient for the children.

[Learn more about Soccer For All](#)