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

Proceeding	91228276
Party	Defendant Noble, Inc.
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Attachments	Noble Inc Answer to Opposition-071502016.pdf(60457 bytes)

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

Barnes & Noble, Inc.)	
Barnes & Noble Booksellers, Inc.)	Opposition No. 91228276
)	
Opposers,)	Mark:
)	NOBLE  GAMING
v.)	
)	
Noble, Inc.)	Serial No.: 86,725,370
)	Filing date: August 14, 2015
Applicant.)	Publication date: Feb. 23, 2016

APPLICANT’S ANSWER TO NOTICE OF OPPOSITION

Applicant, NOBLE, INC., by and through its attorney, hereby answers the Notice of Opposition filed by Barnes & Noble, Inc. and Barnes & Noble Booksellers, Inc.

1. Admitted.

2. Admitted.

3. Admitted.

4. Admitted.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 5 of the Notice of Opposition and therefore denies them.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 6 of the Notice of Opposition and therefore denies them.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 7 of the Notice of Opposition and therefore denies them.

8. Applicant acknowledges Opposer is listed as Owner of record for named Registration No. 1,138,704, but is otherwise without knowledge or information sufficient

to form a belief as to admit or deny all other allegations in paragraph 8 and therefore denies them.

9. Applicant acknowledges Opposer is listed as Owner of record for named Registration No. 2,360,296, but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 9 and therefore denies them.

10. Applicant acknowledges Opposer is listed as Owner of record for named Registration No. 2,290,269, but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 10 and therefore denies them.

11. Applicant acknowledges Opposer is listed as Owner of record for named Registration No. 2,512,356, but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 11 and therefore denies them.

12. Applicant acknowledges Opposer is listed as Owner of record for named Registration No. 3, 848,163, but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 12 and therefore denies them.

13. Applicant acknowledges Opposer is listed as Owner of record for named Registration No. 3,864,808, but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 13 and therefore denies them.

14. Applicant acknowledges Opposer is listed as Owner of record for named Registration No. 4, 319,847, but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 14 and therefore denies them.

15. Applicant acknowledges Opposer is listed as Owner of record for named Registration No. 2,797,319, but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 15 and therefore denies them.

16. Applicant acknowledges Opposer is listed as Owner of record for named

Registration No. 4,556,399, but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 16 and therefore denies them.

17. Applicant acknowledges Opposer is listed as Owner of record for named Registration No. 4,589,168, but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 17 and therefore denies them.

18. Applicant acknowledges Opposer is listed as Owner of record for named Registration No. 2,915,318, but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 18 and therefore denies them.

19. Applicant acknowledges Opposer is listed as Owner of record for named pending application and Registrations. Applicant is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 19 and therefore denies them.

20. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 20 of the Notice of Opposition and therefore denies them.

21. Applicant acknowledges Opposer is listed as Owner of record for named Registrations listed in Paragraph 21 of the Notice of Opposition.

22. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 22 of the Notice of Opposition and therefore denies them.

23. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 23 of the Notice of Opposition and therefore denies them.

24. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 24 of the Notice of Opposition and therefore denies them.

25. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 25 of the Notice of Opposition and therefore denies them.

26. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 26 of the Notice of Opposition and therefore denies them.

27. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 27 of the Notice of Opposition and therefore denies them.

28. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 28 of the Notice of Opposition and therefore denies them.

29. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 29 of the Notice of Opposition and therefore denies them.

30. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 30 of the Notice of Opposition and therefore denies them.

31. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 31 of the Notice of Opposition and therefore denies them.

32. Applicant admits the application details for trademark serial number 86,725,370 for  .

33. Applicant admits the first use date for trademark serial number 86,725,370 is June 3, 2015 but is otherwise without knowledge or information sufficient to form a belief as to admit or deny all other allegations in paragraph 33.

34. Applicant agrees Applicant's mark's dominant portion of its mark is 'NOBLE' but denies and disagrees with Opposer's assertion that Applicant's mark "... having limited distinctiveness."

35. Applicant denies its trademark is "... confusingly similar in sound, appearance and /or meaning" to Opposer's registration. Firstly, the general rule in Trademark law is that the dominating portion of a trademark is the leading part of the design as they create first and strongest impression in the minds of the consumer.

Applying this general rule, Opposer’s mark’s dominant portion is “**BARNES**” while applicant’s is “**NOBLE**,” thus no confusion in sounds. Secondly, Applicant’s logo layout presented a high degree of distinctive overall commercial impressions in that they differ in *color schemes*, the *designs*, the *fonts* and their *appearances as a whole* are vastly different from one another (*emphasis ours*). A side-by-side comparison illustrates our point that the two marks are clearly distinguishable. There is no confusion in their appearances.

Owner	Barnes & Noble Booksellers Inc.	Noble Inc.
Mark		

As to the meaning of the marks, Barnes & Noble began as a college text book seller and remain in the printed materials industry. Noble Gaming is the creation of NOBLE Inc., began as early as 1990 as a specialty gaming devices and related products boutique store, which remains its business model today. Contrary to Opposer’s assertion and allegation, there is absolutely no similarities whatsoever in the meanings of these two trademarks. Therefore, no confusion in their sound, appearance, and/or meaning.

36. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 36 of the Notice of Opposition and therefore denies them.

37. Applicant utilizes the pending trademark for services applied under. To the extent any of the other allegations contained in this Paragraph warrants a response, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 37 of the Notice of Opposition and therefore denies them.

38. Applicant denies its products and services are marketed in the same channels of trade to the same class of purchasers as the Opposer.

Opposer’s Registrations No. 3848163 for ‘BARNES & NOBLE’ is granted for “*retail and online retail bookstore services, featuring, among other things, books, text-books, used books, used text-books, magazines, compact discs, audio and video cassettes, digital video discs, computer software, computer and video games, posters, stationery, school supplies, food, beverages and general giftware items; providing best seller lists*

and personal recommendations and gift ideas concerning books, magazines, music, software and general giftware.” All of which are classified under International Class 35.

Applicant’s ‘Noble Gaming’ trademark is used to market specialty new and used video games and related gaming products only. Products such as gaming consoles, accessories, trading card games; Atari 2600, Nintendo, Sega Genesis, Playstation 4, Xbox One and Wii U; none of these are sold in Opposer’s stores. Consumers seeking special gaming products and related products will not be able to find them in Opposer’s establishments; while those who frequent Opposer’s stores are most likely not customers for Applicant.

Applicant neither offers nor sells any books, magazines, video cassettes, digital video discs, computer software, posters, stationary, school supplies, and all the other items listed on Opposer’s registration.

39. Applicant denies Opposer’s allegations. Applicant’s and Opposer’s marks differ vastly as shown in preceding paragraphs. Each mark also use different trade channels to market to different consumers. Given that the marks and products and services both differ substantially, if not entirely, it is unlikely for consumers to associate these two marks under any circumstance.

40. Applicant vehemently denies Opposer’s allegations in Paragraph 40 based on dissimilarities of the two marks as illustrated in preceding paragraphs.

41. Applicant vehemently denies Opposer’s allegations in Paragraph 41 based on dissimilarities of the two marks as illustrated in preceding paragraphs. It is well settled that one feature of a mark may be more significant or dominant in creating a commercial impression in a likelihood of confusion analysis. “When assessing the likelihood of confusion between two marks, one must determine whether there is a portion of the mark that is dominant in terms of creating a commercial impression. Although there is no mechanical test to select a ‘dominant’ element of a compound word mark, consumers would be more likely to perceive a fanciful or arbitrary term rather than a descriptive or generic term as the source-indicating feature of the mark.” T.M.E.P. § 1207.01(b)(viii). “In identifying the dominant feature of a mark, it is likely the first part of a mark that is most likely to be impressed upon the mind of a purchaser and remembered.” Jeffery A. Handelman, Guide to TTAB Practice § 605[F] (2014); Palm Bay Imports, Inc. v. Veuve

Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 1372-73, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); Edom Laboratories Inc. v. Lichter, 102 USPQ2d 1546, 1551 (TTAB 2012) (noting that the first part of opposer’s mark is “most likely to be impressed upon the mind of a purchaser and remembered.”); L’Oreal S.A. v. Marcon, 102 USPQ2d 1434, 1439 (TTAB 2012) (“purchasers in general are inclined to focus on the first word of portion in a trademark.”); In re Cynosure Inc., 90 USPQ2d 1644, 1646 (TTAB 2009); Everready Battery Co. v. Green Planet Inc., 91 USPQ2d 1511, 1518 (TTAB 2009); Brown Shoe Co. v. Robbins, 90 USPQ2d 1752, 1755 (TTAB 2009) (noting that it is the first portion of a mark that is more likely to make an impression on potential purchasers). Applying these principles, Opposer’s registration and Applicant’s design mark are sharply and clearly distinguishable and differentiable from each other. There is no confusion to be had, thus no connection between the two marks in the minds of the consumer.

42. Applicant vehemently denies Opposer’s allegations in Paragraph 42 of the Notice of Opposition based on the dissimilarities of the two marks as illustrated in preceding paragraphs. Since the two marks are clearly distinguishable and differentiable, there is no confusion and therefore no association with Opposer’s mark. Without the connection there will be absolutely no injury to Opposer’s reputation as alleged therein.

43. Applicant vehemently denies Opposer’s allegations in Paragraph 43 of the Notice of Opposition for reasons enumerated in preceding paragraphs.

44. Applicant vehemently denies Opposer’s allegations in Paragraph 44 of the Notice of Opposition for reasons enumerated in preceding paragraphs.

45. Applicant vehemently denies Opposer’s allegations in Paragraph 45 of the Notice of Opposition for reasons enumerated in preceding paragraphs.

46. Applicant acknowledge receipt of Notice of Opposition.

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WHEREFORE, Applicant prays that this Opposition be dismissed and that Applicant's mark be allowed to proceed to registration.

Attorney for Applicant
NOBLE, INC.

Respectfully submitted,



Dated: July 15, 2016

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Answer to Notice of Opposition has been served on Todd Braverman, Esq., counsel for Opposers by mailing said copy on the date indicated below, via U.S. Postal Service First Class Mail, postage prepaid to:

Todd Braverman, Esq.
Pearl Cohen Zedek Latzer Baratz LLP
1500 Broadway, 12th Floor
New York, NY 10036
Attorney for Opposers

On this 15th day of July, 2016.

A handwritten signature in black ink, appearing to read 'Joanna Y. Tsai', written over a horizontal line.

Joanna Y. Tsai
JYTLAW